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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,377	06/08/2010	6417801	5664-004-RE	2649
26111	7590	08/30/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 08/30/2010

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,377	06/08/2010	6417801	5664-004RE

PILLSBURY WINTHROP SHAW PITTMAN LLP
P O BOX 10500
MCLEAN, VA 22102

EXAMINER

ENGLISH, PETER C.

ART UNIT PAPER

3993

DATE MAILED:
MAILED

AUG 30 2010

CENTRAL REEXAMINATION UNIT

**INTER PARTES REEXAMINATION
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(For Requester)

MAILED

JG 30 2010

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 95/001,377
Filed: June 8, 2010
For: US Patent No. 6,417,801

DECISION ON
PETITION FOR
EXTENSION OF TIME
[37 CFR 1.956]

This is a decision on the petition filed August 25, 2010 to request a one-month extension of time pursuant to 37 CFR 1.956 for filing a response to the Office action mailed July 1, 2010.

The petition is before the Director of the Central Reexamination Unit for consideration.

The petition is **dismissed** for the reasons set forth below.

Decision

The Patent Owner requests an extension of time in which to file a response to the Office action dated July 1, 2010, which set a two-month date for filing a response thereto. The Office action is a non-final Office action. The request is timely filed and includes authorization to debit a deposit account for the \$200.00 petition fee as required by 37 CFR 1.17(g).

37 CFR 1.956 (c) states:

(c) The time for taking any action by a patent owner in an *inter parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the patent owner is due, but in no case will the mere filing of a request effect any extension. Any request for such extension must be accompanied by the petition fee set forth in § 1.17(g). See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

Addressing the requirement of 37 CFR 1.956 to make a showing of “sufficient cause” to grant an extension of time request, MPEP 2665 states, in pertinent part:

Evaluation of whether “sufficient cause” has been shown for an extension must be made by **balancing** the desire to provide a fair opportunity to respond, **against** the requirement of the statute, 35 U.S.C. 314 (c), that the proceedings be conducted with special dispatch.

Any request for an extension of time in a reexamination proceeding must fully state the reasons therefor.

Patent Owner’s Showing of Sufficient Cause to Grant an Extension of Time

The petition for extension of time states that the patent under reexamination was involved in an ITC proceeding in 2008. The ITC issued a Final Determination on January 27, 2009. On July 1, 2010, the Office issued a first Office action. On August 25, 2010 this petition was filed contemporaneously with a Power of Attorney from Sterne, Kessler, Goldstein & Fox P.L.L.C. (SKGF). SKGF has reviewed the patent and the prosecution history of the present reexamination proceeding but requests additional time to review the ITC proceedings.

Analysis and Findings

On balance, it is considered that the petition lacks the "sufficient cause" for an extension of time. Patent Owner has failed to set forth a factual accounting that is deemed to establish reasonably diligent behavior by all those responsible for preparing a response within the statutory period. The fact that patent owner has retained new counsel one week before the response is due does not rise to the level of sufficient cause or diligent behavior on the part of patent owner. When balanced against the requirement of 35 USC 314(c) that this proceeding be handled with special dispatch, Owner's showing is inadequate to justify the grant of a one-month extension of time in which to file a response to the Office action. Accordingly, the response is due September 1, 2010. Patent Owner should expect that future requests for extensions will not be granted absent strong and compelling reasons that establish the existence of an extraordinary situation necessitating the additional time.

Conclusion

1. The Patent Owner's petition for extension of time in which to file a response to the Office action of July 1, 2010 is **dismissed**.
2. The Patent Owner's response is due September 1, 2010.
3. Response may be submitted as follows:

By EFS: Registered users may submit via the electronic filing system EFS-Web at:
<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

4. Telephone inquiries with regard to this decision should be directed to Deborah Jones, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3991, at (571) 272-1535.

/Deborah Jones/,
SPE, Art Unit 3991,
Central Reexamination Unit



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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,381
Filed: June 9, 2010
For: U.S. Patent No. 7,532,537

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION AND**
: **EXPUNGING**
: **IMPROPER PAPER**

This is a decision on third party requester's petition paper entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. §§ 1.182 AND 1.183," filed on November 8, 2010. The third party requester petition is taken as a petition under 37 CFR § 1.183 to waive the requirement of 37 CFR 1.943(b) that written comments by third party requester not exceed fifty (50) pages in length. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in written comments by third party requester is granted to the extent that the page limit for written comments by third party requester is extended to not exceed 88 pages in length.

For the reasons set forth below, third party requester's comments submission is an improper paper and is being expunged without consideration. Since the third party requester paper has been scanned into the record, Image File Wrapper (IFW) of the 95/001,381 *inter partes* reexamination proceeding, the November 8, 2010 third party requester comments submission is being expunged from the record by closing it and marking it "not public" in the IFW of the 95/001,381 *inter partes* reexamination proceeding.

BACKGROUND

1. On May 12, 2009, United States Patent No. 7,532,537 (the '537 patent) issued to Solomon et al.
2. On June 9, 2010, a request for *inter partes* reexamination of the '537 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,381 (the '1381 proceeding).
3. On September 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1381 proceeding, with an accompanying Office action on the merits.
4. On October 8, 2010, patent owner filed a timely response to the Office action.
5. On November 8, 2010, third party requester filed the instant petition entitled "PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. §§ 1.182 AND 1.183," concurrently with third party requester's comments after the patent owner response to the September 8, 2010 Office Action. This requester petition is the subject of the present decision.

DECISION

I. DECISION GRANTING-IN-PART PETITION TO WAIVE THE REQUIREMENTS OF 37 CFR 1.943(b)

Relevant portions of the statute, regulations and MPEP

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on November 8, 2010, to address patent owner's October 8, 2010 response to the non-final Office action and two IDS statements.¹ The requester points out that the response added 19 new claims and amended 9 claims and that the two IDS statements contained "hundreds of new prior art references (274 references) not before considered by the Office."² In support of its request for waiver of the rule, third party requester argues that additional pages are needed for its proposed new rejections to comply with the requirements of MPEP 2617 and 35 U.S.C. § 311. Specifically, requester argues that MPEP 2617 "requires a discussion of the pertinence of each prior art reference to the patentability of each of the claims presented for the newly submitted prior art," and that "35 U.S.C. § 311 requires an explanation of how to apply the newly proposed rejections..."³

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's November 8, 2010 written comments include 62 pages of remarks, which are subject to the 50 page limit. The third party requester written comments are also accompanied by a declaration of David Wang under 37 CFR 1.132 and an IDS citing 4 documents. Three of the cited documents are prior art references, and one document is a joint claim construction and prehearing statement from the litigation of a related patent (US Patent No. 7,289,386).

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page

¹ Petition at page 1. These two IDS statements were filed by patent owner on October 8, 2010, and on October 12, 2010.

² Petition at page 1.

³ Petition at page 2.

count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 4-page declaration of Wang contains 2 pages of legal arguments regarding claim construction; these two pages are thus counted toward the page limit.

The three prior art references cited in the IDS do not count toward the page limit.

Third party requester's comments rely on a 35-page claim construction and prehearing statement from the litigation of a related patent.⁴ Therefore, this entire court document from the litigation of a related patent, *which is not a court document containing claim construction done by the court* for the patent under reexamination in the present proceeding, is counted toward the page limit.

Accordingly, the November 8, 2010 third party requester comments *in toto* is 99 pages in length, as to pages counted toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 49 pages of arguments in excess of 50 required to complete the third party requester's comments are unreasonable in this instance, in view of the present facts and circumstances. As discussed in Section II.B below, third party requester's comments improperly propose new prior art rejections for unamended claims. And, a substantial portion of third party requester's 62 page comments are directed to proposed new prior art rejections for unamended claims, pages of which are not permitted, and consequently would not be needed in the comments. Requester's argument that additional pages are needed to address patent owner's IDS submission is found unpersuasive as third party requester does not have either a statutory right under 35 U.S.C. § 314(b)(2), or a regulatory right under 37 CFR 1.947 and 1.948, to comment on patent owner's IDS submission. Accordingly, addressing an IDS submission cannot support the basis for additional pages.

It is noted that the September 8, 2010 non-final Office action is 14 pages on its face and does not incorporate any pages from the request for the non-adopted rejections. In contrast, the non-final Office action incorporates a substantial number of pages from the request for the adopted rejections. Patent owner's response, which is page length compliant, included 43 pages of

⁴ See third party requester's written comments at page 3.

remarks and was accompanied by a 4-page declaration of Hyun Lee under 37 CFR 1.132. The patent owner's response also added 19 new claims, and amended 9 claims.

In a balancing of the equities, and after a review of the comments submission, the third party requester petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived as to the **38 pages** of the portions of requester's written comments, which are included in the regulatory page count, that exceed the 50-page limit (assuming requester revises the comments submission to properly limit it by deleting the comments that are directed to proposed new prior art rejections for unamended claims).

Third party requester's written comments submission, that is 99 pages in length, does not comply with the page limit of eight-eight (88) pages in length granted in this decision by waiver. The third party requester's written comments submission lacks an entry right in the present '1381 proceeding. The written comments paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it "not public" in the IFW of the present reexamination proceeding.

II. DECISION EXPUNGING THIRD PARTY REQUESTER'S COMMENTS SUBMITTED NOVEMBER 8, 2010

A. Relevant portions of the statute, regulations and MPEP

35 U.S.C. § 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response.

37 CFR 1.948(a) provides:

(a) After the *inter partes* reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

- (1) which is necessary to rebut a finding of fact by the examiner;
- (2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP § 2666.05, Third Party Comments After Patent Owner Response, provides in pertinent part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

B. Third party requester's comments filed on November 8, 2010, are improper for proposing new prior art rejections that are prohibited by the statute and the rules

The third party requester's comments submission is improper for introducing newly proposed prior art rejections for unamended claims.⁵ Third party requester's newly proposed prior art rejections for unamended claims are based on the Halbert and the Kolor references.⁶ Third party requester justifies these newly proposed prior art rejections as follows: With respect to the

⁵ See for example, pages 24-27 and 40-57 of the November 8, 2010 comments, which contain newly proposed prior art rejections for unamended claims.

⁶ *Id.*

Halbert reference, third party requester asserts that the reference, “pursuant to 37 CFR 1.948 did not become known to the third party requester until November 8, 2011.”⁷ With respect to the Kolor reference, third party requester asserts that the reference, “pursuant to 37 CFR 1.948 did not become known to the Third Party Requester until the service of the Netlist IDS, received no earlier than October 11, 2011.”⁸

While the third party requester’s explanations might be persuasive for newly citing the art pursuant to 37 CFR 1.948(a)(3), they are not persuasive for the introducing the new prior art rejections for the unamended claims, based on the cited art.

35 U.S.C. § 314(b)(2) limits the content of requester’s comments to “addressing issues raised by the action of the Office or the patent owner’s response thereto.” When new prior art is necessary to rebut a finding of fact by the examiner or a patent owner response, then a proposed new ground of rejection may be introduced, if it is limited to modification of the existing rejection by adding the new art that provides the rebuttal as per 37 CFR 1.948(a)(1) or (2). An entirely new proposed new ground of rejection, however, and one which is based on 37 CFR 1.948(a)(3) art is not permitted by 35 U.S.C. § 314(b)(2), as such would not address “issues raised by the action of the Office or the patent owner’s response.”

It is also to be observed, though not relevant to the present situation, that prior art submitted under 37 CFR 1.948(a)(3) by third party requester must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. Third party requester did not explain the circumstances under which the prior art first became available and why it was not available earlier.

Even if 37 CFR 1.948 is shown to be satisfied, such does not necessarily permit requester to propose a new ground of rejection based on additional art, as (1) 37 CFR 1.947 must be satisfied in order for requester to be permitted to propose a new ground of rejection, and (2) 37 CFR 1.947 cannot be waived to the extent that it promulgates a requirement of the statute – in this instance, 35 U.S.C. § 314(b)(2).

Therefore, the November 8, 2010 requester comments do not have a right of entry under 37 CFR 1.947 and 1.948 and 35 U.S.C. § 314(b)(2). There is simply no statutory or regulatory authority for entry of the newly proposed prior art rejections not necessitated by an amendment to the patent claims. And, as pointed out above, the written comments paper was entered (scanned) into the IFW before discovery of the defect in the paper, and as such, cannot be physically removed from the IFW. Therefore, the written comments paper is being expunged from the record by closing it and marking it “not public” in the IFW of the present reexamination proceeding.

In view of the above discussion as to the comments filed on November 8, 2010 being improper, the comments are expunged from the record in the manner described above.

⁷ *Id.* at page 24. It also appears that requester intended to state November 8, 2010, instead of November 8, 2011.

⁸ *Id.* at page 36. It also appears that requester intended to state October 11, 2010, instead of October 11, 2011.

THIRD PARTY REQUESTER OPTIONS

For the above reasons, the November 8, 2010 comments submitted by the third party requester are improper.

I. If the third party requester desires to bring the newly presented proposed rejections before the Office, requester may file a new and complete request for an *ex parte* reexamination of: the '537 patent based on the newly cited Halbert and Kolor references. Any such request must set forth a substantial new question of patentability that is different from the substantial new question of patentability set forth in this proceeding, and any other previous examination of the patent in the Office.

II. Third party requester is given fifteen (15) days from the mailing date of this decision to rectify and refile the comments. As to any such replacement comments, the third party requester is limited to 88 pages pursuant to the page limit waiver granted-in-part in this decision. The requester should review the entire replacement written comments prior to filing the response for any non-statutory comments.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (expunged) comments submission. No comments that add to those in the returned paper will be considered for entry.

If no replacement comments from the third party requester are timely received, the reexamination proceeding will be forwarded to the examiner for appropriate action, without entry of written comments by the third party requester.

CONCLUSION

1. Third party requester's November 8, 2010 petition under 37 CFR 1.183 is granted in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's 37 CFR 1.947 comments submission after the October 8, 2010 patent owner response is not to exceed 88 pages in length. **This waiver is conditional on the submission being in at least 12 point font and at least one-and-a-half spaced, with appropriate margins.**
2. Third party requester's written comments paper filed on November 8, 2010 is an improper paper, and therefore will NOT be made a part of the record of the '1381 proceeding.
3. Since third party requester's comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the '1381 proceeding, these papers are expunged by closing them in the '1381 reexamination proceeding's IFW file and marking them as "non-public."
4. Third party requester is given fifteen (15) days from the mailing date of this decision to rectify and refile the comments. The third party requester's responsive submission must be clearly

labelled as either redacted or re-drafted written comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point, resubmission of comments will no longer be permitted. Any replacement comments submitted in response to the notification **must be strictly limited to (i.e., must not go beyond) the comments in the original (now expunged) comments submission**. No comments that add to those in the original paper will be considered for entry.

5. No copy of the third party requester's November 8, 2010 written comments will be maintained in the record, or elsewhere in the Office.
6. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

1-19-11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,381	06/09/2010	7,532,537	043326-000-0019	4993
20995	7590	06/29/2011	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			ART UNIT	PAPER NUMBER

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JUN 29 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001381
PATENT NO. : 7532537
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,381

1. THIS IS A DECISION ON THE PETITION FILED 24 June 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 14 June 2011 which sets a one (1) month period for filing a response to the Office action, be extended by two (2 months).

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☒ Granted or ☐ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- B. ☒ Other/comment: see attached
- C. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)



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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,388	07/01/2010	7606382	2989.001REX0	8186
29053	7590	01/18/2011	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			ART UNIT	PAPER NUMBER

DATE MAILED: 01/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

Date:

MAILED

JAN 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001388
PATENT NO. : 7606382
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,388

1. THIS IS A DECISION ON THE PETITION FILED 04 January 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 21 December 2010 which sets a one (1) month period for filing a response thereto, be extended by and additional one (1) month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☒ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for 2 additional weeks, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment: _____ see attached discussion _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/Mark Reinhart/
[Signature]

(Title)

SPE AU 3992__



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,388	07/01/2010	7606382	2989.001REX0	8186
29053	7590	10/06/2011	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784			ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes K/S HIMPP, LLC

v.

Hear-Wear Technologies, LLC

Reexamination Control No. 95/001,388

Patent No. 7,606,382

Technology Center 3900

DECISION ON PETITION

This is a decision on the patent owner's "Petition Under 37 C.F.R. § 1.182 for the Patent Office to Return Third Party Requester Appeal Brief," filed on August 5, 2011 (petition #1). The petition requests that the requester's appellant brief of July 25, 2011, be returned and expunged for not being compliant with the applicable statutes and rules. The petition fee of \$400 has been charged to petitioner's credit card on August 8, 2011, as authorized on the last page of the petition.

Inter Partes Reexamination Control No. 95/001,388
Patent No. 7,606,382

This is also a decision on “Requester’s Opposition to Patent Owner’s Petition Under 37 C.F.R. § 1.182,” filed on September 8, 2011 (opposition). The opposition asserts that the appeal brief is proper, and argues that patent owner’s rationales are improper and do not “substantiate” expunging the brief. The petition fee of \$400 has been charged to petitioner’s deposit account on October 5, 2011, as authorized on the last page of the opposition.

This is further a decision on the patent owner’s “Petition Under 37 C.F.R. § 1.182 for the Patent Office to Determine that Third Party Requester’s Respondent Brief is Non-compliant and should be Returned,” filed on September 20, 2011 (petition #2). The petition requests that the requester’s respondent brief of August 25, 2011, be returned for not being compliant with the applicable rules. The petition fee of \$400 has been charged to petitioner’s credit card on September 21, 2011, as authorized on the last page of the petition.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. A request for *inter partes* reexamination of U.S. Patent No. 7,606,382 was filed on July 1, 2010, and was assigned control no. 95/001,388.
2. On August 10, 2010, reexamination was ordered, and a non-final Office action was mailed.
3. Prosecution was conducted and on April 25, 2011, a Right of Appeal Notice (RAN) was mailed.
4. Patent owner filed a Notice of Appeal on May 23, 2011, and requester filed a Notice of Cross-Appeal on May 25, 2011.
5. Both patent owner and requester filed an appellant brief on July 25, 2011.

Inter Partes Reexamination Control No. 95/001,388
Patent No. 7,606,382

6. Patent owner filed petition #1 on August 5, 2011.
7. Both patent owner and requester filed a respondent brief on August 25, 2011.
8. Requester filed an opposition to the petition on September 8, 2011.
9. Patent owner filed petition #2 on September 20, 2011.

DISCUSSION

Patent owner's petition #1 requests that the requester's appellant brief of July 25, 2011, be rejected and expunged because the brief includes an issue for review that is not properly appealable by the requester, and it is asserted that entry of the brief prejudices patent owner's rights on appeal. Petition #1 points out that page 7 of the requester's brief includes the issue that "the Office correctly adopted Proposed Rejections 1-6 of claims 1-6 presented in the Request and associated claim charts (filed July 1, 2010), and why the adopted rejections should be affirmed." Petitioner asserts that this is not a decision favorable to patentability, therefore it is not an issue that requester can properly appeal, and therefore not a proper subject for requester's appeal brief. The requester's opposition contends that the inclusion of this issue is proper because it is presented as background information relating to previous arguments by requester, previous arguments by patent owner and previous findings by the Office.

Patent owner's petition #2 requests that the requester's respondent brief of August 25, 2011, be rejected because the brief does not provide a statement that accepts or disputes Patent Owner's summary of the claimed subject matter as present in Patent Owner's Appeal Brief and therefore violates 37 C.F.R.

§ 41.68(b)(1)(v). Patent owner asserts that arguments characterizing the claims do not belong in the summary of claimed subject matter, *e.g.*, "The '382 patent claims are directed to well-known concepts, such as modular hearing aids including

Inter Partes Reexamination Control No. 95/001,388

Patent No. 7,606,382

behind-the-ear components and connectors.” Patent owner contends that such statement is mere advocacy and therefore an improper statement for the summary of claimed subject matter. Petition #2 further asserts that other sections of the requester’s respondent brief similarly lack a statement that accepts or disputes the patent owner’s statement in the corresponding sections of the appellant’s brief, *e.g.*, Status of claims, Status of amendments, and Issues to be reviewed on appeal.

RELEVANT AUTHORITY

35 U.S.C. 134(c) states:

THIRD-PARTY.- A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

35 U.S.C. 315(b) states:

THIRD-PARTY REQUESTER.- A third-party requester-

(1) may appeal under the provisions of section 134, and may appeal under the provisions of sections 141 through 144, with respect to any final decision favorable to the patentability of any original or proposed amended or new claim of the patent; and

(2) may, subject to subsection (c), be a party to any appeal taken by the patent owner under the provisions of section 134 or sections 141 through 144.

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

Inter Partes Reexamination Control No. 95/001,388

Patent No. 7,606,382

MPEP 2675 states in pertinent part:

...
Third party requesters are reminded that their briefs in appeal cases must be responsive to each examiner determination of patentability (determination of inapplicability of a proposed rejection) which the third party requester-appellant contests.

...
37 C.F.R. § 41.68(b)(1)(v) states:

(a)

(1) Respondent(s) in an appeal may once, within the time limit for filing set forth in § 41.66, file a respondent brief and serve the brief on all parties in accordance with § 1.903 of this title.

(2) The brief must be signed by the party, or the party's duly authorized attorney or agent, and must be accompanied by the requisite fee set forth in § 41.20(b)(2).

(3) The respondent brief shall be limited to issues raised in the appellant brief to which the respondent brief is directed.

(4) A requester's respondent brief may not address any brief of any other requester.

(b)

(1) The respondent brief shall contain the following items under appropriate headings and in the order here indicated, and may include an appendix containing only those portions of the record on which reliance has been made.

(i) *Real Party in Interest*. A statement identifying by name the real party in interest.

(ii) *Related Appeals and Interferences*. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to respondent, the respondent's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a

bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (b)(1)(ix) of this section.

(iii) *Status of claims.* A statement accepting or disputing appellant's statement of the status of claims. If appellant's statement of the status of claims is disputed, the errors in appellant's statement must be specified with particularity.

(iv) *Status of amendments.* A statement accepting or disputing appellant's statement of the status of amendments. If appellant's statement of the status of amendments is disputed, the errors in appellant's statement must be specified with particularity.

(v) *Summary of claimed subject matter.* A statement accepting or disputing appellant's summary of the subject matter defined in each of the independent claims involved in the appeal. If appellant's summary of the subject matter is disputed, the errors in appellant's summary must be specified.

(vi) *Issues to be reviewed on appeal.* A statement accepting or disputing appellant's statement of the issues presented for review. If appellant's statement of the issues presented for review is disputed, the errors in appellant's statement must be specified. A counter statement of the issues for review may be made. No new ground of rejection can be proposed by a requester respondent.

(vii) *Argument.* A statement accepting or disputing the contentions of appellant with each of the issues presented by the appellant for review. If a contention of the appellant is disputed, the errors in appellant's argument must be specified, stating the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Each issue must be treated under a separate heading. An argument may be made with each of the issues stated in the counter statement of the issues, with each counter-stated issue being treated under a separate heading.

(viii) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by

respondent in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the respondent's brief. See § 41.63 for treatment of evidence submitted after appeal.

(ix) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (b)(1)(ii) of this section.

(x) *Certificate of service*. A certification that a copy of the respondent brief has been served in its entirety on all other parties to the reexamination proceeding. The names and addresses of the parties served must be indicated.

(2) A respondent brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(c) If a respondent brief is filed which does not comply with all the requirements of paragraph (a) and paragraph (b) of this section, respondent will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended brief. If respondent does not file an amended respondent brief within the set time period, or files an amended respondent brief which does not overcome all the reasons for non-compliance stated in the notification, the respondent brief and any amended respondent brief by that respondent will not be considered.

ANALYSIS

Petition #1 and the opposition have been considered fully. A petition under 37 C.F.R. § 1.182 to strike another party's submission is appropriate if a submission is improper. A review of the record reveals that the requester's appellant brief of July 25, 2011, sets forth three (3) issues on appeal on page 7.

Inter Partes Reexamination Control No. 95/001,388
Patent No. 7,606,382

Issue 3 is stated as “the Office correctly adopted Proposed Rejections 1-6 of claims 1-6 presented in the Request and associated claim charts (filed July 1, 2010), and why the adopted rejections should be affirmed.” The “Arguments” section includes numerous pages devoted to this issue. It is agreed that this issue is not appropriate for a requester’s appellant brief because it is not an issue “favorable to the patentability of any original or proposed amended or new claim of a patent” pursuant to 35 U.S.C. 143(c) and 35 U.S.C. 315(b). This issue and the accompanying arguments are appropriate for a requester’s respondent brief. Therefore, the requester’s appellant brief of July 25, 2011, is not in compliance with 35 U.S.C. 143(c) and 35 U.S.C. 315(b), and therefore is **not entered**.

Petition #2 has been considered fully. A review of the record reveals that the requester’s respondent brief of August 25, 2011, includes the appropriate section headings, but as pointed out by patent owner, the content under the headings does not include a statement that accepts or disputes Patent Owner’s Status of claims, Status of amendments, Summary of the claimed subject matter, and Issues to be reviewed on appeal. Therefore, the requester’s respondent brief of August 25, 2011, is not in compliance with 37 C.F.R. § 41.68, and therefore is **not entered**.

Accordingly, the patent owner’s petition #1 is **granted**, and requester’s opposition is **denied**.

Patent owner’s petition #2 is **granted**.

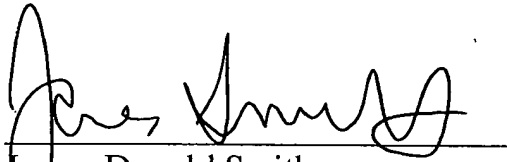
CONCLUSION

In view of the foregoing, the petitions are GRANTED.

Requester hereby is given one opportunity to file a corrected appellant brief in compliance with 35 U.S.C. 143(c) and 35 U.S.C. 315(b), and a corrected

Inter Partes Reexamination Control No. 95/001,388
Patent No. 7,606,382

respondent brief in compliance with 37 C.F.R. § 41.68, within a non-extendable time period of one (1) month from the mailing date of this decision. If a compliant appellant brief is not timely received, the requester's appeal will be dismissed. If a corrected respondent brief is not timely received, then the appeal will proceed without consideration of requester's respondent brief.


James Donald Smith
Chief Administrative Judge

COUNSEL FOR PATENT OWNER:

FULBRIGHT & JAWORSKI L.L.P

2200 Ross Avenue

Suite 2800

Dallas, TX 75201-2784

COUNSEL FOR THIRD PARTY REQUESTER:

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

1100 New York Avenue, NW

Washington, DC 20005



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	19749.003	8373
26111	7590	09/29/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MAILED

SEP 29 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.:95/001,389

1. THIS IS A DECISION ON THE PETITION FILED 27 September 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
- Patent owner requests that the period for responding to the Office action mailed on _____, which sets a _____ period for filing a response thereto, be extended by _____.
- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
- A. ☒ Granted or ☐ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE Art Unit 3992
(Title)



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	02/16/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MAILED
Date: FEB 6 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For patent owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

NOVAK, DRUCE & QUIGG, LLP (For requester)
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

MAILED

FEB 16 2011

CENTRAL REEXAMINATION UNIT

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

:
: DECISION
: DISMISSING
: PETITION
:

This is a decision on patent owner's December 21, 2010 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On October 17, 2006 the Office issued U.S. Patent No. 7,123,208 (the '208 patent) to Puente Baliarda *et al.*
2. On July 1, 2010, a first request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent, assigned control No. 95/001,389 ("the '1389 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1389 requester").
3. On August 12, 2010, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1389 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the July 1, 2010 request for reexamination. The order indicated that an Office action was attached.

4. On November 12, 2010, patent owner timely filed a response to the August 12, 2010 Office action.¹
5. On December 3, 2010, a second request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent, assigned control No. 95/001,501 ("the '1501 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the '1501 requester").
6. On December 13, 2010, third party requester timely filed responsive comments.
7. On December 14, 2010, a third request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 37, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent, assigned control No. 95/000,591 ("the '591 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '591 requester").
8. On December 21, 2010, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1389 proceeding and the '591 and '1501 proceedings.
9. On January 25, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1501 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the December 3, 2010 request for reexamination. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
10. On January 31, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 37, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent in the '591 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the December 14, 2010 request for reexamination. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.
11. To date, an Office action has issued in the '1389 *inter partes* reexamination proceeding and no Office action has issued in the '591 and '1501 *inter partes* reexamination proceedings for the '208 patent.

DECISION

Patent owner's December 21, 2010 petition is dismissed. Initially, it is to be noted that, once all proceedings are ordered, the proceedings are ripe for consideration of whether or not to merge proceedings, and the Office's decision on whether or not to merge is within the sole discretion of the Office.² In this instance, as all of the reexamination proceedings have been ordered, a

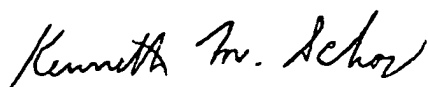
¹ The Office granted patent owner's request for a one month extension of time to file a response.

² MPEP 2686.01 I

determination will be made in due course as to whether or not the Office will exercise its sole discretion to merge for the present situation.³ In addition, should a decision be made to merge, procedures are in place to accommodate the merging of proceedings where an outstanding Office action exists.⁴ Accordingly, there is no basis to suspend proceedings in this instance.

CONCLUSION

1. Patent owner's December 21, 2010 petition is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

³ MPEP 2686.01 III

⁴ MPEP 2686.01 III



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	02/24/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MAILED
Date: FEB 24 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Michael Q. Lee : (For Patent Owner)
STERNE, KESSLER, GOLDSTEIN :
& FOX P.L.L.C. :
1100 NEW YORK AVE., NW :
WASHINGTON, DC 20005 :

MAILED

FEB 24 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUISIANA STREET :
53RD FLOOR :
HOUSTON, TX 77002 :

In re: Puente Baliarda et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,389 : UNDER 37 CFR § 1.181
Deposited: July 1, 2010 :
For: U.S. Patent No.: 7,123,208 :

This is a decision on a petition filed by the patent owner on January 31, 2011, entitled:
"PETITION UNDER 37 C.F.R. § 1.181 TO DENY REQUESTER'S REQUEST TO
REINSTATE PUENTE BALIARDA DISSERTATION AS AN SNQ, AND TO HOLD
REQUESTER'S WRITTEN COMMENTS AS IMPROPER" [hereinafter "the Petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to
review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,123,208 issued on October 17, 2006.
- A request for *inter partes* reexamination was filed on July 1, 2010 and assigned control no. 95/001,389.
- *Inter partes* reexamination was ordered and a non-final rejection was mailed on August 12, 2010.
- On November 12, 2010, patent owner responded to the Office action.
- On December 13, 2010, the third party requester filed comments to the patent owner's response.
- On January 31, 2011, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 312 Determination of issue by Director

- (a) REEXAMINATION. — Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.
- (b) RECORD. — A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.
- (c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

II. CONTENT

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

* * *

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response . . . , the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

DECISION

Patent owner ["petitioner"] argues that the third party requester's comments filed December 13, 2010 are improper because they are directed to issues other than those raised by the Office action or the patent owner's response. In particular, the comments at pages 39-40 argue that the examiner should reconsider his decision refusing to grant certain proposals as substantial new questions of patentability.


35 U.S.C. § 312 and 37 CFR § 1.927 make clear that an examiner's determination as to the existence of a substantial new question of patentability is final and non-appealable. This determination is therefore not an issue to be argued during the examination stage of the proceeding. Furthermore, 35 U.S.C. § 314(b)(2) only permits third party comments "addressing the action of the Office or the patent owner's response thereto." *See also* 37 CFR § 1.947 ("These comments shall be limited to issues raised by the Office action or the patent owner's response."). The examiner's determination was made in the Order Granting the Request for *Inter Partes* Reexamination. The Order is separate and distinct from the Office action. Neither the Office action nor the patent owner's response substantively raised this issue, therefore the third party comments are not "addressing issues raised by the action of the Office or the patent owner's response thereto" as required by the statute. The comments are therefore improper and are expunged from the record. In accordance with MPEP § 2666.05, the third party has fifteen days from the mailing date of this decision to rectify and refile the comments, limiting them only to issues raised by the Office action and patent owner's response.

Accordingly, the petition is granted.

CONCLUSION

1. The petition filed January 31, 2011 is granted. The third party comments filed December 13, 2010 are expunged from the record.
2. The third party has a time period of fifteen (15) days from the mailing date of this decision to rectify and refile the comments. The comments must be directed only to points and issues covered by the Office action and/or the patent owner's response.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	079957.0105	7104
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	06/01/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

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JUL 01 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD. SUITE 1500

AUSTIN, TX 78701-4078

Date:

MAILED

JUL 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001501

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)); and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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Date:

MORRISON & FOERSTER LLP

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SUITE 100

SAN DIEGO, CA 92130-2040

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HOUSTON, TX 77002

(For the '1389 requester)

BAKER BOTTS, LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701

(For the '1501 requester)

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130

(For the '591 requester)

In re Puente Baliarda et al.
Inter Partes Reexamination
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

In re Puente Baliarda et al.
Inter Partes Reexamination
Control No. 95/001,501
Filed: December 3, 2010
For: U.S. Patent No. 7,123,208

In re Puente Baliarda et al.
Inter Partes Reexamination
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No. 7,123,208

MAILED

JUL 01 2011

CENTRAL REEXAMINATION UNIT

DECISION,
SUA SPONTE,
TO MERGE
REEXAMINATION
PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

REVIEW OF FACTS

1. On October 17, 2006 the Office issued U.S. Patent No. 7,123,208 (the '208 patent) to Carles Puente Baliarda *et al.* with 117 claims.
2. On July 1, 2010, a request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,389 ("the '1389 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1389 requester") as the real party in interest.
3. On August 12, 2010, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1389 proceeding. An Office action rejecting all claims subject to reexamination accompanied the order.
4. On November 12, 2010, patent owner timely filed a response to the August 12, 2010 Office action in the '1389 proceeding.¹
5. On December 3, 2010, a second request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,501 ("the '1501 proceeding"). The request identified HTC Corp. and HTC America, Inc. (hereinafter "the '1501 requester") as the real party in interest.
6. On December 13, 2010, third party requester timely filed responsive comments in accordance with 37 CFR 1.947 in the '1389 proceeding.
7. On December 14, 2010, a third request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 37, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/000,591 ("the '591 proceeding"). The request identified Kyocera Communications, Inc. (hereinafter "the '591 requester") as the real party in interest.
8. On January 25, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1501 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
9. On January 31, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent in the

¹ The Office granted patent owner's request for a one month extension of time to file a response.

'591 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

10. To date, an Office action has issued in the '1389 *inter partes* reexamination proceeding and no Office action has issued in the '591 and '1501 *inter partes* reexamination proceedings for the '208 patent.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,389, 95/001,501 and 95/000,591 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).² First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a

² Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '591 *inter partes* third party requester did not propose any rejections of claims 18, 37, and 46-47 in their request for reexamination, the '591 requester has no appeal rights as to those claims as they appear in the '208 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://spportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

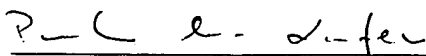
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,389, 95/001,501 and 95/000,591 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	3008.008REX2	7104
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: **MAILED**
JUN 21 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD. SUITE 1500

AUSTIN, TX 78701-4078

MAILED

Date:

01/21/2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001501

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date: **MAILED**

JUN 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591

PATENT NO. : 7123208

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Patent Owner)

**NOVAK, DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET,
FIFTY-THIRD FLOOR
HOUSTON, TX 77002**

(For 95/001,389 Third Party Requester)

MAILED

JUN 21 2011

'CENTRAL REEXAMINATION L

BAKER BOTTS LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4078

(For 95/001,501 Third Party Requester)

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

(For 95/000,591 Third Party Requester)

***Inter Partes* Reexamination Proceeding**
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

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Inter Partes Reexamination Proceeding
Control No. 95/001,501
Filed: December 3, 2010
For: U.S. Patent No. 7,123,208

: DECISION
: ON PETITION
: UNDER 37 CFR 1.183

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No. 7,123,208

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,389.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **dismissed as unnecessary** for the reasons set forth below.

BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Baliarda *et al.*
2. On July 1, 2010, a third party requester filed a request for *inter partes* reexamination of the '208 patent, which request was assigned Reexamination Control No. 95/001,389 (the '1389 proceeding).
3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the '1389 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On November 12, 2010, patent owner filed a response to the August 12, 2010 Office action.¹
5. On March 7, 2011, third party requester filed corrected comments after the August 12, 2010 Office action and patent owner's November 12, 2010 response.²
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's November 12, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 12, 2010 Office action (patent owner corrected response submission).
8. On April 29, 2011, third party requester filed comments after the August 12, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).
9. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1389 proceeding with *inter partes* reexamination proceeding

¹ On September 29, 2010, the Office mailed a decision granting patent owner's September 27, 2010 petition for a one-month extension of time.

² On February 24, 2011, the Office mailed a decision granting patent owner's January 31, 2011 petition under 37 CFR 1.181 and expunging the '1389 requester's December 13, 2010 comments submission and giving the '1389 requester 15 days from the mailing date of that decision to file corrected comments.

control no. 95/001,501 (the '1501 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,591 (the '591 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1389 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 22 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).³ Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."⁴ Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."⁵

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.⁶ Additionally, patent owner asserts that "the full length of the Corrected Response and the 132 declarations are needed to fully and adequately

³ Patent owner petition under 37 CFR 1.183 at page 2.

⁴ *Id.* (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (9 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

⁵ *Id.*

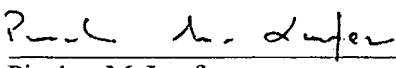
⁶ *Id.* at pages 2-4.

respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference over 170 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination.”⁷ Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁸ As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner’s November 12, 2010 original response submission to patent owner’s April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the ‘1389 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner’s April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.⁹ Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner’s April 11, 2011 corrected response submission. Accordingly, patent owner’s request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner’s April 11, 2011 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.
2. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.


Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-17-2011

⁷ Id. at page 5.

⁸ Id.

⁹ 21 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 24-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, the portions of the 9-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” that are subject to the regulatory page limit count do not cause the total number of pages of patent owner’s April 11, 2011 corrected response submission to exceed the 50-page limit. It is noted that the pages of the “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132,” the “Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132,” and the “Declaration of Rubén Bonet Under 37 C.F.R. § 1.132” do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as “Exhibit 5B” and “Exhibit 6” also do not count toward the regulatory page limit.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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26111	7590	08/03/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 08/03/2011

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1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
AUG 03 2011
CENTRAL REEXAMINATION

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,389 & 95/001,501
& 95/001,591

1. THIS IS A DECISION ON THE PETITION FILED 28 July 2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action dated 01 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
 - B. ☒ Other/comment: see attached
 - C. ☐ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: see attachment.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings as well as the overall length of the reexaminations if added together before council, concurrent with preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

It is further noted that the petition raises questions about the need for declaratory evidence pursuant to 37 CFR § 1.132. The time needed to gather such evidence does support sufficient cause for a one (1) month extension of time.

The requirement for reasonably diligent behavior by the patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time.

Per MPEP § 2665 (in-part)

"First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added)

On balance there is "sufficient cause" to grant-in-part the petition for extension of time for a period of one (1) month.

The petition for extension of time is hereby granted-in-part.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373

26111 7590 09/28/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 09/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

SEP 28 2011

CENTRAL REEXAMINATION

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,501; 95/001,389; 95/000,591

1. THIS IS A DECISION ON THE PETITION FILED September 23, 2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on July 1, 2011, which sets a 2-month period for filing a response thereto, be extended by another 2 months. A first request for a two month extension being granted in part (for one month) on August 3, 2011.
 - A. ☒ Petition fee per 37 CFR §1.17(g)):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☒ Other: electronically submitted.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____
 - B. ☒ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☒ Other/comment: A pending petition to terminate 1 of the 3 merged proceedings does not constitute extraordinary circumstances as to why patent owner needs additional time.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.



[Signature]

ERIC S. KEASEL
CRU SPE-AU 3992

(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389 + 95/001,501 + 95/000,591	07/01/2010	7123208	3008.008REX0	8373
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: 11-18-11

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389 + 95/001501 + 95/000591
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

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BAKER BOTTS LLP (For 95/001,501 Third Party Requester)
PATENT DEPARTMENT
98 SAN JACINTO BLVD, SUITE 1500
AUSTIN, TX 78701-4039

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,501
Filed: December 3, 2010
For: U.S. Patent No. 7,123,208

**DECISION
ON PETITION
UNDER 37 CFR 1.183**

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,591, 95/001,389 and 95/001,501.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

RELEVANT BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,389, 95/001,501, and 95/000,591, were instituted by the Office.
3. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1389 proceeding with the '1501 and '591 proceedings (the merged proceeding).
4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.
5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).¹

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

¹ On August 3 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office Action.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 123 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.² Patent owner states that it concurrently filed "a number of 132 declarations" but asserts that the declarations "include only facts and thus does not count towards the 50-page limit."³ Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit..."⁴

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.⁵ Additionally, patent owner asserts that "the full length of the Response is needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 35 pages, it incorporates by reference almost 800 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination."⁶ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."⁷

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),⁸ and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),⁹ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent

² Patent owner petition under 37 CFR 1.183 at page 2.

³ Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

⁴ Id. at page 2.

⁵ Id. at pages 4-7.

⁶ Id. at page 2-3.

⁷ Id. at page 3.

⁸ 123 pages of the remarks portion of patent owner's October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 23-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 143 pages of the patent owner's October 3, 2011 response submission count toward the 50-page limit.

⁹ On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 35 pages, but it incorporates by reference numerous pages from the '1389, '1501 and '591 requests for *inter partes* reexamination and comments submissions.

owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

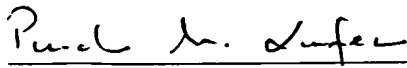
CONCLUSION

1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.
2. The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

Reexamination Control No. 95/000,591
Reexamination Control No. 95/001,389
Reexamination Control No. 95/001,501

-6-

3. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

11-17-2011



United States Patent and Trademark Office

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DEC 12 2011

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CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* '1501 Requester)

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Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1389 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No.: 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,501
Filed: December 03, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No: 95/001,389
Filed: July 01, 2010
For: U.S. Patent No. 7,123,208

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,501, filed on September 16, 2011, is granted.

Inter partes reexamination proceeding control number 95/001,501 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,501, 95/000,591 and 95/001,389.

Inter partes reexamination proceeding 95/001,501, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,501 (the '1501 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1501 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '591 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision, which will issue in due course.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '208 patent, which is the patent under reexamination in the '1501 proceeding, are listed in the consent judgment as claims 1, 5, 7, 10-12, 14, 15, 18, 21, 24-26, 28, 29, 33, 37, 40, 43-48, 54, 57-59 and 61, which are identical to the claims that were requested to be reexamined by HTC in the '1501 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '208 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1501 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/001,501 (the '1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501, 95/000,591 and 95/001,389.

Inter partes reexamination proceeding control no. 95/001,501 (the '1501 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue**.² Any rejection proposed by HTC (the requester of the '1501 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

² As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '591 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.³ As noted in the June 1, 2011 decision entitled “Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings” (the June 1, 2011 merger decision), because the requester of the ‘591 proceeding did not propose any rejections of claims 18, 37, and 46-47 in its request for reexamination, the requester of the ‘591 proceeding has no appeal rights as to those claims as they appear in the ‘208 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,591 and 95/001,389, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,591 and 95/001,389 will otherwise remain, in general, as outlined by the June 1, 2011 merger decision.

The ‘1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM “Application Number Information” screen and the “Contents” screen will be printed, the printed copy will be annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner’s September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,501 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,501 (the ‘1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501, 95/000,591 and 95/001,389.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.
- The prosecution of the ‘1501 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The ‘1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the ‘1501 proceeding, as set forth in this decision.

³ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester’s comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner’s amendment, if requester’s comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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HOUSTON, TX 77002

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Date: DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000591
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For *Inter Partes* '591 Requester) DEC 12 2011

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(For *Inter Partes* '1389 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No.: 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,389
Filed: July 01, 2010
For: U.S. Patent No. 7,123,208

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:¹

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,501, was granted. *Inter partes* reexamination proceeding 95/001,501 was severed from the merger of *inter partes* reexamination proceedings 95/001,501, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,591, filed on September 30, 2011, is dismissed.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is dismissed.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,591 (the '591 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '591 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '208 patent's claims 1, 5, 7, 10-12, 14, 15, 18, 21, 24-26, 28, 29, 33, 37, 40, 41, 43-47, 48, 54, 57-59 and 61, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to

expunge, discussed below), the patent owner informs the Office that “[t]he Final Consent Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 5, 7, 10-12, 14, 15, 21, 24-26, 28, 29, 33, 40, 43-45, 48, 54, 57-59 and 61 of the ‘208 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘591 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘591 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

² The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is dismissed.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘591 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so,

whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '591 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,591 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in black ink, reading "Brian E. Hanlon". The signature is written in a cursive style with a horizontal line underneath.

Brian E. Hanlon
Director
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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Date: **MAILED**

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001389 + 95000591
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

FEB 27 2012

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(For *Inter Partes* '1389 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No.: 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,389
Filed: July 01, 2010
For: U.S. Patent No. 7,123,208

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,389 (the '1389 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1389 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,501. *Inter partes* reexamination proceeding 95/001,501 was severed from the merger of *inter partes* reexamination proceedings 95/001,501, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,591 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,591 (the '591 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '591 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '591 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '591 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,591 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	19749.003	8872
26111	7590	10/07/2010	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 10/07/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

OCT 07 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,390

1. THIS IS A DECISION ON THE PETITION FILED 27 September 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
- Patent owner requests that the period for responding to the Office action mailed on 19 August 2010 which sets a two (2) months period for filing a response thereto, be extended by one (1) month
- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: _____
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
- A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)

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of Time in Reexamination**

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- D. ☒ Petition properly signed.

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/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)

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☐ Other/comment: _____.
 - B. ☐ Dismissed because:
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/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,390
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B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.

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iii. ☐ Other: _____.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

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ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 .In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[Signature]	(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	19749.003	8872
26111	7590	02/16/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/16/2011

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(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
FEB 6 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

(For patent owner)

NOVAK, DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

(For requester)

MAILED
JUL 16 2010
CENTRAL REEXAMINATION UNIT

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,390
Filed: July 2, 2010
For: U.S. Patent No. 7,015,868

:
: DECISION
: DISMISSING
: PETITION
:

This is a decision on patent owner's December 21, 2010 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On March 12, 2006 the Office issued U.S. Patent No. 7,015,868 (the '868 patent) to Puente Baliarda *et al.*
2. On July 2, 2010, a first request for *inter partes* reexamination of claims 1, 3, 6, 12-14, 23, 26, and 32-35 of the '868 patent, assigned control No. 95/001,390 ("the '1390 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1390 requester").
3. On August 12, 2010, *inter partes* reexamination was ordered on claims 1, 3, 6, 12-14, 23, 26, and 32-35 of the '868 patent in the '1390 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the July 2, 2010 request for reexamination. The order indicated that an Office action was attached, but an Office action was not concurrently issued. An Office action was issued on August 19, 2010.

4. On November 16, 2010, a second request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent, assigned control No. 95/000,589 ("the '589 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '589 requester").
5. On November 19, 2010, patent owner timely filed a response to the August 19, 2010 Office action.¹
6. On December 3, 2010, a third request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent, assigned control No. 95/001,498 ("the '1498 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the '1498 requester").
7. On December 20, 2010, third party requester timely filed responsive comments.
8. On December 21, 2010, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1390 proceeding and the '589 and '1498 proceedings.
9. On January 13, 2011, *inter partes* reexamination was ordered on claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '589 proceedings based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the November 16, 2010 request for reexamination. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
10. On January 25, 2011, *inter partes* reexamination was ordered on claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '1498 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the December 3, 2010 request for reexamination. An Office action was not concurrently issued in either proceeding. The orders indicated that Office actions would issue in due course.
11. To date, an Office action has issued in the '1390 *inter partes* reexamination proceeding and no Office action has issued in the '589 and '1498 *inter partes* reexamination proceedings for the '868 patent.

DECISION

Patent owner's December 21, 2010 petition is dismissed. Initially, it is to be noted that, once all proceedings are ordered, the proceedings are ripe for consideration of whether or not to merge proceedings, and the Office's decision on whether or not to merge is within the sole discretion of the Office.² In this instance, as all of the reexamination proceedings have been ordered, a determination will be made in due course as to whether or not the Office will exercise its sole discretion to merge for the present situation.³ In addition, should a decision be made to merge,

¹ The Office granted patent owner's request for a one month extension of time to file a response.

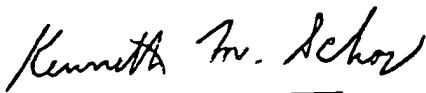
² MPEP 2686.01 I

³ MPEP 2686.01 III

procedures are in place to accommodate the merging of proceedings where an outstanding Office action exists.⁴ Accordingly, there is no basis to suspend proceedings in this instance.

CONCLUSION

1. Patent owner's petition is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

⁴ MPEP 2686.01 III



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UNITED STATES DEPARTMENT OF COMMERCE
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2011

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HOUSTON, TX 77002

Date:

MAILED
FEB 24 2010
CENTRAL REEXAMINATION UNIT

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Michael Q. Lee : (For Patent Owner)
STERNE, KESSLER, GOLDSTEIN :
& FOX P.L.L.C. :
1100 NEW YORK AVE., NW :
WASHINGTON, DC 20005 :

MAILED

FEB 24 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUISIANA STREET :
53RD FLOOR :
HOUSTON, TX 77002 :

In re: Puente Baliarde et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,390 : UNDER 37 CFR § 1.181
Deposited: July 2, 2010 :
For: U.S. Patent No.: 7,015,868 :

This is a decision on a petition filed by the patent owner on January 31, 2011, entitled:
"PETITION UNDER 37 C.F.R.. § 1.181 TO DENY REQUESTER'S REQUEST TO
REINSTATE NON-ADOPTED SNQS, AND TO HOLD REQUESTER'S WRITTEN
COMMENTS AS IMPROPER" [hereinafter "the Petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to
review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,015,868 issued on March 21, 2006.
- A request for *inter partes* reexamination was filed on July 2, 2010 and assigned control no. 95/001,390.
- *Inter partes* reexamination was ordered on August 12, 2010 and a non-final rejection was mailed on August 19, 2010.
- On November 19, 2010, patent owner responded to the Office action.
- On December 20, 2010, the third party requester filed comments to the patent owner's response.
- On January 31, 2011, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 312 Determination of issue by Director

- (a) REEXAMINATION. — Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.
- (b) RECORD. — A record of the Director's determination under subsection (a) shall be placed in the official file of the patent, and a copy shall be promptly given or mailed to the owner of record of the patent and to the third-party requester.
- (c) FINAL DECISION. — A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the *inter partes* reexamination fee required under section 311.

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

II. CONTENT

The third party requester comments must be directed to points and issues covered by the Office action and/or the patent owner's response.

* * *

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response . . . , the written comments are improper. If the written comments are improper, the examiner should return the written comments (the entire paper) with an explanation of what is not proper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the third party requester. The notification to the third party requester is to provide a time period of fifteen (15) days for the third party requester to rectify and refile the comments. If, upon the second submission, the comments are still not proper, the comments will be returned to third party requester with an explanation of what is not proper, and at that point the comments can no longer be resubmitted. The loss of right to submit further comments applies only to the patent owner response at hand. See MPEP § 2666.20. To the extent that 37 CFR 1.947 provides that the third party requester "may once" file written comments, that provision is hereby waived to the extent of providing the third party requester the one additional opportunity to remedy a comments paper containing merits-content that goes beyond what is permitted by the rules; 37 CFR 1.947 is not waived to provide any further opportunity in view of the statutory requirement for special dispatch in reexamination.

Any replacement comments submitted in response to the notification must be strictly limited to (i.e., must not go beyond) the comments in the original (returned) comments submission. No comments that add to those in the returned paper will be considered for entry.

DECISION

Patent owner ["petitioner"] argues that the third party requester's comments filed December 20, 2010 are improper because they are directed to issues other than those raised by the Office action or the patent owner's response. In particular, the comments at page 41 argue that the examiner should reconsider his decision refusing to grant certain proposals as substantial new questions of patentability.

35 U.S.C. § 312 and 37 CFR § 1.927 make clear that an examiner's determination as to the existence of a substantial new question of patentability is final and non-appealable. This determination is therefore not an issue to be argued during the examination stage of the proceeding. Furthermore, 35 U.S.C. § 314(b)(2) only permits third party comments "addressing the action of the Office or the patent owner's response thereto." *See also* 37 CFR § 1.947 ("These comments shall be limited to issues raised by the Office action or the patent owner's response."). The examiner's determination was made in the Order Granting the Request for *Inter Partes* Reexamination. The Order is separate and distinct from the Office action. Neither the Office action nor the patent owner's response substantively raised this issue, therefore the third party comments are not "addressing issues raised by the action of the Office or the patent owner's response thereto" as required by the statute. The comments are therefore improper and are expunged from the record. In accordance with MPEP § 2666.05, the third party has fifteen days from the mailing date of this decision to rectify and refile the comments, limiting them only to issues raised by the Office action and patent owner's response.

Accordingly, the petition is granted.

CONCLUSION

1. The petition filed January 31, 2011 is granted. The third party comments filed December 20, 2010 are expunged from the record.
2. The third party has a time period of fifteen (15) days from the mailing date of this decision to rectify and refile the comments. The comments shall be limited to issues raised by the Office action and/or the patent owner's response.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	05/23/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/23/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAY 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, DC 20005

(For Patent Owner)

MAILED

MAY 23 2011

Baker Botts, LLP
Patent Department
98 San Jacinto Blvd.
Suite 1500
San Antonio, TX 78701-4039

(For 95/001,498 Requester) CENTRAL REEXAMINATION

Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

(For 95/000,589 Requester)

Novak Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, TX 77002

(For 95/001,390 Requester)

In re Carles Puente Baliarde et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,498
Filed: December 3, 2010
For: U.S. Patent No. 7,015,868

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In re Carles Puente Baliarde et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,589
Filed: November 16, 2010
For: U.S. Patent No. 7,015,868

: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**
:
:
:

In re Carles Puente Baliarde et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,390
Filed: July 2, 2010
For: US. Patent No. 7,015,868

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,015,868 (“the ‘868 patent”) issued to Carles Puente Baliarde et al. on March 21, 2006, with 37 claims.
2. A request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent was filed on July 2, 2010, by a third party requester, and was assigned control number 95/001,390 (“the ‘1390 *inter partes* proceeding”). The real party in interest is Samsung Electronics Co. Ltd.
3. On August 12, 2010, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent in the ‘1390 *inter partes* proceeding based on the examiner’s determination that the July 2, 2010 request raised a substantial new question of patentability affecting these claims. The order was followed by a non-final rejection action mailed on August 19, 2010.
4. A second request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent was filed on November 16, 2010, by a third party requester, and was assigned control number 95/000,589 (“the ‘589 *inter partes* proceeding”). The real party in interest is Kyocera Communications, Inc.
5. A third request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent was filed on December 3, 2010, by a third party requester, and was assigned control number 95/001,498 (“the ‘1498 *inter partes* proceeding”). The real party in interest is HTC Corporation and HTC America, Inc.
6. On January 13, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent in the ‘589 *inter partes* proceeding based on the examiner’s determination that the November 16, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the ‘589 proceeding.
7. On January 25, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the ‘868 patent in the ‘1498 *inter partes* proceeding based on the examiner’s determination that the December 3, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the ‘1498 proceeding.
8. On April 11, 2011, patent owner submitted a response to the August 19, 2010 non-final rejection action in the ‘1390 *inter partes* proceeding.¹ The April 11, 2011 patent owner response did not include any amendment to the specification or claims.

¹ Patent owner’s April 11, 2011 response in the ‘1390 *inter partes* proceeding was a corrected response filed in response to a March 25, 2011 Notice Re Defective Paper In Inter Partes Reexamination. The March 25, 2011 Notice stated that patent owner’s original November 19, 2010 response to the August 19, 2010 non-final rejection action was defective.

9. On May 2, 2011, the '1390 requester filed comments to patent owner's April 11, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,390, 95/000,589 and 95/001,498 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a

signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,390, *inter partes* Reexamination No. 95/000,589 and *inter partes* Reexamination Control No. 95/001,498 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. The examiner will issue an Office action for the merged proceeding in due course.
3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	06/20/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,390	07/02/2010	7,015,868	079957.0104

NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
53th FLOOR
HOUSTON, TX 77002

EXAMINER

MENEFEE, JAMES

ART UNIT	PAPER
----------	-------

3992

DATE MAILED:

06/20/11

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,390	07/02/2010	7,015,868	079957.0104

NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
53th FLOOR
HOUSTON, TX 77002

EXAMINER

MENEFEE, JAMES

ART UNIT

PAPER

3992

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 20 2011

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Patent Owner)

BAKER BOTTS LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD.
SUITE 1500
AUSTIN, TX 78701-4039

(For 95/001,498 Third Party Requester)

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130

(For 95/000,589 Third Party Requester)

NOVAK, DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
53RD FLOOR
HOUSTON, TX 77002

(For 95/001,390 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,498
Filed: December 3, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,390
Filed: July 2, 2010
For: U.S. Patent No. 7,015,868

DECISION
ON PETITIONS
UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,390.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,390.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The patent owner petition under 37 CFR 1.183 is **dismissed as unnecessary** and the third party requester petition under 37 CFR 1.183 is **granted** to the extent set forth below.

BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the '868 patent) issued to Baliarde *et al.*
2. On July 2, 2010, a third party requester filed a request for *inter partes* reexamination of the '868 patent, which request was assigned Reexamination Control No. 95/001,390 (the '1390 proceeding).
3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the '1390 proceeding and, on August 19, 2010, the Office issued a non-final Office action.
4. On November 19, 2010, patent owner filed a response to the August 19, 2010 Office action.¹
5. On March 7, 2011, third party requester filed corrected comments after the August 19, 2010 Office action and patent owner's November 19, 2010 response.²
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's November 19, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 19, 2010 Office action (patent owner corrected response submission).
8. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the

¹ On October 7, 2010, the Office mailed a decision granting patent owner's September 27, 2010 petition for a one-month extension of time.

² On February 24, 2011, the Office mailed a decision granting patent owner's January 31, 2011 petition under 37 CFR 1.181 and expunging the '1390 requester's December 20, 2010 comments submission and giving the '1390 requester 15 days from the mailing date of that decision to file corrected comments.

August 19, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

9. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1390 proceeding with *inter partes* reexamination proceeding control no. 95/001,498 (the '1498 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,589 (the '589 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a

response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 39 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).³ Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."⁴ Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."⁵

³ Patent owner petition under 37 CFR 1.183 at page 2.

⁴ *Id.* (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

⁵ *Id.*

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.⁶ Additionally, patent owner asserts that “the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference over 150 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination.”⁷ Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁸ As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 as “Exhibit 1” a redlined document comparing patent owner’s November 19, 2010 original response submission to patent owner’s April 11, 2011 corrected response submission. The “Exhibit 1” document has been expunged from the record of the ‘1390 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner’s April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.⁹ Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner’s April 11, 2011 corrected response submission. Accordingly, patent owner’s request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

IV. Third party requester petition of May 2, 2011

On May 2, 2011, the ‘1390 requester filed, in the ‘1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The ‘1390 requester asserts that the May 2, 2011 comments submission includes “50 pages of double spaced 12 pt font arguments and an 8 page declaration from Dr.

⁶ Id. at pages 2-4.

⁷ Id. at page 5.

⁸ Id. at pages 5-6.

⁹ 38 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page and certificate of service page are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 19-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” that are subject to the regulatory page limit count do not cause the total number of pages of patent owner’s April 11, 2011 corrected response submission to exceed the 50-page limit (e.g., excluded from the page count are portions related to declarant’s qualifications, technical background information, technical explanations of terms of art used by a reference, etc.). It is noted that the pages of the “Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132,” the “Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132,” and the “Declaration of Rubén Bonet Under 37 C.F.R. § 1.132” do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as “Exhibit 2” and “Exhibit 7B” also do not count toward the regulatory page limit.

Balanis under 37 C.F.R. § 1.132.”¹⁰ The ‘1390 requester asserts, however, that “[i]f the Office agrees with [patent owner’s] interpretation of MPEP § 2667(I)(A)(2), then Samsung’s Comments are only 50 pages as Dr. Balanis’s declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue.”¹¹

In support of its request for waiver of the rule, the ‘1390 requester asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 114 page response.”¹² The ‘1390 requester asserts that it “has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit” and “is asking for significantly fewer total pages than [sic] the Patent Owner has submitted,” *i.e.*, requester “is only asking for a total of 58 pages.”¹³ The ‘1390 requester also asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner.”¹⁴

Based on the specific facts set forth in the ‘1390 requester’s petition under 37 CFR 1.183, the ‘1390 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),¹⁵ and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the ‘1390 requester’s May 2, 2011 comments submission exceeds 50 pages. Accordingly, the ‘1390 requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the ‘1390 requester’s May 2, 2011 comments submission. This waiver makes the ‘1390 requester’s May 2, 2011 comments submission page-length compliant.

¹⁰ Third party requester petition under 37 CFR 1.183 at page 1.

¹¹ *Id.* at page 4. The ‘1390 requester is cautioned that statements submitted in opposition to patent owner’s petition under 37 CFR 1.183 are improper and may result in the requester’s petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on pages 3-4 of the third party requester petition under 37 CFR 1.183, the ‘1390 requester presents arguments against patent owner’s position set forth in patent owner’s petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner’s response to an Office action on the merits. Patent owner’s petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner’s corrected response submission, however, is not a “response” to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner’s petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper “closed” and “not public” in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

¹² *Id.* at page 2.

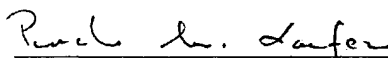
¹³ *Id.*

¹⁴ *Id.*

¹⁵ 50 pages of the remarks portion of the ‘1390 requester’s May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, to the extent portions of the 8-page “Declaration of Dr. Constantine A. Balanis” are subject to the regulatory page limit count, the total number of pages of the May 2, 2011 comments submission exceeds the 50-page limit. In this instance, the pages of the copies of the court documents that were filed as exhibits to the May 2, 2011 comments submission do not count toward the regulatory page limit.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **dismissed as unnecessary**.
2. The '1390 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1390 requester's May 2, 2011 comments submission. This waiver makes the '1390 requester's May 2, 2011 comments submission page-length compliant.
3. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-17-2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
ART UNIT			PAPER NUMBER	

DATE MAILED: 11/18/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,498	12/03/2010	7015868	3008.001REX2	7027
26111	7590	11/18/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: **MAILED**

NOV 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BAKER BOTTS, LLP

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

Date:

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001498

PATENT NO. : 7015868

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
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(For Patent Owner)

MORRISON & FOERSTER LLP
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(For 95/000,589 Third Party Requester)

NOVAK, DRUCE & QUIGG, LLP
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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
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(For 95/001,390 Third Party Requester)

BAKER BOTTS LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

(For 95/001,498 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,390
Filed: July 2, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,498
Filed: December 3, 2010
For: U.S. Patent No. 7,015,868

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

**DECISION
ON PETITION
UNDER 37 CFR 1.183**

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,589, 95/001,390, and 95/001,498.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is granted to the extent set forth below.

RELEVANT BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the '868 patent) issued to Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,390, 95/000,589, and 95/001,498, were instituted by the Office.
3. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1390 proceeding with the '589 and '1498 proceedings (the merged proceeding).
4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.
5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).¹

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

¹ On August 5, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office action.

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 121 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.² Patent owner states that it concurrently filed “a number of 132 declarations” but asserts that the declarations “include only facts and thus does not count towards the 50-page limit.”³ Nonetheless, patent owner also requests waiver of the 50-page limit for “those portions of the 132 Declarations that the PTO holds count towards the 50 page limit....”⁴

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.⁵ Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 44 pages, it incorporates by reference almost 550 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”⁶ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁷

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),⁸ and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),⁹ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

² Patent owner petition under 37 CFR 1.183 at page 2.

³ Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

⁴ Id. at page 2.

⁵ Id. at pages 4-7.

⁶ Id. at page 2-3.

⁷ Id. at page 3.

⁸ 122 pages of the remarks portion of patent owner’s October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 142 pages of the patent owner’s October 3, 2011 response submission count toward the 50-page limit.

⁹ On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 44 pages, but it incorporates by reference numerous pages from the ‘1390, ‘1498 and ‘589 requests for *inter partes* reexamination and comments submissions.

Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the July 1, 2011 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

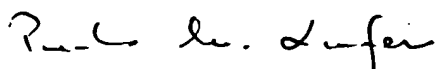
1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is granted and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.
2. The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester each has 30 days from the mailing date of this decision, granting patent

Reexamination Control No. 95/000,589
Reexamination Control No. 95/001,390
Reexamination Control No. 95/001,498

-6-

owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

11-17-2011



United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* '589 Requester)

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(For *Inter Partes* '1498 Requester)

Novak, Druce & Quigg, LLP
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(For *Inter Partes* '1390 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No.: 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,498
Filed: December 03, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No: 95/001,390
Filed: July 02, 2010
For: U.S. Patent No. 7,015,868

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,498, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,498 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,498, 95/000,589 and 95/001,390.

Inter partes reexamination proceeding 95/001,498, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,498 (the '1498 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that "... HTC [the defendant/requester of the '1498 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '589 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '868 patent, which is the patent under reexamination in the '1498 proceeding, are listed in the consent judgment as claims 1, 3, 6, 12, 14, 23, 26, and 32-35, which are identical to the claims that were requested to be reexamined by HTC in the '1498 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '868 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1498 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498, 95/000,589 and 95/001,390.

Inter partes reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue**.² Any rejection proposed by HTC (the requester of the '1498 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

² As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '589 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.³

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,589 and 95/001,390, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,589 and 95/001,390 will otherwise remain, in general, as outlined by the decision, mailed on May 23, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,498 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498, 95/000,589 and 95/001,390.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.
- The prosecution of the '1498 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1498 proceeding, as set forth in this decision.

³ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000589
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HOUSTON, TX 77002

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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DEC 12 2011

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(For *Inter Partes* '1390 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No.: 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,390
Filed: July 02, 2010
For: U.S. Patent No. 7,015,868

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:¹

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,498, was granted. *Inter partes* reexamination proceeding 95/001,498 was severed from the merger of *inter partes* reexamination proceedings 95/001,498, 95/000,589 and 95/001,390, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,589 and 95/001,390.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,589, filed on September 30, 2011, is dismissed.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is dismissed.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,589 (the '589 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '589 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '868 patent's claims 1, 3, 6, 12, 14, 23, 26, 32-35, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘868 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘589 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘589 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

² The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘589 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘589 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,589 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon
Director
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MAILED
FEB 27 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001390 + 95000589
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(For Patent Owner)

Morrison & Foerster, LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

(For *Inter Partes* '589 Requester)

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1390 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No.: 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,390
Filed: July 02, 2010
For: U.S. Patent No. 7,015,868

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,390 (the '1390 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1390 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,498. *Inter partes* reexamination proceeding 95/001,498 was severed from the merger of *inter partes* reexamination proceedings 95/001,498, 95/000,591 and 95/001,389, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,591 and 95/001,389.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,589 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,589 (the '589 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '589 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '589 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '589 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,589 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,391	07/07/2010	7155439	Wellogix-005-1:RE	3547
21897	7590	12/15/2010	EXAMINER	
THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057			ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2010

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121 S.W. SALMON STREET
PORTLAND, OR 97204

Date: **MAILED**

DEC 15 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001391
PATENT NO. : 7155439
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,391

1. THIS IS A DECISION ON THE PETITION FILED 13 December 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 03 November 2010 which sets a 2 month period for filing a response thereto, be extended by and additional 1 month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for 2 additional weeks, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☒ Other/comment: _____ see attached discussion _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/Mark Reinhart/
[Signature]

(Title)

SPE AU 3992__

Analysis and Decision:

In the petition patent owner's representative requests a two-month extension of time to respond to the outstanding office action. Petitioner is newly appointed representation of patent owner.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative has "begun reviewing" the documents received.

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need to consider future evidence, conduct legal research and confer with patent owner regarding the issues raised and weigh all options. Owner further submits counsel will need to review and analyze four other *inter partes* reexamination proceedings prior to filing a response to the outstanding office action.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in an *inter partes* reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council late in the response period, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management.

In consideration of the factual accounting provided by patent owner in the petition balanced with the statutory mandate of conducting reexamination proceedings with special dispatch, it is felt an additional two week period for response is reasonable. Such would result in new counsel having approximately one full month for response.

The petition for extension of time is hereby granted in part for two (2) additional weeks.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,392	07/08/2010	7293029	Wellogix-005-1:D:RE	5176
2292	7590	01/04/2011	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2011

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001392
PATENT NO. : 7293029
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,392

1. THIS IS A DECISION ON THE PETITION FILED December 13, 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on November 19, 2010 which sets a 2 month period for filing a response thereto, be extended by and additional 1 month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for 2 additional weeks, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☒ Other/comment: _____ see attached discussion _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/J. Harrison/
[Signature]

SPE AU 3992_____
(Title)

Analysis and Decision:

In the petition patent owner's representative requests a two-month extension of time to respond to the outstanding office action. Petitioner is newly appointed representation of patent owner.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative has "begun reviewing" the documents received.

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need to consider future evidence, conduct legal research and confer with patent owner regarding the issues raised and weigh all options. Owner further submits counsel will need to review and analyze four other inter partes reexamination proceedings prior to filing a response to the outstanding office action.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch it is noted the instant proceeding was ordered October 4, 2010 and the first office action issued on November 10, 2010. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained counsel in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in an inter partes reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new counsel late in the response period, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new counsel. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management.

In consideration of the factual accounting provided by patent owner in the petition balanced with the statutory mandate of conducting reexamination proceedings with special dispatch, it is felt an additional two week period for response is reasonable. Such would result in new counsel having approximately one full month for response.

The petition for extension of time is hereby granted in part for two additional weeks. Response is due January 24, 2011.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,397	07/16/2010	7669133	Wellogix-004-2:RE	4982
2292	7590	12/13/2010	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER

DATE MAILED: 12/13/2010

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001397
PATENT NO. : 7669133
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,397

1. THIS IS A DECISION ON THE PETITION FILED November 30, 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on November 19, 2010 which sets a 2 month period for filing a response thereto, be extended by and additional 1 month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: electronic payment via EFS.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for 2 additional weeks, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☒ Other/comment: _____ see attached discussion _____.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/J. Harrison/
[Signature]

_____/SPE AU 3992_____
(Title)

Analysis and Decision:

In the petition patent owner's representative requests a two-month extension of time to respond to the outstanding office action. Petitioner is newly appointed representation of patent owner.

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response, patent owner's representative has "begun reviewing" the documents received.

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need to consider future evidence, conduct legal research and confer with patent owner regarding the issues raised and weigh all options. Owner further submits counsel will need to review and analyze four other inter partes reexamination proceedings prior to filing a response to the outstanding office action.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch it is noted the instant proceeding was ordered September 22, 2010 and the first office action issued on October 12, 2010. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in an inter partes reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council late in the response period, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management.

In consideration of the factual accounting provided by patent owner in the petition balanced with the statutory mandate of conducting reexamination proceedings with special dispatch, it is felt an additional two week period for response is reasonable. Such would result in new counsel having approximately one full month for response.

The petition for extension of time is hereby granted in part for two additional weeks. Response is due December 26, 2010 and will be considered timely if received on December 27, 2010.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,397	07/16/2010	7669133	6115-0101L	4982
2292	7590	03/25/2011	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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ONE WORLD TRADE CENTER
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

Date:

MAILED

MAR 25 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001397
PATENT NO. : 7669133
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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(For Patent Owner)

MAILED

MAR 25 2011

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PORTLAND, OR 97204

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,397
Filed: July 16, 2010
For: U.S. Patent No. 7,669,133

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION**

This is a decision on third party requester's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)," filed on January 11, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 90 pages. Subsequently, on January 26, 2011, third party requester timely filed comments under 37 CFR 1.947.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in comments by third party requester is granted to the extent that the page limit for comments by third party requester is extended to not exceed 84 pages in length.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party,

subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments, and requests that the page limit be extended to 90 pages.¹ In support of its request for waiver of the rule, third party requester argues that additional pages are needed to "address the range of Patent Owner arguments made in its Response to the Office Action on the rejected claims" and to include claim charts relating to the numerous newly added claims, as well as any supporting declarations.²

¹ Petition at 2 and 5..

² *Id.* at 4 and 5.

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's January 26, 2011 written comments include 38 pages of remarks, which are subject to the 50 page limit.

The third party requester comments submission is also accompanied by a declaration of Carlos Serrano-Morales under 37 CFR 1.132, Appendix AA, and Exhibits 26-31.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, e.g., arguments that the claims are patentable or unpatentable, or arguments that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, arguments as to how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document includes an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the regulatory page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 13-page declaration of Serrano-Morales, contains legal arguments on 6 pages. Examples of legal arguments in the Serrano-Morales declaration, which are not exhaustive, that count toward the page limit are:

On page 8, in paragraph 32, declarant Serrano-Morales states: "My opinion ... is that ...there is nothing in the description of the domain and the problem being cited in the '133 patent that is significantly different from what was being implemented by reasonably skilled professionals at the time that the '133 patent application was submitted, including professionals working with the very Blaze Advisor system cited in the '133 patent."

On page 9, in paragraph 38, declarant Serrano-Morales states: "The Release of Blaze Advisor 3.2 referred to by the ' 133 patent practiced the claims described in the Kintzer patent, and provided the capability for users of the product to generate their own concrete configurations for the generic embodiments recited in the Kintzer claims. "

On page 10, in paragraph 44, declarant Serrano-Morales states: "...I would consider that these known uses of Blaze Advisor are similar in nature to the uses of parameter validation Wellogix sought to claim in the '133 patent."

On page 11, in paragraph 47, declarant Serrano-Morales states: "...I consider that, in my current understanding of the '133 patent claims as well as the Wellogix Response to Office Action, Wellogix has not provided substance to the "complexity" aspect."

On page 12, in paragraph 50, declarant Serrano-Morales states: "I cannot find anything in the specification or the claims, however, to support a material difference between what is claimed and what was known by a reasonably skilled user of the technologies of the time, including the technology described in the Kintzer patent and other references relating to Blaze Advisor and similar systems."

On pages 12-13, in paragraph 53, declarant Serrano-Morales states: "Most if not all of these applications were implemented leveraging Blaze Advisor in combination with other technologies by reasonably skilled professionals in combinations that correspond to patterns that were well known at the time, including to perform tasks referenced in the Amended claims newly proposed by Wellogix."

Appendix AA is a 40-page claim chart that counts toward the page limit.

Exhibits 26 and 27 are court documents and are free of legal arguments; therefore, they do not count toward the page limit.

Exhibits 28-31 are references and do not count toward the page limit.

Accordingly, the January 26, 2011 third party requester comments submission *in toto* is 84 pages in length.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 34 pages of arguments in excess of 50 pages required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. Furthermore, patent owner's response added 28 new claims. It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 84 pages in length is appropriate in the interest of justice.

Accordingly, third party requester's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's comments

submission to exceed the page limit by up to 34 pages. This waiver makes requester's January 26, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments filed on January 26, 2011 may exceed the page limit by up to 34 pages. This waiver makes the January 26, 2011 third party requester comments submission page-length compliant.
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

3/15/11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,397	07/16/2010	7669133	6115-0101L	4982
2292	7590	04/05/2012	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

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Date: **MAILED**

A- 05 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001397
PATENT NO. : 7669133
TECHNOLOGY CENTER : 3999
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: (For Patent Owner)

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APR 05 2012
CENTRAL REEXAMINATION UNIT

Joseph T. Jakubek
KLARQUIST SPARKMAN, LLP
121 S.W. Salmon St.
Suite 1600
Portland, OR. 97204

:
:
: (For Third Party
: Requester)

In re: Chikirivao et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,397
For: U.S. Patent No.: 7,669,133

:
: DECISION ON PETITION

This is a decision on the petition filed by the Third Party Requestor on July 22nd, 2011, entitled "PETITION TO THE DIRECTOR UNDER 37 CFR § 1.181 FOR AN ORDER THAT THE EXAMINER REOPEN PROSECUTION, OR ALTERNATIVELY FOR AN ORDER THAT THE EXAMINER AMEND THE RIGHT OF APPEAL NOTICE TO INCLUDE PROPOSED REJECTIONS NOT PROPERLY SET FORTH AS ADOPTED OR NOT ADOPTED".

The Petition is treated as a petition under 37 CFR § 1.181.

The petition is before the Director of the Central Reexamination Unit.

The Petition is DENIED.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,669,133 issued on February 23rd, 2010.
- A request for *inter partes* reexamination was filed on July 16th, 2010 and assigned control no. 95/001,397.
- *Inter partes* reexamination was ordered on September 22nd, 2010.
- A Non-Final Office Action was mailed on October 12th, 2010.
- Patent Owner's Response to the Non-Final Office Action was received on December 27th, 2010.
- The Third Party Requestor's Comments to the Patent Owner Response and the Non-Final Office Action were received on January 26th, 2011.
- An Action Closing Prosecution (ACP) Office Action was mailed on March 14th, 2011.
- Patent Owner's Response to the ACP was received on April 14th, 2011.
- The Third Party Requestor's Comments to the Patent Owner Response and the ACP were received on May 16th, 2011.
- A Right of Appeal Notice (RAN) Office Action was mailed on July 11th, 2011.
- The instant Petition was filed on July 22nd, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing **date of the action or notice from which relief is requested** may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable. (Emphasis added.)

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8. (Emphasis added.)

37 CFR 1.948 states, in part:

- (a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:
- (1) which is necessary to rebut a finding of fact by the examiner;
 - (2) which is necessary to rebut a response of the patent owner; or
 - (3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record indicates. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

MPEP 2673 states, in part:

II. OPTIONS AS TO WHICH ACTION TO ISSUE

A) Right of Appeal Notice - Where no 37 CFR 1.951(a) submission has been filed by the patent owner, or where a submission under 37 CFR 1.951(a) (and 37 CFR 1.951(b)) has been filed and the examiner will not modify his/her position; the examiner should issue a Right of Appeal Notice (RAN). See MPEP § 2673.02. If the patent owner's submission included a proposed amendment, the RAN will indicate whether or not it was entered.

Where a submission has been filed under 37 CFR 1.951(a) (or 37 CFR 1.951(b)) and that submission is incomplete or is defective, the examiner should notify the parties, in the RAN, that the submission has not been considered, and that no additional opportunity is available to correct the defect(s) in the submission, because 37 CFR 1.951(a) and (b) provide that comments may only be filed "once." (Emphasis added)

(B) Office action reopening of prosecution - See MPEP § 2673.01 for a discussion of when the examiner should issue an action reopening prosecution.

DECISION

The Third Part Requestor ["petitioner"] argues in the petition, dated July 22, 2011, that the Office vacate the Right of Appeal Notice (RAN) Office action dated July 11th, 2011 based on the failure of the Examiner to conduct a thorough investigation of the available prior art, including proper consideration of each of the proposed rejections. Alternatively, the petitioner argues that a compliant amended RAN clearly setting forth the additional proposed rejections be issued so as to provide the petitioner the right to appeal.

Petition

As a procedural matter, the petition was filed under 37 CFR § 1.181, which is reserved for action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

In the petition, petitioner states that in the RAN the Examiner did not consider the petitioner's proposed obviousness rejection based on the Kintzer reference alone (issue 3), which had been raised in the original Request and reiterated in the petitioner's written comments following the ACP (Instant Petition, Page 7). However, the record of the proceedings clearly indicates that the examiner considered all of the proposed rejections that were set forth in compliance with 35

U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), or 37 CFR 1.947 and 37 CFR 1.948 in the request for reexamination or petitioner's written comments following the non-final Office action.

For example, the non-final Office action clearly articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915. Specifically, the non-final Office action on page 5 clearly articulated the Office's position with respect to the proposed rejection based on the Kintzer reference (Issue 1) under 35 U.S.C. 102(e), wherein the examiner adopted the proposed rejection for claims 1-2, 7-17, 19-22, 24-30, 32-33, 35-36 and 39-42, the examiner did not adopt the proposed rejection for claims 23, 31, 37-38, and the examiner adopted with modification the rejections proposed for claims 3-6 and 18. The non-final Office action also on page 7 clearly articulated the Office's position with respect to the proposed rejection based on the Kintzer reference (alone) under 35 U.S.C. 103(a) (Issue 3), wherein the examiner did not adopt the proposed rejection for claims 1-43.

Likewise, the ACP and RAN clearly articulated reasons for the adoption or the lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947 or 37 CFR 1.948. In response to the non-final Office action, the Patent Owner filed a Response, dated 12/28/2010, in which Patent Owner argued the rejections and proposed new claims 44-71, dependent on the previously presented claims 1, 10, 32, 43, or 37. The examiner in the ACP, dated 3/14/2011, explicitly addressed the proposed rejection of the new claims 44-71 on the basis of the Kintzer reference (Page 9 / Issue 25), wherein the examiner did not adopt the proposed rejections. Furthermore, the examiner in the RAN addressed Issues 24-36 by clearly setting forth whether the proposed rejections were either adopted or not adopted, *see e.g.*, Pages 15-19 of RAN, and clearly setting forth the reasons for both the adoption or lack of adoption of the proposed rejections, *see e.g.*, Pages 62-66 of RAN.

Therefore, the record of the proceeding makes it clear that the examiner did indeed consider all the proposed rejections based on the Kintzer reference alone that were properly raised under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948.

Further, the grounds of argument presented in the petition appear to seek review of the merits of the examiner's determinations. The issue of whether the examiner incorrectly withdrew the rejections under 35 U.S.C. 102 and/or 103 is an appealable matter, and so cannot be addressed by petition. *See*, MPEP 1201 and 1002. Therefore, to the extent that petitioner's arguments seek review of the propriety of the merits of the examiner's determinations, these arguments are procedurally dismissed.

The petitioner further requests that the examiner make a thorough investigation of the entire set of prior art on the record. For instance, the petitioner requests that the examiner consider Issues B-I as set forth in section IV of petitioner's Comment dated 05/16/2011 (Instant Petition, Page 7). However, the Examiner in the RAN has clearly indicated that in view of MPEP 2666.05,

which cites to 37 CFR 1.947 and 37 CFR 1.948, the new grounds of rejections exceed the scope of the allowed comments and are improper.

In addition, the petitioner requests that the examiner consider additional issues (rejections) that are currently presented in the instant petition, but were not presented prior to close of prosecution. *See*, Petition, pages 9-11 (Additional Issues C, E, H-P, R-W). These issues are considered improper and have not been considered. As discussed above, the controlling reexamination statutes and regulations clearly demand presentation of all the issues regarding patentability prior to the close of prosecution for patentability issues to be resolved with special dispatch. *See e.g.*, 37 CFR 1.953(c). In this proceeding, the RAN clearly lists all the proper proposed rejections, clearly articulates the Office's position on each of the proposed rejections, and, consistent with MPEP 2673, clearly states the rejections that are deemed improper.

In view of the foregoing, the record clearly shows that the examiner considered all the proposed rejections set forth in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination by providing an Office action which either adopted or not adopted these proposed rejections. In addition, the ACP and the RAN clearly articulated reasons for both the adoption and lack of adoption of all of the proposed rejection, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948.

For the reasons set forth above, it is deemed that the RAN is proper and that the examiner followed Office rules and procedures and did not abuse her discretion in deciding to not consider the new proposed obviousness rejection. For all the reasons discussed above, the petition for reconsideration is denied.

CONCLUSION

1. The petition filed July 22nd, 2011 is denied.
2. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Examiner, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,398	07/16/2010	6684789	P-74637-US	5488
49443	7590	12/15/2010	EXAMINER	
Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036			ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE, SUITE 700
DALLAS, TX 75219

Date:

MAILED

DEC 15 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001398
PATENT NO. : 6684789
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

MAILED

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,398

DEC 15 2010

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 01 December 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on November 19, 2010 which sets a one (1) month period for filing a response thereto, be extended by and additional two (2) months.

 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: electronic payment via EFS.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☒ Other/comment: _____ see attached discussion _____.
 - B. ☐ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

_____/Mark Reinhart/
[Signature]

(Title)

SPE AU 3992__

In the petition patent owner's representative requests a two-month extension of time to respond to the outstanding office action. Petitioner is newly appointed representation of patent owner.

In support of why, in spite of the action taken thus far, the requested additional time is needed patent owner submits new counsel will need to consider future evidence, conduct legal research and confer with patent owner regarding the issues raised and weigh all options.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of newly retained council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in an inter partes reexamination proceeding.

In as much as patent owner does have a right to retain new counsel at any time during a reexamination proceeding, patent owner must also remain diligent. The mere fact patent owner retained new council late in the response period, absent the existence of any further compelling evidence or reasoning, does not rise to the level of sufficient cause to warrant the amount of additional time requested. Presumably the outstanding need for action in the instant proceeding was considered in the decision to retain new council. Further, the requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management.

On balance, the petitioner notes the length of the Office action, secondary considerations, future holidays and the fact that the company is German:

In consideration of the factual accounting provided by patent owner in the petition balanced with the statutory mandate of conducting reexamination proceedings with special dispatch, it is felt an additional two week period for response is reasonable. Such would result in new counsel having approximately one full month for response.

The petition for extension of time is hereby granted in part for one (1) month.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,398	07/16/2010	6684789	P-74637-US	5488
49443	7590	04/13/2011	EXAMINER	
Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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HAYNES AND BOONE, LLP

IP SECTION

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DALLAS, TX 75219

Date:

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APR 13 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001398

PATENT NO. : 6684789

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,398	07/16/2010	6,684,789	P-74637-US

CCP SYSTEMS AG
STAMMHEIMER ST.35
STUTTGART 70435
GERMANY

EXAMINER

MARY, STEELMAN

ART UNIT	PAPER
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3992

DATE MAILED:

04/13/11

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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95/001,398	07/16/2010	6,684,789	P-74637-US

CCP SYSTEMS AG
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STUTT GART 70435
GERMANY

EXAMINER
MARY, STEELMAN

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CCP Systems AG
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Germany

(For Patent Owner)

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APR 13 2011

CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

(For *Inter Partes* Requester)

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,398
Filed: July 16, 2010
For: US Patent No. 6,684,789

:
: **DECISION**
: **ON**
: **PETITION**
:

This is a decision on the third party requester petition paper entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)," filed on February 9, 2011.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration for consideration.

The petition under 37 CFR 1.183 is dismissed as moot.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, the Office issued United States Patent Number 6,684,789 (the '789 patent) to Thomas E. Krautter.
2. On July 16, 2010, a request for *inter partes* reexamination of the '789 patent was filed by a third party requester, and assigned Reexamination Control No. 95/001,398 (the '1398 proceeding).

3. On October 14, 2010, the Office issued an order granting *inter partes* reexamination in the '1398 proceeding, indicating that an Office action would issue in due course.
4. On November 19, 2010, the Office issued a first Office action on the merits.
5. On January 10, 2011 patent owner timely filed a response to the first Office action on the merits.
6. On February 9, 2011, third party requester submitted comments in response to patent owner's January 10, 2011 response and the November 19, 2010 first Office action. Concurrently, third party requester filed the present petition paper in the '1398 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)."
7. On March 15, 2011, the Office issued a notice of defective paper indicating that patent owner's January 10, 2011 response was improper and setting a time period for resubmission.
8. On March 30, 2011, patent owner submitted a corrected response to the first Office action, addressing the issues raised by the Office in the March 15, 2011 notice of defective paper. Concurrently, patent owner filed a petition requesting waiver of the regulatory page limit requirement of 37 CFR 1.943(b).
9. This decision addresses the requester's February 9, 2011 petition under 37 CFR 1.183 requesting waiver of the page limit requirement for third party requester comments in an *inter partes* reexamination proceeding.

DECISION

Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

Discussion

Third party requester petitions for waiver of the regulatory 50-page limit under 37 CFR 1.943(b) and the entry of the February 9, 2011 third party requester comments submission. On March 15, 2011, the Office issued a notice of defective paper, which indicated that patent owner's January 10, 2011 response was improper because it failed to comply with the page length requirements of 37 CFR 1.943(b), and which set a time period for resubmission. On March 30, 2011, patent owner filed a corrected response, in reply to the March 15, 2011 notice.

As requester's February 9, 2011 comments submission was in response to an improper patent owner submission, it will not be further considered on the merits, as being moot, since the patent owner did not in fact respond to the Office action in accordance with the rules. See MPEP 2667, subsection I A 2.

Accordingly, the present petition is dismissed as moot.

In accordance with 37 CFR 1.947, third party requester is provided with one opportunity to submit written comments in response to the corrected patent owner response filed on March 30, 2011, limited to issues raised by the Office action or by patent owner's corrected response, within 30 days from the date of service of patent owner's corrected response.

Correspondence Address of the Patent Owner

The change of correspondence address, filed by the patent owner on December 1, 2010, is *ineffective*. The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file*. See MPEP 2622 and 37 CFR 1.33(c). In the present case, the official correspondence address for the patent owner is shown in the caption of this decision.

A courtesy copy of this decision will be mailed to the law firm of Pearl Cohen Zedek Latzer, LLP, of New York, NY, also as shown in the caption of this decision. Absent the filing of a proper change of correspondence address in the *patent file*, application no. 10/275,784, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- Third party requester's February 9, 2011 petition under 37 CFR 1.183 is dismissed as moot.
- The third party requester is provided with one opportunity to submit written comments in response to the corrected patent owner response filed on March 30, 2011, limited to issues raised by the Office action or by patent owner's corrected response, within 30 days from the date of service of patent owner's corrected response.
- The change of correspondence address, filed by the patent owner on December 1, 2010, is ineffective. A courtesy copy of this decision will be mailed to the law firm of Pearl Cohen Zedek Latzer, LLP, of New York, NY, also as shown in the caption of this decision. **Absent the filing of a proper change of correspondence address in the patent file, application no. 10/275,784, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.**
- Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,398	07/16/2010	6684789	P-74637-US	5488
49443	7590	08/23/2011	EXAMINER	
Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036			ART UNIT	PAPER NUMBER

DATE MAILED: 08/23/2011

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HAYNES AND BOONE, LLP

IP SECTION

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DALLAS, TX 75219

Date:

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AUG 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001398

PATENT NO. : 6684789

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

(For Patent Owner)

MAILED

AUG 23 2011

CENTRAL REEXAMINATION UNIT

Haynes and Boone, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

(For *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,398
Filed: July 16, 2010
For: US Patent No. 6,684,789

:
: **DECISION**
: **ON**
: **PETITIONS**
:

This is a decision on (1) the patent owner petition entitled, "PETITION PURSUANT TO 37 C.F.R. § 1.183 TO WAVE PAGE LIMIT FOR PATENT OWNER RESPONSE UNDER 37 C.F.R. § 1.943(b)" filed on March 30, 2011, and (2) the third party requester petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)," filed on April 26, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Patent owner's March 30, 2011 petition is granted to the extent set forth below.

Third party requester's April 26, 2011 petition is dismissed to the extent requested, but is granted-in-part for the reasons set forth below.

Third party requester's April 26, 2011 submission is an improper paper and expunged for the reasons set forth below.

REVIEW OF THE RELEVANT FACTS

1. On February 3, 2004, the Office issued United States Patent Number 6,684,789 (the '789 patent) to Thomas E. Krautter.

2. On July 16, 2010, a request for *inter partes* reexamination of the '789 patent was filed by a third party requester, and it was assigned Reexamination Control No. 95/001,398 (the '1398 proceeding).
3. On October 14, 2010, the Office issued an order granting *inter partes* reexamination in the '1398 proceeding, indicating that an Office action would issue in due course.
4. On November 19, 2010, the Office issued a first Office action on the merits.
5. On January 10, 2011 patent owner timely filed a response to the first Office action on the merits.
6. On February 9, 2011, third party requester submitted comments after patent owner's January 10, 2011 response and the November 19, 2010 first Office action. Concurrently, third party requester filed the present petition paper in the '1398 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)."
7. On March 15, 2011, the Office issued a notice of defective paper indicating that patent owner's January 10, 2011 response was improper and setting a time period for resubmission.
8. On March 30, 2011, patent owner submitted a corrected response to the first Office action, addressing the issues raised by the Office in the March 15, 2011 notice of defective paper. Concurrently, patent owner filed a petition requesting waiver of the regulatory page limit requirement of 37 CFR 1.943(b).
9. On April 13, 2011, the Office dismissed as moot requester's February 9, 2011 petition.
10. On April 26, 2011, third party requester submitted comments after the patent owner's March 30, 2011 response and the November 19, 2010 first Office action. Concurrently, third party requester filed a new petition paper in the '1398 proceeding entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS UNDER 37 C.F.R. § 1.943(b)."

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be

imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.945(a) provides

The patent owner will be given at least thirty days to file a response to any Office action on the merits of the inter partes reexamination.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

II. Discussion & Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which a patent owner petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response. In like manner, a showing which a requester petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a requester comments submission in compliance with the 50-page limit, and submission of a comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted

comments paper. This too can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response or comments, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

A. Patent Owner March 30, 2011 Petition Under 37 CFR 1.183

Patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on March 30, 2011 to address the November 19, 2010 non-final Office action, and requests that the page limit be extended by five pages.¹

Patent owner states "[p]atent [o]wner and the undersigned have worked to reduce the number of pages for submission to the extent possible, without unduly affecting the merits of the argument"² Further patent owner asserts that, "The Office Action expressly incorporates by reference substantially all of the [t]hird [p]arty [r]equester's [r]eexamination [r]equest . . .".³ Patent owner asserts that the present facts present an extraordinary situation in which justice requires waiver of the page limit given the efforts undertaken to redraft the submissions and the necessity to fully and completely respond to the Office action.⁴ Further, patent owner notes the 50-page limitation is regulatory requirement and not statutory and thus within the Director's prerogative and authority to waive.⁵

¹ Petition at 1.

² *Id.* at page 2.

³ *Id.*

⁴ *Id.* at pages 2-3.

⁵ *Id.* at page 3.

Patent owner's response is found to consist of *inter alia* a 34-page patent owner remarks section, an amendment to the claims that amends an original claim and adds new claims 54-82, a 20-page appendix outlining support for newly added claims 54-82, and two declarations under 37 CFR 1.132. The declarations under 37 CFR 1.132 are a 17-page declaration by David Birnbaum under 37 CFR 1.132 and a 4-page declaration by Christoph Picht. The 4-page declaration by Picht presents only objective and technical opinion evidence, and is free of legal argument. Therefore the Picht declaration does not count against the regulatory page limit. Eleven pages of the 17-page declaration by Birnbaum were found to contain legal argumentation/conclusion, see *inter alia* the non-obviousness arguments made on page 7, paragraph 44; page 8, paragraph 61; page 11, paragraph 77; and page 17, paragraph 130; see also the indefiniteness assertion on page 9, paragraph 63. Therefore eleven pages of the Birnbaum declaration counts against the regulatory page limit. Accordingly, the length of patent owner's substantive response exceeds the page limit, and the extent of the waiver being requested, is to submit a total of approximately 65 pages.⁶

Based upon the individual facts and circumstances of this case, including the November 19, 2010 Office action and its incorporation by reference from the request for reexamination in the '1398 proceeding, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent of patent owner's March 30, 2011 response. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's March 30, 2011 response submission. This waiver makes patent owner's March 30, 2011 response submission page-length compliant.

B. Third Party Requester April 26, 2011 Petition Under 37 CFR 1.183

Third party requester's April 26, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

Third party requester petitions for waiver asserting that "waiver [of 37 CFR 1.943(b)] is in keeping with the substantial interest of justice in that the [r]equester should have the opportunity to effectively address each of the new claims and all of the issues raised by the PO [r]emarks."⁷ In further support of waiver of 37 CFR 1.943(b), requester states that, "allowing the [t]hird [p]arty [r]equester to adequately respond to the patentability of each of the new claims and provide the explanation for the proposed rejections in a claim chart format will help the examiner expedite the subsequent examination which is to be conducted with special dispatch in accordance with t 37 C.F.R. § 1.937."⁸ In summary the third party requester's basis for waiver of 37 CFR 1.943(b) is the fact that patent owner's March 30, 2011 response added 29 new claims. Requester has not demonstrated nor asserted that any attempt to comply with rule 1.943(b) was made by economizing the response or that a prose styled response did not substantially reduce the number of pages as compared to the chart styled response that requester opted to submit. However, it is noted that third party requester is submitting comments pursuant

⁶ The sum of the patent owner 34 page remarks section, 20 page listing of support for new claims section and 11 pages of the Birnbaum declaration.

⁷ Third party requester petition at page 1.

⁸ Id. at pages 1-2.

to 37 CFR 1.947 in response to a patent owner response pursuant to 37 CFR 1.945(a) that exceeds the regulatory 50-page limit by 15 pages.

Third party requester's response is found to consist of a 34-page comments section, a single 7-page declaration under 37 CFR 1.132 and a 125-page set of five claim charts for 29 newly added claims that span only 5 pages. The 7-page 37 CFR 1.132 declaration executed by Paul Jacobs, ("the Jacobs declaration"), was found to contain legal argumentation/conclusion, see *inter alia* the obviousness argument/conclusion made on page 6, paragraphs 16-18. Therefore, one page of the Jacobs declaration is considered part of third party requester's substantive response. Accordingly, the length of third party requester's substantive response, and the extent of the waiver being requested, is 160 pages.⁹

Based on the individual facts and circumstances of this case, it is not equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, to the extent requested. The total number of pages of third party requester's April 26, 2011 comments submission that counts toward the page limit is 160 pages.¹⁰ The granting of a waiver for 110 additional pages based upon patent owner's inclusion of 29 new claims that span only 5 pages is not commensurate with the requirements of justice in this situation, even when considering that the patent owner's comments exceed the regulatory page limit by 15 pages. Thus, requester's petition under 37 CFR 1.183 is dismissed.

The page limit requirement of 37 CFR 1.943(b) is instead waived to the extent that justice requires in this circumstance and permits third party requester's comments submission to exceed the page limit requirements by 60 pages, for a total of 110 pages. This waiver does not make third party requester's April 26, 2011 comments submission page-length compliant. Therefore, third party requester's April 26, 2011 response is an improper paper and it will not be considered. The response is being expunged by being closed in the '1398 proceeding's Image File Wrapper (IFW) and marking "non-public." The response will not constitute part of the record of the present reexamination proceeding.

C. Guidance for Third Party Requester

Requester's April 26, 2011 submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the April 26, 2011 submission however, was scanned into the electronic Image File Wrapper (IFW) of the proceeding, before discovery of the impropriety. Thus, the submission cannot be physically returned to requester. Therefore, the IFW copy of the submission is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

For the reasons given above, the April 26, 2011 submission by third party requester exceeded the page limit established by 37 CFR 1.943(b) and this decision. However, from the record it is apparent that requester's submission was a *bona fide* attempt to respond and advance

⁹ The sum of requester's 34-page comments section plus page 6 of the Jacobs declaration and the 125 pages of claim charts.

¹⁰ Id.

prosecution. Accordingly, requester may, within 15 days from the date of this notice, exercise one of the following two options:

1. Submit re-drafted remarks that do not exceed the 110 page limit established by this decision; or,
2. File a copy of the original remarks with pages redacted to satisfy the 110 page limit established by this decision.

This 15-day period for reply is not extendable.

Requester is reminded that under the requirements of 37 CFR 1.903, any paper submitted pursuant to this Notice must be served on the patent owner.

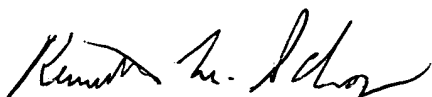
If no comments submission from requester is received within the allotted time, the reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from requester.

Requester is advised that submissions must be of sufficient size, 12 point font, 1.5 line spaced and conform to the margin requirements of 37 CFR 1.52(a)(1)(ii) and have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition. See 37 CFR 1.52.

CONCLUSION

1. Patent owner's March 30, 2011 petition under 37 CFR 1.183, granted and the page limit of 37 CFR 1.943(b) is waived to the extent of patent owner's March 30, 2011 response submission. This waiver makes patent owner's March 30, 2011 response submission page-length compliant.
2. Third party requester's April 26, 2011 petition under 37 CFR 1.183 is dismissed to the extent requested.
3. Third party requester's request for waiver of the 37 CFR 1.943(b) is granted-in-part to permit 50 additional pages to respond to patent owner's March 30, 2011 submission. Third party requester is given a 15 day non-extendable time period for reply to submit a 110 page response.
4. Third party requester's April 26, 2011 response is an improper paper and will not be considered. The response is being expunged by being closed in the '1398 proceeding's Image File Wrapper (IFW) and marking "non-public." The response will not constitute part of the record of the present reexamination proceeding.
5. A copy of this decision will be made of public record.

6. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

8-22-11
Kenpet8/...



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,399	07/16/2010	7497943	IND4-29741-USRX-1	5884
87884	7590	07/20/2011	EXAMINER	
Mossman, Kumar and Tyler, PC P.O. Box 421239 Houston, TX 77242			ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

K&L GATES LLP

P.O. BOX 1135

CHICAGO, IL 60690

Date:

MAILED

JUL 20 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001399

PATENT NO. : 7497943

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,524	12/12/2009	7497943	IND4-29741-USRX	9423
87884	7590	07/20/2011	EXAMINER	
Mossman, Kumar and Tyler, PC P.O. Box 421239 Houston, TX 77242			ART UNIT	PAPER NUMBER

DATE MAILED: 07/20/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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Commissioner for Patents
United States Patents and Trademark Office
P.O.Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
DAVIDSON, DAVIDSON & KAPPEL, LLC
485 7TH AVENUE
14TH FLOOR
NEW YORK, NY 10018

Date:

MAILED

JUL 20 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000524
PATENT NO. : 7497943
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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MAILED

JUL 20 2011

Mossman, Kumar and Tyler, PC
P.O. Box 421239
Houston TX 77242

(For patent owner)

CENTRAL REEXAMINATION UNIT

Davidson, Davidson & Kappel, LLC
485 7th Avenue
New York, NY 10018

(For the '524 requester)

K & L Gates LLP
PO Box 1135
Chicago, IL 60690

(For the '1399 requester)

In re Nguyen *et al.*
Inter Partes Reexamination
Control No. 95/000,524
Filed: December 12, 2009
For: U.S. Patent No. 7,497,943

:
:
:
: **DECISION,**
: ***SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Nguyen *et al.*
Inter Partes Reexamination
Control No. 95/001,399
Filed: July 16, 2010
For: U.S. Patent No. 7,497,943

:
:
:
:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

REVIEW OF FACTS

1. On March 3, 2009, the Office issued U.S. Patent No. 7,497,943 (the '943 patent) to Tran M. Nguyen *et al.* with 25 claims.
2. On December 12, 2009, a request for *inter partes* reexamination of claims 1, 5-6, and 17 of the '943 patent, was filed by a third party requester and assigned control No. 95/000,524 ("the '524 proceeding"). The request identified Assateague Oil, LLC ("the '524 requester") as the real party in interest.
3. On February 4, 2010, *inter partes* reexamination of the '943 patent was granted in the '524

proceeding. Reexamination was granted for claims 1, 5-6, and 17 of the '943 patent. An Office action was concurrently issued.

4. On April 5, 2010, patent owner timely filed a response to the February 4, 2010 Office action. Patent owner did not amend the specification or the claims.
5. On May 4, 2010, the '524 third party requester timely filed responsive comments.
6. On July 16, 2010, a second request for *inter partes* reexamination of claims 1, 9, and 17 of the '943 patent, assigned control No. 95/001,399 ("the '1399 proceeding"), was filed by a third party requester. The request identified Nalco Company ("the '1399 requester") as the real party in interest.
7. On September 17, 2010, *inter partes* reexamination was ordered on claims 1, 9, and 17 of the '943 patent in the '524 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
8. To date, no Office action has issued in the '1399 *inter partes* reexamination proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the above-captioned proceedings for overlapping claims of the same patent. Both proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/000,524 and 95/001,399 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the specification and claims are identical in both proceedings. Therefore a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of *rejection* can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

It is to be noted that, because the '524 *inter partes* third party requester did not propose any rejections of claim 9 in their request for reexamination, the '524 requester has no appeal rights as to those claims as they appear in the '943 patent.

Likewise, it is to be noted that, because the '1399 *inter partes* third party requester did not propose any rejections of claims 5 and 6 in their request for reexamination, the '1399 requester has no appeal rights as to those claims as they appear in the '943 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
 Central Reexamination Unit
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
 Central Reexamination Unit

by Hand to: Customer Service Window
 Attn: Central Reexamination Unit
 Randolph Building, Lobby Level
 401 Dulany Street
 Alexandria, VA 22314

by EFS: Registered users may submit papers via the
 electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

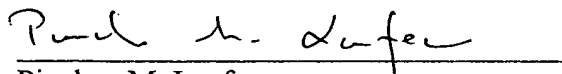
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/00,524 and 95/001,399 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration



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Jesse Delcamp : (For Patent Owner)
10166 66th Street :
Pinellas Park, FL 33782 :

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NOV 08 2011

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :

In re: Miller :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,402 :
Deposited: July 22, 2010 :
For: U.S. Patent No.: 7,643,773 :

This is a decision on a petition filed on September 12, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.181, OR ALTERNATIVELY UNDER 37 C.F.R. § 1.182" [hereinafter "the petition"] and requests the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Right of Appeal Notice.

The petition is before the Director of the Central Reexamination Unit. The petition is granted in part and dismissed in part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,643,773 issued on January 5, 2010.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,402.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 12, 2011, confirming the claims.
- The third party requester filed the instant petition as well as a Notice of Appeal on September 12, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions Not Specifically Provided For

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The third party requester [“petitioner”] argues that the RAN was improper because the examiner (1) failed to consider the character and weight of a declaration, including rebuttal evidence, and (2) the examiner’s statement of reasons for confirmation are not consistent with the subject matter of the claims.

Declaration and Rebuttal

In the first Office action on the merits, the examiner adopted rejections based in part on the Blaine reference. As part of its response filed May 11, 2011, the patent owner filed a declaration under 37 CFR § 1.131 to show invention prior to the Blaine reference. The third party argued in its June 9, 2011 comments submission that the declaration was defective in that it did not show the claimed invention was reduced to practice, and that it was inconsistent with other testimony by the declarant, provided with the comments. The examiner in the next Office action, an Action Closing Prosecution, found that the declaration sufficiently antedated the reference. As to the third party’s rebuttal evidence, the examiner stated that under 37 CFR § 1.906(c), the issue as to the discrepancy between the inventor’s declaration and deposition is not within the scope of reexamination. Such findings were reiterated in the RAN.

Petitioner argues that the examiner did not sufficiently consider the character and weight of the declaration evidence because the examiner did not comment on or apparently consider the deposition it submitted in rebuttal to the declaration. The Director agrees. It appears that the examiner did not consider the rebuttal evidence at all in light of the citation to 37 CFR § 1.906. The deposition was entered into the record, and is evidence that allegedly contradicts the declaration. It therefore is evidence potentially affecting the character and weight of the declaration evidence, and must have been considered when determining whether the declaration evidence is sufficient. Even if, in the extreme case, the examiner determined the deposition should be given zero weight in the analysis, it still must be considered and that fact stated. As the record tends to show the examiner did not consider the evidence at all, such action was improper and the petition is granted to the extent it requests the examiner consider all evidence.

It should be understood that this Decision in no way determines what weight should be given to the various evidence, or what conclusion the examiner should reach. This Decision merely says that all evidence must be considered in weighing the declaration evidence. Review of the merits of a § 1.131 declaration is a matter for appeal, MPEP § 715.08, and therefore the particular weight to be given to a piece of evidence is properly addressed on appeal. Likewise, to the extent petitioner argues that the declaration does not sufficiently show reduction to practice that is a merits issue and not a formalities issue subject to consideration by petition. So long as all properly entered evidence is considered, regardless of what particular conclusions the examiner may draw, the proceeding may pass to the Board for resolution of the merits on appeal. Accordingly, the petition is dismissed to the extent it requests review of the merits of the declaration.

Reasons for Confirmation

Petitioner argues that the RAN is improper because the examiner's statement of reasons for confirmation is not consistent with the claim language. Petitioner argues the claims do not expressly require certain limitations recited by the examiner and that the examiner therefore did not give the claims the broadest reasonable interpretation in light of the specification, nor did she follow MPEP guidance on claim interpretation.

An examiner's claim construction and reasons for confirming the claims over the prior art are matters that directly impact whether a rejection can be made. Such findings by the examiner therefore likewise directly impact any decision favorable to patentability, which is a matter for appeal under 35 U.S.C. § 315(b). As stated by the predecessor to the Federal Circuit:

There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner [T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims.

In re Hengehold, 169 USPQ 473, 479-80 (CCPA 1971). Claim construction and reasons for confirmation are substantive issues that at least indirectly relate to the rejection (or lack thereof) of claims, and therefore are the type of decisions that are properly reviewable by the Board, rather than by petition. Accordingly, to the extent the petition requests review of the reasons for confirmation, claim construction, or the examiner's determination that the prior art does not meet the claims, the petition is dismissed.

New Action

In accordance with the above, the examiner will issue a new Office action fully considering all of the evidence regarding the antedating of the Blaine reference. Assuming nothing else changes, the new action should be an Action Closing Prosecution. If the examiner changes course and reapplies the rejections based on Blaine, such rejections would be the same as those presented originally, therefore closing prosecution would be appropriate. Even if the examiner again finds that the evidence is sufficient to antedate the Blaine reference, the overall evidence forming the basis for such findings will be different, therefore the parties should be accorded the opportunity to comment on this matter if necessary so an ACP, rather than a RAN, would be appropriate.

CONCLUSION

1. The petition filed September 12, 2011 is granted in part and dismissed in part.
2. The examiner will issue a new action where all evidence concerning the antedating of the Blaine reference is considered.
3. The examiner's reasons for confirmation are not subject to review by petition.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,402	07/22/2010	7,643,773	004878.00033	3177
72693	7590	02/17/2012	EXAMINER	
Jesse Delcamp 10166 66th Street Pinellas Park, FL 33782			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-17-12

BANNER & WITCOFF, LTD.

1100 13th STREET N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001402

PATENT NO. : 7643773

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

Jesse Delcamp :
10166 66th Street : (For Patent Owner)
Pinellas Park, FL 33782 :

BANNER & WITCOFF, LTD. :
1100 13TH STREET N.W. : (For Third Party
SUITE 1200 : Requester)
WASHINGTON, DC 20005-4051 :

In re: Miller :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,402 :
Deposited: July 22, 2010 :
For: U.S. Patent No.: 7,643,773 :

This is a decision on a petition filed on February 13, 2012, entitled "PETITION FOR CLARIFICATION UNDER 37 C.F.R. § 1.181/1.182" [hereinafter "the petition"]. The petition requests clarification as to the status of the proceeding, and requests additional time to file a Respondent's Brief should it be determined that the proceeding is ripe for appeal.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. The petition is granted in that the status is clarified. Additionally, the Office *sua sponte* expunges the third party requester's appeal brief from the record.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,643,773 issued on January 5, 2010.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,402.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 12, 2011, confirming the claims.
- The third party requester filed a Notice of Appeal on September 12, 2011 along with a petition claiming the RAN was improper.
- On November 8, 2011, that petition was granted in part. In that decision the CRU Director stated that the examiner would issue a new Office action replacing the RAN.
- On November 10, 2011, the third party requester filed an appeal brief.
- On February 13, 2012, the patent owner filed the instant petition. To date the examiner has not issued the replacement Office action.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(a) Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

DECISION

The patent owner requests clarification of the status of the proceeding and questions whether the appeal brief filed by the third party is premature. The appeal brief is available in the Image File Wrapper, therefore it has been entered into the record. The petition is accordingly considered as invoking the supervisory authority of the Director to review the potentially improper entry of the appeal brief into the record. This is considered to be an “appropriate circumstance[]” under 37 CFR § 1.181(a)(3) and the petition is therefore considered under section 1.181.¹

The Office issued a decision on a petition on November 8, 2011, stating that the examiner would issue a new Office action replacing the previously issued RAN. While the decision did not explicitly say so, it was clearly implied that this constituted a withdrawal of the RAN and a reopening of prosecution. It was stated that the examiner would consider evidence that was not previously considered, and that the examiner would issue a new action, likely an Action Closing Prosecution but not a RAN. Accordingly, that decision can be considered as reopening prosecution so that the examiner could issue a new action.

¹ Additionally, while the filing of the petition occurred over two months after the entry of the appeal brief, the petition is not dismissed as untimely under 37 CFR § 1.181(f). That subsection is discretionary (a petition “may” be dismissed as untimely) and here it is important to consider the petition because it is clear the brief was premature.

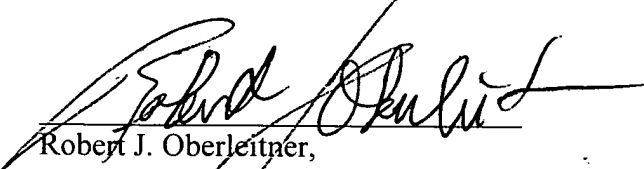
As prosecution was reopened by that decision, the appeal brief filed by the third party requester on November 10, 2011 was premature. While the petition does not expressly request relief other than clarification of the status, the Director finds that appropriate relief is the expungement of the brief from the record. As the proceeding is no longer ripe for appeal, an appeal brief was premature and is considered an "unauthorized paper" under 37 CFR § 1.939.

As to the status, the status of the proceeding is as stated in the November 8, 2011 decision. The examiner will issue a new action in due course consistent with that decision.

Accordingly, the petition is granted in that the status is clarified as requested. Furthermore, the Office *sua sponte* expunges the third party requester's appeal brief as it is premature.

CONCLUSION

1. The petition filed February 13, 2012 is granted. The status is as described above.
2. The examiner will issue a new action consistent with the November 8, 2011 petition decision.
3. The appeal brief filed November 10, 2011 is premature and expunged from the record.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,403	07/22/2010	7,113,710	004878.00035	3212
21901	7590	11/07/2011	EXAMINER	
Smith & Hopen, P.A. Attn: General Patent Matters 180 Pine Avenue North Oldsmar, FL 34677			ART UNIT	PAPER NUMBER

DATE MAILED: 11/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BANNER & WITCOFF, LTD

1100 13TH STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001403

PATENT NO. : 7113710

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

Smith Hopen, PA : (For Patent Owner)
180 Pine Avenue North :
Oldsmar, FL 34677 :

BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :

In re: Miller :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,403 :
Deposited: July 22, 2010 :
For: U.S. Patent No.: 7,113,710 :

This is a decision on a petition filed on September 19, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.181, OR ALTERNATIVELY UNDER 37 C.F.R. § 1.182" [hereinafter "the petition"] and requests the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Right of Appeal Notice.

The petition is before the Director of the Central Reexamination Unit. The petition is granted in part and dismissed in part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,113,710 issued on September 26, 2006.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,403.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 18, 2011, confirming the claims.
- The third party requester filed the instant petition as well as a Notice of Appeal on September 19, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions Not Specifically Provided For

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The third party requester [“petitioner”] argues that the RAN was improper because the examiner (1) failed to consider the character and weight of a declaration, including rebuttal evidence, and (2) the examiner’s statement of reasons for confirmation are not consistent with the subject matter of the claims.

Declaration and Rebuttal

In the first Office action on the merits, the examiner adopted rejections based in part on the Static Control reference. As part of its response filed May 25, 2011, the patent owner filed a declaration under 37 CFR § 1.131 to show invention prior to the Static Control reference. The third party argued in its June 23, 2011 comments submission that the declaration was defective in that it did not show the claimed invention was reduced to practice, and that it was inconsistent with other testimony by the declarant, provided with the comments. The examiner in the next Office action, an Action Closing Prosecution, found that the declaration sufficiently antedated the reference. As to the third party’s rebuttal evidence, the examiner stated that under 37 CFR § 1.906(c), the issue as to the discrepancy between the inventor’s declaration and deposition is not within the scope of reexamination. Such findings were reiterated in the RAN.

Petitioner argues that the examiner did not sufficiently consider the character and weight of the declaration evidence because the examiner did not comment on or apparently consider the deposition it submitted in rebuttal to the declaration. The Director agrees. It appears that the examiner did not consider the rebuttal evidence at all in light of the citation to 37 CFR § 1.906. The deposition was entered into the record, and is evidence that allegedly contradicts the declaration. It therefore is evidence potentially affecting the character and weight of the declaration evidence, and must have been considered when determining whether the declaration evidence is sufficient. Even if, in the extreme case, the examiner determined the deposition should be given zero weight in the analysis, it still must be considered and that fact stated. As the record tends to show the examiner did not consider the evidence at all, such action was improper and the petition is granted to the extent it requests the examiner consider all evidence.

It should be understood that this Decision in no way determines what weight should be given to the various evidence, or what conclusion the examiner should reach. This Decision merely says that all evidence must be considered in weighing the declaration evidence. Review of the merits of a § 1.131 declaration is a matter for appeal, MPEP § 715.08, and therefore the particular weight to be given to a piece of evidence is properly addressed on appeal. Likewise, to the extent petitioner argues that the declaration does not sufficiently show reduction to practice that is a merits issue and not a formalities issue subject to consideration by petition. So long as all properly entered evidence is considered, regardless of what particular conclusions the examiner may draw, the proceeding may pass to the Board for resolution of the merits on appeal. Accordingly, the petition is dismissed to the extent it requests review of the merits of the declaration.

Reasons for Confirmation

Petitioner argues that the RAN is improper because the examiner's statement of reasons for confirmation is not consistent with the claim language. Petitioner argues the claims do not expressly require certain limitations recited by the examiner and that the examiner therefore did not give the claims the broadest reasonable interpretation in light of the specification, nor did she follow MPEP guidance on claim interpretation.

An examiner's claim construction and reasons for confirming the claims over the prior art are matters that directly impact whether a rejection can be made. Such findings by the examiner therefore likewise directly impact any decision favorable to patentability, which is a matter for appeal under 35 U.S.C. § 315(b). As stated by the predecessor to the Federal Circuit:

There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner [T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims.

In re Hengehold, 169 USPQ 473, 479-80 (CCPA 1971). Claim construction and reasons for confirmation are substantive issues that at least indirectly relate to the rejection (or lack thereof) of claims, and therefore are the type of decisions that are properly reviewable by the Board, rather than by petition. Accordingly, to the extent the petition requests review of the reasons for confirmation, claim construction, or the examiner's determination that the prior art does not meet the claims, the petition is dismissed.

New Action

In accordance with the above, the examiner will issue a new Office action fully considering all of the evidence regarding the antedating of the Static Control reference. Assuming nothing else changes, the new action should be an Action Closing Prosecution. If the examiner changes course and reapplies the rejection based on Static Control, such rejection would be the same as presented originally, therefore closing prosecution would be appropriate. Even if the examiner again finds that the evidence is sufficient to antedate the Static Control reference, the overall evidence forming the basis for such findings will be different, therefore the parties should be accorded the opportunity to comment on this matter if necessary so an ACP, rather than a RAN, would be appropriate.

CONCLUSION

1. The petition filed September 19, 2011 is granted in part and dismissed in part.
2. The examiner will issue a new action where all evidence concerning the antedating of the Static Control reference is considered.
3. The examiner's reasons for confirmation are not subject to review by petition.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yücel
Director, Central Reexamination Unit



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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001403

PATENT NO. : 7113710

TECHNOLOGY CENTER : 3999

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Jesse Delcamp : (For Patent Owner)
10166 66th Street :
Pinellas Park, FL 33782 :

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FEB 17 2012

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :

In re: Miller :
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- U.S. Patent No. 7,113,710 issued on September 26, 2006.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,403.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 18, 2011, confirming the claims.
- The third party requester filed a Notice of Appeal on September 19, 2011 along with a petition claiming the RAN was improper.
- On November 7, 2011, that petition was granted in part. In that decision the CRU Director stated that the examiner would issue a new Office action replacing the RAN.
- On November 21, 2011, the third party requester filed an appeal brief.
- On February 13, 2012, the patent owner filed the instant petition. To date the examiner has not issued the replacement Office action.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

DECISION

The patent owner requests clarification of the status of the proceeding and questions whether the appeal brief filed by the third party is premature. The appeal brief is available in the Image File Wrapper, therefore it has been entered into the record. The petition is accordingly considered as invoking the supervisory authority of the Director to review the potentially improper entry of the appeal brief into the record. This is considered to be an “appropriate circumstance[]” under 37 CFR § 1.181(a)(3) and the petition is therefore considered under section 1.181.¹

The Office issued a decision on a petition on November 7, 2011, stating that the examiner would issue a new Office action replacing the previously issued RAN. While the decision did not explicitly say so, it was clearly implied that this constituted a withdrawal of the RAN and a reopening of prosecution. It was stated that the examiner would consider evidence that was not previously considered, and that the examiner would issue a new action, likely an Action Closing Prosecution but not a RAN. Accordingly, that decision can be considered as reopening prosecution so that the examiner could issue a new action.

¹ Additionally, while the filing of the petition occurred over two months after the entry of the appeal brief, the petition is not dismissed as untimely under 37 CFR § 1.181(f). That subsection is discretionary (a petition “may” be dismissed as untimely) and here it is important to consider the petition because it is clear the brief was premature.

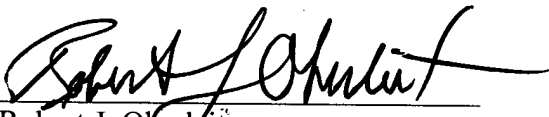
As prosecution was reopened by that decision, the appeal brief filed by the third party requester on November 21, 2011 was premature. While the petition does not expressly request relief other than clarification of the status, the Director finds that appropriate relief is the expungement of the brief from the record. As the proceeding is no longer ripe for appeal, an appeal brief was premature and is considered an "unauthorized paper" under 37 CFR § 1.939.

As to the status, the status of the proceeding is as stated in the November 7, 2011 decision. The examiner will issue a new action in due course consistent with that decision.

Accordingly, the petition is granted in that the status is clarified as requested. Furthermore, the Office *sua sponte* expunges the third party requester's appeal brief as it is premature.

CONCLUSION

1. The petition filed February 13, 2012 is granted. The status is as described above.
2. The examiner will issue a new action consistent with the November 7, 2011 petition decision.
3. The appeal brief filed November 21, 2011 is premature and expunged from the record.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,404	07/22/2010	7,257,356	004878.00034	3246
72693	7590	11/04/2011	EXAMINER	
Jesse Delcamp 10166 66th Street Pinellas Park, FL 33782			ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BANNER & WITCOFF, LTD

1100 13TH STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

Date:

MAILED

NOV 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001404

PATENT NO. : 7257356

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Jesse Delcamp : (For Patent Owner)
10166 66th Street :
Pinellas Park, FL 33782 :

MAILED

NOV 07 2011

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :

In re: Miller :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,404 :
Deposited: July 22, 2010 :
For: U.S. Patent No.: 7,257,356 :

This is a decision on a petition filed on September 23, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.181, OR ALTERNATIVELY UNDER 37 C.F.R. § 1.182" [hereinafter "the petition"] and requests the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper Right of Appeal Notice.

The petition is before the Director of the Central Reexamination Unit. The petition is granted in part and dismissed in part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,257,356 issued on August 14, 2007.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,404.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 23, 2011, confirming the claims.
- The third party requester filed the instant petition as well as a Notice of Appeal on September 23, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions Not Specifically Provided For

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

DECISION

The third party requester ["petitioner"] argues that the RAN was improper because the examiner (1) failed to consider the character and weight of a declaration, including rebuttal evidence, and (2) the examiner's statement of reasons for confirmation are not consistent with the subject matter of the claims.

Declaration and Rebuttal

In the first Office action on the merits, the examiner adopted rejections based in part on the Blaine reference. As part of its response filed May 18, 2011, the patent owner filed a declaration under 37 CFR § 1.131 to show invention prior to the Blaine reference. The third party argued in its June 16, 2011 comments submission that the declaration was defective in that it did not show the claimed invention was reduced to practice, and that it was inconsistent with other testimony by the declarant, provided with the comments. The examiner in the next Office action, an Action Closing Prosecution, found that the declaration sufficiently antedated the reference. As to the third party's rebuttal evidence, the examiner stated that under 37 CFR § 1.906(c), the issue as to the discrepancy between the inventor's declaration and deposition is not within the scope of reexamination. Such findings were reiterated in the RAN.

Petitioner argues that the examiner did not sufficiently consider the character and weight of the declaration evidence because the examiner did not comment on or apparently consider the deposition it submitted in rebuttal to the declaration. The Director agrees. It appears that the examiner did not consider the rebuttal evidence at all in light of the citation to 37 CFR § 1.906. The deposition was entered into the record, and is evidence that allegedly contradicts the declaration. It therefore is evidence potentially affecting the character and weight of the declaration evidence, and must have been considered when determining whether the declaration evidence is sufficient. Even if, in the extreme case, the examiner determined the deposition should be given zero weight in the analysis, it still must be considered and that fact stated. As the record tends to show the examiner did not consider the evidence at all, such action was improper and the petition is granted to the extent it requests the examiner consider all evidence.

It should be understood that this Decision in no way determines what weight should be given to the various evidence, or what conclusion the examiner should reach. This Decision merely says that all evidence must be considered in weighing the declaration evidence. Review of the merits of a § 1.131 declaration is a matter for appeal, MPEP § 715.08, and therefore the particular weight to be given to a piece of evidence is properly addressed on appeal. Likewise, to the extent petitioner argues that the declaration does not sufficiently show reduction to practice that is a merits issue and not a formalities issue subject to consideration by petition. So long as all properly entered evidence is considered, regardless of what particular conclusions the examiner may draw, the proceeding may pass to the Board for resolution of the merits on appeal. Accordingly, the petition is dismissed to the extent it requests review of the merits of the declaration.

Reasons for Confirmation

Petitioner argues that the RAN is improper because the examiner's statement of reasons for confirmation is not consistent with the claim language. Petitioner argues the claims do not expressly require certain limitations recited by the examiner and that the examiner therefore did not give the claims the broadest reasonable interpretation in light of the specification, nor did she follow MPEP guidance on claim interpretation.

An examiner's claim construction and reasons for confirming the claims over the prior art are matters that directly impact whether a rejection can be made. Such findings by the examiner therefore likewise directly impact any decision favorable to patentability, which is a matter for appeal under 35 U.S.C. § 315(b). As stated by the predecessor to the Federal Circuit:

There are a host of various kinds of decisions an examiner makes in the examination proceeding—mostly matters of a discretionary, procedural or nonsubstantive nature—which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but traditionally have been settled by petition to the Commissioner [T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims.

In re Hengehold, 169 USPQ 473, 479-80 (CCPA 1971). Claim construction and reasons for confirmation are substantive issues that at least indirectly relate to the rejection (or lack thereof) of claims, and therefore are the type of decisions that are properly reviewable by the Board, rather than by petition. Accordingly, to the extent the petition requests review of the reasons for confirmation, claim construction, or the examiner's determination that the prior art does not meet the claims, the petition is dismissed.

New Action

In accordance with the above, the examiner will issue a new Office action fully considering all of the evidence regarding the antedating of the Blaine reference. Assuming nothing else changes, the new action should be an Action Closing Prosecution. If the examiner changes course and reapplies the rejections based on Blaine, such rejections would be the same as those presented originally, therefore closing prosecution would be appropriate. Even if the examiner again finds that the evidence is sufficient to antedate the Blaine reference, the overall evidence forming the basis for such findings will be different, therefore the parties should be accorded the opportunity to comment on this matter if necessary so an ACP, rather than a RAN, would be appropriate.

CONCLUSION

1. The petition filed September 23, 2011 is granted in part and dismissed in part.
2. The examiner will issue a new action where all evidence concerning the antedating of the Blaine reference is considered.
3. The examiner's reasons for confirmation are not subject to review by petition.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,404	07/22/2010	7,257,356	004878.00034	3246
72693	7590	02/17/2012	EXAMINER	
Jesse Delcamp 10166 66th Street Pinellas Park, FL 33782			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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Date:

BANNER & WITCOFF, LTD

1100 13TH STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

MAILED

FEB 17 2012

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

CENTRAL REEXAMINATION UNIT

REEXAMINATION CONTROL NO. : 95001404

PATENT NO. : 7257356

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Jesse Delcamp : (For Patent Owner)
10166 66th Street :
Pinellas Park, FL 33782 :

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FEB 17 2012

CENTRAL REEXAMINATION UNIT

BANNER & WITCOFF, LTD. : (For Third Party
1100 13TH STREET N.W. : Requester)
SUITE 1200 :
WASHINGTON, DC 20005-4051 :

In re: Miller :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,404 :
Deposited: July 22, 2010 :
For: U.S. Patent No.: 7,257,356 :

This is a decision on a petition filed on February 13, 2012, entitled "PETITION FOR CLARIFICATION UNDER 37 C.F.R. § 1.181/1.182" [hereinafter "the petition"]. The petition requests clarification as to the status of the proceeding, and requests additional time to file a Respondent's Brief should it be determined that the proceeding is ripe for appeal.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. The petition is granted in that the status is clarified. Additionally, the Office *sua sponte* expunges the third party requester's appeal brief from the record.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,257,356 issued on August 14, 2007.
- A request for *inter partes* reexamination was filed July 22, 2010 and assigned control no. 95/001,404.
- *Inter partes* reexamination was ordered and prosecution progressed until a Right of Appeal Notice ["RAN"] was mailed August 23, 2011, confirming the claims.
- The third party requester filed a Notice of Appeal on September 23, 2011 along with a petition claiming the RAN was improper.
- On November 7, 2011, that petition was granted in part. In that decision the CRU Director stated that the examiner would issue a new Office action replacing the RAN.
- On November 23, 2011, the third party requester filed an appeal brief.
- On February 13, 2012, the patent owner filed the instant petition. To date the examiner has not issued the replacement Office action.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(a) Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

DECISION

The patent owner requests clarification of the status of the proceeding and questions whether the appeal brief filed by the third party is premature. The appeal brief is available in the Image File Wrapper, therefore it has been entered into the record. The petition is accordingly considered as invoking the supervisory authority of the Director to review the potentially improper entry of the appeal brief into the record. This is considered to be an “appropriate circumstance[]” under 37 CFR § 1.181(a)(3) and the petition is therefore considered under section 1.181.¹

The Office issued a decision on a petition on November 7, 2011, stating that the examiner would issue a new Office action replacing the previously issued RAN. While the decision did not explicitly say so, it was clearly implied that this constituted a withdrawal of the RAN and a reopening of prosecution. It was stated that the examiner would consider evidence that was not previously considered, and that the examiner would issue a new action, likely an Action Closing Prosecution but not a RAN. Accordingly, that decision can be considered as reopening prosecution so that the examiner could issue a new action.

¹ Additionally, while the filing of the petition occurred over two months after the entry of the appeal brief, the petition is not dismissed as untimely under 37 CFR § 1.181(f). That subsection is discretionary (a petition “may” be dismissed as untimely) and here it is important to consider the petition because it is clear the brief was premature.

As prosecution was reopened by that decision, the appeal brief filed by the third party requester on November 23, 2011 was premature. While the petition does not expressly request relief other than clarification of the status, the Director finds that appropriate relief is the expungement of the brief from the record. As the proceeding is no longer ripe for appeal, an appeal brief was premature and is considered an "unauthorized paper" under 37 CFR § 1.939.

As to the status, the status of the proceeding is as stated in the November 7, 2011 decision. The examiner will issue a new action in due course consistent with that decision.

Accordingly, the petition is granted in that the status is clarified as requested. Furthermore, the Office *sua sponte* expunges the third party requester's appeal brief as it is premature.

CONCLUSION

1. The petition filed February 13, 2012 is granted. The status is as described above.
2. The examiner will issue a new action consistent with the November 7, 2011 petition decision.
3. The appeal brief filed November 23, 2011 is premature and expunged from the record.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,405	07/23/2010	7558083	36856.1759-083IPR	4311
24197	7590	06/27/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 6-27-11

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001405
PATENT NO. : 7558083
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Klarquist Sparkman, LLP
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Portland, OR 97204

(For Patent Owner)

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,405	:	DISMISSING
Filing Date: July 23, 2010	:	PETITION
For: U.S. Patent No.: 7,558,083	:	

This is a decision on the April 25, 2011 patent owner petition under 37 CFR 1.182, entitled "Petition to Stay *Inter Partes* Reexamination" (the April 25, 2011 patent owner petition under 37 CFR 1.182).

The April 25, 2011 patent owner petition under 37 CFR 1.182, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The April 25, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO to **suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner argues that good cause exists to suspend the present proceeding because the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). Upon brief review of the multitude of court documents filed in the present proceeding, the Office has verified that the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the copending litigation, which satisfies item A.²

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. The patent owner states that prior to trial, the district court instructed the parties to agree on a representative number of claims for trial management purposes, and that the parties agreed to try claim 1 as a representative claim of the ‘083 patent. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of any court document that includes, for example, the court’s instructions regarding the requirement to select representative claims, such as the court’s order to select representative claims, or a court document that includes a statement by the patent owner regarding the court’s requirement to select representative claims. Furthermore, the patent owner has not pointed to, and provided as an attachment to the present petition, any court document that sets forth which claims of the ‘083 patent were the subject of the litigation *prior to* the court’s requirement to select representative claims. In other words, the patent owner has not provided evidence showing which group of

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner’s statement after brief review. However, if more than a brief review of the voluminous number of court documents is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

claims is represented by the representative claim. For this reason, the patent owner has not sufficiently shown that the claims at issue in the litigation are identical to the claims in reexamination, i.e., claims 1, 5, 6, 8, 9, 11, 13-16, 18, 20-22, 26, 27, 29-33, 35, 37-40, 42, 45, 46, 49, 51, and 52 of the '083 patent. Thus, item B has not been shown to have been satisfied.³

The patent owner asserts that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. To support its assertion, the patent owner points to exhibit A of the present petition, which is a court document, filed on November 29, 2010 by the co-defendants in the copending litigation, that identifies prior art "that may anticipate or showing [sic] the state of the art" pursuant to 35 U.S.C. 282, and that "reserves the right to modify or supplement this disclosure". As argued by the patent owner, this court document cites each of the eleven references cited by the requester/co-defendant in the request for reexamination. The Office further notes that the request for reexamination was filed with the Office prior the commencement of the trial in the litigation. For this reason, the patent owner has sufficiently shown that any issues raised in the reexamination proceeding were either raised or could have been raised prior to trial in the litigation. Thus, item C has been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner states that the district court has entered a judgment on the jury verdict. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of the court's judgment to support its statement. Furthermore, the patent owner has not provided any evidence⁴ that an appeal has been filed with the Federal Circuit or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been

³ Regarding patent owner's footnote no. 3, appearing on page 3 of the present petition, the patent owner is reminded that any evidence filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition in such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office's statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). In the present case, the patent owner has submitted, under 37 CFR 1.985, hundreds of pages of court documents as a "notice of concurrent proceeding" pursuant to 37 CFR 1.985, and has vaguely "pointed to" the documents cited in the present petition as having "been made of record in the '1405 Re-examination via Notice of Concurrent Proceedings/Court Action" (see footnote 3 of page 3 of the present petition). Due to the volume of petitions that are processed by the Office in reexamination proceedings, the time taken to peruse hundreds of pages of court documents in an effort to locate documents which may be, or which the patent owner asserts is, supportive of its petition is deemed to be overly burdensome, and prevents the Office from complying with its statutory mandate for special dispatch. For this reason, the patent owner must file, as an attachment to any renewed petition that may be filed, a copy of any evidentiary document that is alleged to be in support of the present petition, and must appropriately reference the attachment in the present petition, so that the supporting passages in the document that are alleged to support the present petition may be located after brief review. The patent owner is also reminded that the Office, in its sole discretion, may deem the volume of litigation papers filed under 37 CFR 1.985 to be too extensive, and may expunge all or part of the submission entitled "Notice of Concurrent Proceedings". "In such instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers". See MPEP 2686. For this reason, any additional papers submitted in this proceeding under 37 CFR 1.985 will be viewed with scrutiny.

⁴ Which must also be filed as an attachment to the present petition.

satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '083 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed before trial began. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.⁵ In the present case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. The patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not shown that the claims in suit are identical to the claims under reexamination in the present proceeding see the above discussion as to this point.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the April 25, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

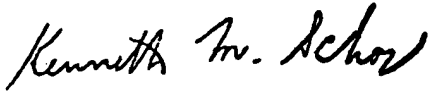
If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed.**

CONCLUSION

- The April 25, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The petition under 37 CFR 1.183 entitled "Petition to Waive Rules (37 CFR § 1.183)" (requesting waiver of 37 CFR 41.2 and 41.60), also filed by the patent owner on April 25, 2011, and requester's opposition to this petition, filed on June 14, 2011, **will be addressed in due course**.

⁵ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

6-24-11
Kenpet8/IP/suspend



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,405	07/23/2010	7558083	36856.1759-083IPR	4311
24197	7590	06/30/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

Date:

MAILED

JUN 30 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001405
PATENT NO. : 7558083
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Klarquist Sparkman, LLP
121 SW Salmon Street, Suite 1600
Portland, OR 97204

(For Patent Owner)

MAILED

JUN 30 2011

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

(For *Inter Partes* Requester) REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,405
Filed: July 23, 2010
For: U.S. Patent No. 7,558,083

: **DECISION GRANTING**
: **PETITION AND *SUA SPONTE***
: **WAIVING PAGE LIMIT FOR**
: **REQUESTER'S COMMENTS**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)," filed on April 25, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is granted for the reasons set forth here.

BACKGROUND

1. On July 7, 2009, United States Patent No. 7,558,083 ("the '083 patent") issued to Schlecht.
2. On July 23, 2010, a request for *inter partes* reexamination of the '083 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,405 ("the '1405 proceeding").
3. On October 19, 2010, the Office mailed an order granting *inter partes* reexamination in the '1405 proceeding.
4. On February 25, 2011, the Office issued a non-final Office action in the '1405 proceeding.
5. On April 25, 2011, patent owner filed the instant petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" ("the petition under 37 CFR 1.183"), concurrently with "SYNQOR INC.'S AMENDMENT AND RESPONSE TO THE NON-FINAL OFFICE ACTION," accompanied by a claim appendix.
6. On April 26, 2011, patent owner filed, at the direction of the Office, "SYNQOR, INC.'S CORRECTED AMENDMENT AND RESPONSE TO THE NON-FINAL OFFICE

ACTION,” accompanied by “CORRECTED CLAIM APPENDIX A” (“patent owner response”).

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner’s April 25, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its response to the February 25, 2011 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner’s April 26, 2011 response.¹ In particular, patent

¹ Patent owner initially filed a response on April 25, 2011 and filed a corrected response on April 26, 2011. The April 26, 2011 response is a substitute (not supplemental) to the April 25, 2011 response. Hence, this decision is based on the April 26, 2011 response.

owner requests that the Office permit entry of the response, which totals “less than 78 pages of argument (excluding reference materials, the listing of claims, and fact declarations)....”²

In support of waiver of 37 CFR 1.943(b), patent owner states that the February 25, 2011 Office action “incorporated by reference the bulk of the arguments in the Requester’s Request for Reexamination, effectively resulting in an office action comprising more than 200 pages of rejections and findings (split into twelve ‘issues’).”³ Patent owner asserts that “[i]t is not realistic that a patent owner could fairly address the scope of rejections adopted by the Examiner in less than one fourth of the space than was used [to] set forth the reasoning for the rejections” and that the length of patent owner’s response “is not excessive in view of the effective length of the Office Action.”⁴

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Upon brief review, the April 26, 2011 response submission includes 77 pages of arguments.⁵ Based on the individual facts and circumstances of this case such as, for example, the size of the February 25, 2011 Office action, including the incorporation by reference of pages from the request for reexamination in the ‘1405 proceeding,⁶ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner’s response submission not exceed 77 pages.

Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s response to the February 25,

² Petition at page 3.

³ *Id.* at page 2.

⁴ *Id.* at page 3.

⁵ The cover sheet and claims appendix are excluded from the regulatory page limit count.

⁶ See February 25, 2011 Office action which, on its face, spans only 13 pages in length but relies on incorporation by reference of more than 200 pages from the request for *inter partes* reexamination in the ‘1405 proceeding.

2011 Office action to exceed the page limit by 27 pages. This waiver makes patent owner's April 26, 2011 response submission page-length compliant.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 77 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's April 26, 2011 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's April 25, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's April 26, 2011 response submission to exceed the page limit by 27 pages. This waiver makes patent owner's April 26, 2011 response submission page-length compliant.
2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 77 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's April 26, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-28-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,405	07/23/2010	7558083	36856.1759-083IPR	4311
24197	7590	02/02/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: **FEB 02 2012**

Joseph R. Keating

CENTRAL REEXAMINATION UNIT

KEATING & BENNETT, LLP

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001405

PATENT NO. : 7558083

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

FEB 02 2012

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
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Suite 200
Reston, VA 20191

(For *Inter Partes* Requester) **CENTRAL REEXAMINATION UNIT**

In re Schlecht	:	DECISION
<i>Inter Partes</i> Reexamination Proceeding	:	
Control No. 95/001,405	:	DISMISSING
Filed: July 23, 2010	:	
For: U.S. Patent No.: 7,558,083	:	PETITION

This is a decision on patent owner's April 25, 2011 combined petition entitled "Petition to Waive Rules (37 CFR § 1.183)" (patent owner's April 25, 2011 combined petition).

This decision also addresses requester's June 14, 2011 opposition paper entitled "Opposition to Petition Waive [*sic*] Rules (37 CFR § 1.183)" (requester's June 14, 2011 opposition).

Patent owner's April 25, 2011 combined petition, requester's June 14, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's April 25, 2011 combined petition under 37 CFR 1.182 and 1.183 is **dismissed**.

DECISION

The patent owner requests that the Office "waive" the provisions of 37 CFR 41.2 and 41.60 "so that [the patent owner] may compel the production of evidence [under 35 U.S.C. 24] from the relevant parties" and present the evidence to the Office.¹ The patent owner argues that "Congress intended that the Patent Owner would be able to compel the production of evidence from hostile parties (e.g., infringers)", and that "the trial record establishes the existence of substantial evidence [which is under a protective order by the court] that defeats the Requester's allegations of obviousness". Thus, the present combined petition is taken as:

- 1) a petition under 37 CFR 1.183 to "waive" the provisions of 37 CFR 41.2 and 41.60;
- 2) a petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding; and
- 3) a petition under 37 CFR 1.182 to permit the entry of the discovered evidence.

¹ See the last two lines of page 9 of the present petition.

37 CFR 41.2 provides, in pertinent part:

An appeal in an *inter partes* reexamination proceeding is not a contested case.

37 CFR 41.60 provides, in pertinent part:

An *inter partes* reexamination proceeding is not a contested case subject to part D [which governs interferences].

37 CFR 1.183 permits waiver of “any *requirement* of the regulations . . . which is not a requirement of the statutes . . .”. The above-quoted provisions, however, are *definitions*, not requirements. There is no requirement for the Office to waive. Furthermore, the Office cannot selectively “waive” the definition of any one *inter partes* reexamination proceeding, i.e., that it is not a contested case, while preserving the same definition for other *inter partes* reexamination proceedings, because to do so would be arbitrary and capricious. For this reason, patent owner’s petition under 37 CFR 1.183 to “waive” the relevant provisions of 37 CFR 41.2 and 41.60 is dismissed.

The patent owner also requests the Office, under 37 CFR 1.182, to authorize discovery in the present proceeding. Patent owner’s petition is, in essence, a request to review the Office’s interpretation that the *inter partes* reexamination statute does not authorize discovery in *inter partes* reexamination proceedings, which includes the interpretation that *inter partes* reexamination proceedings are not “contested cases” within the meaning of 35 U.S.C. 24.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use *in any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office’s decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner’s response, an appeal stage, and the issuance of a certificate at the conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI)

adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments. An *inter partes* reexamination proceeding is otherwise modeled on *ex parte* proceedings such as initial examination or *ex parte* reexamination, which do not permit discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did “not subject the patent to any greater challenge in scope than currently exists today” but “merely allows a reexam requestor the option to further explain why a particular patent should not have been granted”).

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part (emphasis added):

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for **initial examination** under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide any basis for the authorization of discovery under 35 U.S.C. 24. The initial examination of a patent application is not a “contested case in the Patent and Trademark Office” within the meaning of 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination “will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.” The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, implies that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) (“In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*”) (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester’s written comments must be filed within thirty days of the date of service of patent owner’s response. There is no authorization for discovery. Furthermore, it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that ‘reexamination proceedings will be “special” through their pendency’ in the office and provides for an accelerated schedule. MPEP § 2261.

Ethicon, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. The time needed to conduct the discovery, the additional, extensive consideration by the Office of that discovery, and the resolution of any issues, would be contrary to the statutory mandate for special dispatch. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for “special dispatch.” Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the “special dispatch” requirement in the statute, i.e., a finding of “good cause” by the Director, the Office has not authorized an exception to the “special dispatch” provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a) and (b)(2).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) (“The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the *ex parte* nature of the proceeding.”); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) (“Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced

if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.”).

It is clear that the Office’s construction of the statute has consistently been that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (*see* AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a “round table meeting” to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that “the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke *inter partes* reexamination and risk its estoppel effect.” *United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination* (2004) (available at http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm), at 4; *see also* Transcript of February 17, 2004 Roundtable Meeting (available at http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are unpatentable.” *Id.* at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

In this regard, on September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” *See* Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

....

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress’s characterization of the provision for limited discovery in *inter partes* review as an “improvement” over *inter partes* reexamination settles any dispute concerning the proper

interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

Furthermore, an *inter partes* reexamination proceeding is not a contested case. The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. See, e.g., 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart". If Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled *inter partes* reexamination proceedings on interferences, which are contested cases, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery.

Finally, in quashing a subpoena served by the patent owner on the requester in merged *inter partes* reexamination proceeding control numbers 95/000,542 and 95/000,552 ("the merged proceeding"), the district court for the Eastern District of Virginia recently determined that an *inter partes* reexamination proceeding is not a contested case, and that discovery is not permitted in *inter partes* reexamination proceedings. See *Abbott Labs. v. Cordis Corp.*, Civil Action No. 1:11-MC-421, Order (E.D. Va. Jan. 20, 2012) (Hilton, J.), aff'g Order (Anderson, Mag. J.) (granting motion to quash); see Hr'g Tr. at 19-20 (E.D. Va. Dec. 9, 2011) (agreeing with the Office's December 7, 2011 final agency action in the merged proceeding when explaining reasons for granting motion to quash). See also the December 7, 2011 final agency action (in the merged proceeding) denying a petition by the patent owner (in that merged proceeding) requesting the Office to authorize the patent owner to compel discovery in that proceeding.

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings. Accordingly, patent owner's petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding, is **dismissed**. Given this dismissal, patent owner's petition under 37 CFR 1.182 to permit the entry of the discovered evidence is **dismissed as moot**.

The patent owner states that the evidence which patent owner wishes to obtain by discovery is subject to a June 19, 1999 protective order by the court in *SynQor, Inc. v. Artesyn Technologies, Inc., et al*, Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.). Even if the patent owner were to obtain the evidence desired, the Office would not review, permit the entry of, or otherwise consider such evidence, because the Office would not violate the court's protective order, also as argued by the requester. In order for such evidence to be entered and considered by the Office, the patent owner must provide evidence that the requester has consented to a waiver of the court's protective order, and that the court has granted such a waiver. The patent owner has apparently not obtained the requester's consent in view of the requester's argument, in its June 14, 2011 opposition, that the court's protective order "remains in full force and effect to this day", and that the Office cannot grant the patent owner the authority to violate the court's order. The patent owner must explain, in any response to this decision, why the patent owner believed,

at the time of filing the present petition, that it would not be a violation of the court's protective order if the Office were to grant the present petition.

The patent owner has recourse through the court to request the court's permission to submit the necessary materials in this proceeding, also as argued by the requester. Therefore, there are adequate remedies to address this situation.

The patent owner further states that documents, which are designated as exhibits D and E and which are attached to the present petition, were subject to the court's protective order, but were made public at trial by the requester. The patent owner also states that additional documents, which were filed on April 25, 2011 in a notice of concurrent proceedings, were also subject to the court's protective order, but were presented at trial by the requester's expert witness, Dr. Leeb. The patent owner has not, for example, provided *evidence* that these documents were made public by the requester, or that requester has consented to a waiver of the court's protective order with respect to these documents. However, the requester has had over nine months to object to the filing of the documents in the notice of concurrent proceedings, and to the filing of the documents attached to the present petition as exhibits D and E, during which time the requester has filed its June 14, 2011 opposition to the present petition and has filed comments, on July 25, 2011, on patent owner's April 25, 2011 response. To date, the requester has not presented any arguments that any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

In view of the above, patent owner's April 25, 2011 combined petition under 37 CFR 1.183 to "waive" the relevant provisions of 37 CFR 41.2 and 41.60, and under 37 CFR 1.182 to authorize discovery, and to permit entry of the discovered evidence, is **dismissed**.

A decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)", patent owner's October 6, 2011 petition entitled "Renewed Petition to Stay *Inter Partes* Re-examination (37 CFR § 1.182)", and patent owner's January 30, 2012 petition entitled "Petition under 37 CFR 1.183 to Waive Page Limit Set by 37 CFR § 1.943(B)" will each be separately mailed in due course.

CONCLUSION

- Patent owner's April 25, 2011 combined petition under 1.182 and 1.183 is **dismissed**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,405	07/23/2010	7558083	36856.1759-0831PR	4311
24197	7590	02/10/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/10/2012

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(For *Inter Partes* Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,405
Filed: July 23, 2010
For: U.S. Patent No.: 7,558,083

**DECISION
DISMISSING
AND EXPUNGING
IMPROPER PETITION**

This is a decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)" (patent owner's September 29, 2011 petition).

Patent owner's September 29, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's September 29, 2011 petition under 37 CFR 1.182 is **dismissed**.

The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged** from the record by marking the paper "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The patent owner requests the entry of the September 29, 2011 declaration under 37 CFR 1.132 of Brooke Ekins, a legal assistant to counsel for the patent owner, who states that the documents filed concurrently with the declaration are true and correct copies of documents that were either issued by the court or filed in court by one of the parties, in the litigation styled *SynQor, Inc. v. Artesyn Technologies, Inc., et al*, Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.) and in the litigation styled *SynQor, Inc. v. Ericsson, Inc. et al*, Civil Action No. 2-11-CV-54 (E.D. Tex.).

The patent owner asserts that these documents were originally submitted on April 26, 2011 as part of a notice of concurrent proceedings. The patent owner further states that the present

petition is submitted because the patent owner believes that these documents “may not have been entered”, and that patent owner’s supplemental response, also filed on April 26, 2011, “might be deemed as an incomplete response”, because the patent owner relied upon certain of these documents in its April 26, 2011 supplemental response. The patent owner requests entry of these documents pursuant to 37 CFR 1.182 because the “rules do not generally provide for the proactive correction of a defect”.

A review of Office records, however, reveals that a notice of concurrent proceedings by the patent owner was received on April 25, 2011 (rather than on April 26, 2011), and that patent owner’s April 26, 2011 supplemental response, in addition to its April 25, 2011 notice of concurrent proceedings, were entered. Office records fail to reveal that patent owner’s April 26, 2011 supplemental response, or for that matter, patent owner’s April 25, 2011 notice of concurrent proceedings, were determined by the Office to be defective.¹

37 CFR 1.182 provides, in pertinent part:

All situations **not specifically provided for in the regulations** of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed . . .

As presently argued by the patent owner, the declaration under 37 CFR 1.132 of Brooke Ekins (the Ekins declaration) is submitted to provide copies of documents on which the patent owner relied in its (first) supplemental response, filed on April 26, 2011. In other words, the Ekins declaration and its accompanying exhibits is a second, supplemental response by the patent owner, which is specifically governed by the provisions of 37 CFR 1.945(b). Thus, the present petition under 37 CFR 1.182 is improper because the regulations specifically provide for the entry of a supplemental response. Furthermore, to be considered, any supplemental response must be filed as a separate paper as required by 37 CFR 1.4(c), and not as an attachment to a petition, because 1) different matters may be considered by different branches or sections of the Office, and 2) it is not clear whether the attachment, itself, is meant to be the supplemental response, or whether another document, of which the attachment is a duplicate, is meant to be the supplemental response.

For the reasons given above, patent owner’s September 29, 2011 petition under 37 CFR 1.182 is **dismissed**. The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged from the record** by marking the paper “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

¹ In fact, patent owner’s April 26, 2011 supplemental response was directly addressed by the examiner in the November 28, 2011 action closing prosecution (ACP).

Additional Comments

Even if the Ekins declaration and its accompanying exhibits, which is a second supplemental response by the patent owner, were properly filed as a separate paper, it would not be entitled to entry into the record because the patent owner has not provided a showing of a sufficient cause why the second supplemental response should be entered. 37 CFR 1.945(b) provides:

Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

- (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
- (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
- (3) A compelling reason to enter the supplemental response.

Specifically, the patent owner has not provided any explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied. Furthermore, the Office has not found to be defective either 1) patent owner's April 25, 2011 notice of concurrent proceedings,² which, according to the patent owner, includes duplicates of the presently submitted exhibits to the Ekins declaration, or 2) patent owner's April 26, 2011 supplemental response. Thus, the patent owner has not provided a compelling reason to enter the second supplemental response, i.e., the Ekins declaration and its accompanying exhibits, filed on September 29, 2011.

For these reasons, even if the Ekins declaration and its accompanying exhibits were properly filed as a separate paper, it would not be entitled to entry into the record, and would be expunged from the record pursuant to MPEP 2666, subsection III.

CONCLUSION

- Patent owner's September 29, 2011 petition under 1.182 is **dismissed**.
- Patent owner's September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper**

² In patent owner's April 25, 2011 combined petition to reopen prosecution, the patent owner stated that certain documents filed as part of patent owner's April 25, 2011 notice of concurrent proceedings were also subject to the a protective order by the court, but were made public at trial by requester's expert witness, Dr. Leeb. However, as discussed in the Office's February 2, 2012 decision dismissing the April 25, 2011 combined petition, while the patent owner has not provided evidence that these documents were made public by the requester, or that requester has consented to a waiver of any protective order by the court with respect to these documents, the requester has had over nine months to object to the filing of the documents, during which time the requester has filed its June 14, 2011 opposition to patent owner's April 25, 2011 petition and has filed comments, on July 25, 2011, on patent owner's April 26, 2011 response. To date, the requester has not presented any arguments that any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

paper. It will be **expunged from the record** by marking the paper “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon

Director

Office of Patent Legal Administration

27 2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,405	07/23/2010	7558083	36856.1759-083IPR	4311
24197	7590	02/24/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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Reston, VA 20191

Date:

MAILED

FEB 24 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001405
PATENT NO. : 7558083
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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FEB 24 2012

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
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(For Third Party Requester)

In re Schlecht	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,405	:	DISMISSING
Filing Date: July 23, 2010	:	PETITION
For: U.S. Patent No.: 7,558,083	:	

This is a decision on patent owner's October 6, 2011 petition, entitled "Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (patent owner's October 6, 2011 renewed petition).

This decision also addresses requester's October 27, 2011 opposition paper, entitled "Opposition to Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (requester's October 27, 2011 opposition).

Patent owner's October 6, 2011 renewed petition, requester's October 27, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's October 6, 2011 renewed petition is **dismissed**. The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):¹

[35 U.S.C. 314(c)]² thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

In the June 27, 2011 decision dismissing patent owner’s initial petition to suspend³ the present reexamination proceeding, the Office determined that elements A and E have been satisfied.

Regarding element B, the patent owner asserts that the claims at issue in the reexamination are identical to those in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). In patent owner’s initial petition, the patent owner stated that “[p]rior to trial, the District Court instructed the parties to agree on a representative number of claims for trial management purposes. SynQor [the patent owner] and the Defendants [including the third party requester of the present proceeding] agreed to try claim 1 as a representative claim for the ‘083 patent [the patent under reexamination].” In the June 27, 2011 decision, the Office determined that element B had not been shown to have been satisfied, because the patent owner did not provide evidence of the court’s requirement to select

¹ See particularly, MPEP 2686.04, subsections II(B) and III.

² 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

³Filed on April 25, 2011.

“representative claims”, or evidence showing which claims were represented by the representative claims. With the present petition, the patent owner submits, among other exhibits, 1) Exhibit E, a copy of requester/defendant’s December 2, 2009 invalidity contentions, which was apparently submitted in court, and which identifies all of the claims of the ‘083 patent that are under reexamination as the “asserted claims” of the ‘083 patent in the litigation; 2) Exhibit F, a copy of the court’s March 25, 2010 order granting requester’s motion to compel the patent owner “to reduce the number of claims it asserts”; 3) Exhibit H, a copy of a court document entitled “Listing of Claims”, which was apparently submitted by the patent owner to the district court pursuant to the court’s March 25, 2010 order, and which identifies 13 claims of the ‘083 patent; and 4) Exhibit W, a copy of the court’s August 17, 2011 final judgment, in which the court refers to “claim 1 of the ‘083 patent” as the “asserted” claim of the ‘083 patent, and states that the jury failed to find that “any of the asserted claims are invalid”. Finally, the patent owner states, on page 12 of the present petition, that it “ultimately chose to try the issue of infringement of the ‘083 Patent [solely] based on representative claim 1”.

The patent owner has provided evidence that all of the patent claims under reexamination were originally asserted in the copending litigation (see, e.g. Exhibit F, as outlined above). However, the patent owner has not provided any evidence that the parties agreed, or that the court determined, that claim 1 of the ‘083 patent, which was the only claim of the ‘083 patent that was ultimately litigated, is “representative” of the claims that were originally asserted in the copending litigation. No evidence can be found which shows that the court referred to the claims in suit as “the representative claims”. Rather, the court appears to have consistently referred to the claims in suit as “the asserted claims”. Furthermore, the patent owner has not provided any evidence that the requester/co-defendant agreed that claim 1 would be “representative” of the claims originally asserted by the patent owner in the litigation. In fact, the requester, in its October 27, 2011 opposition, argues that it “had absolutely no input, say, or control over which claims of the ‘083 patent [that the patent owner] would present to the jury at trial in the Litigation”. The evidence proffered by the patent owner only appears to show that the patent owner was given the opportunity to select which claims were to be litigated, and not that the parties agreed, or that the court determined, that the claims selected by the patent owner were to be “representative” of the claims originally asserted in the litigation. Thus, the patent owner has not provided evidence showing that the claims at issue in the reexamination are identical to those in the copending litigation. In fact, the evidence of record appears to show that they are not identical.

For the reasons given above, element B has not been shown to have been satisfied.

Regarding element C, the Office determined, in the June 27, 2011 decision, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. The patent owner had provided, with its April 25, 2011 petition, a copy of a court document, filed on November 29, 2010 by the co-defendants in the copending litigation that cites or incorporates a citation to all of the references cited by the requester/co-defendant in the request for reexamination. Upon reconsideration, however, this evidence is insufficient in view of the fact that the patent owner has failed to show that the claims at issue in the reexamination are identical to those in the copending litigation, and, in fact, appears to have shown that the claims were not identical. In the present case, the patent owner has not shown that any issues raised in the reexamination proceeding with respect to the non-

litigated claims could have been raised by the requester in the copending litigation. The patent owner points to *Katz Interactive Call Processing Patent Litigation v. American Air*, 639 F.3d 1303, 97 USPQ2d 1737 (Fed. Cir. 2011) to show that “the Court’s judgment will have a *res judicata* effect against [the requester/co-defendant] on all claims of the ‘083 Patent even though only claim 1 was presented to the jury”. However, the decision in *Katz*, which the court expressly limited to the circumstances before it,⁴ is inapplicable here. The district court in *Katz* was seeking to eliminate duplicative claims, and allowed the plaintiff/patent owner the opportunity to select the claims that it wanted to assert. The issue on appeal was whether the district court’s approach was fair to the patent owner. The Federal Circuit accepted plaintiff/patent owner’s assertion that the district court’s judgments could preclude *the plaintiff/patent owner* from litigating the unselected claims in later actions brought against the same or other parties. The Federal Circuit, however, viewed the approach as fair because it gave the plaintiff/patent owner the opportunity to select which claims it would assert, and further gave the plaintiff/patent owner the ability to raise additional claims that were not duplicative. *Id.* In the present case, however, the patent owner has not pointed to any part of the *Katz* decision where the Federal Circuit suggested that the approach in *Katz* would likewise limit the *defendant* in *Katz* regarding whether the issue of invalidity of the unasserted claims may be raised in a future litigation. Unlike *Katz*, the issue here is not whether the patent owner had a fair opportunity to raise the unasserted claims in the district court. Instead, the question is whether the requester had a fair opportunity to litigate the validity of the claims that were not asserted against it. The patent owner has not shown that the requester in the present case had a fair opportunity. The patent owner selected which claims would be asserted, not the requester. The patent owner has not shown how the requester could have raised, in the copending litigation, any issues that were raised in the reexamination proceeding with respect to the non-litigated claims, also as argued by the requester in its October 27, 2011 opposition.⁵

“Good cause” for suspension pending the conclusion of litigation is based on a potential for the termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the copending litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the copending litigation as to that patent claim, because there would be no “final decision that the party has not sustained its burden of proving the invalidity” of the patent claim. Thus, there is no “potential for termination” of this reexamination proceeding as to the non-litigated claims. A suspension of the present reexamination proceeding would unfairly deprive the requester of its statutory right to a determination of the patentability of the claims that are not the subject of the litigation, and thus not potentially subject to the estoppel provisions of 35 U.S.C. 317.

Therefore, upon reconsideration, element C has not been shown to have been satisfied.

⁴ 639 F.3d at 1309.

⁵ The patent owner also argues that the requester/defendant, as in *Katz*, requested that the court compel the patent owner to reduce the number of asserted claims. Whether the court required the patent owner to select a reduced number of asserted claims at the request of the requester, however, does not alter the fact that the patent owner has not shown that the court determined, or that the requester agreed, that claim 1 was “representative” of the originally asserted claims, i.e., that the claims under reexamination and the claims in litigation are identical, and has not shown how the requester could have raised, in the copending litigation, any issues raised in the reexamination proceeding with respect to the non-litigated claims.

Regarding element D, the patent owner provides evidence that the proceedings in the district court have concluded, and that the district court has entered a final judgment on the jury verdict. A brief review of the record reveals that the requester appealed the final judgment of the district court to the Federal Circuit on October 28, 2011. The requester, however, states in its October 28, 2011 appeal that “this matter is not yet ripe for appeal” because the district court “has not yet disposed of all of [the requester’s] pending claims”. Furthermore, even if it is later determined that the matter is ripe for appeal, the patent owner has not provided evidence that the appeal has been fully briefed. For these reasons, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office’s determination of “good cause” to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. In addition, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the claims under reexamination differ from those in the copending litigation. Furthermore, unlike *Sony*, the Office has already issued an action closing prosecution; while in *Sony*, an action on the merits had not yet been issued by the Office. Also, in *Sony*, an appeal to the Federal Circuit had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon. In the present case, however, there is evidence that the matter on appeal before the Federal Circuit may not be ripe for appeal, and even if it is later determined that the matter is ripe for appeal, the patent owner has not provided any evidence that the appeal has been fully briefed. In other words, the patent owner has not shown that a final decision *as to all claims under reexamination* is expected in the near future. Furthermore, the present proceeding has progressed on the merits. Without a final decision adverse to the requester as to *all* claims under reexamination, no estoppel can attach as to all claims, to mandate termination of the present ordered reexamination proceeding. The fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

Accordingly, patent owner’s October 6, 2011 renewed petition under 37 CFR 1.182 to suspend the present reexamination proceeding is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

CONCLUSION

- The October 6, 2011 patent owner renewed petition is **dismissed**.
- The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

- Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7724.

 /Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2 22 2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,406	07/23/2010	7564702	36856.1759-702IPR	4429
24197	7590	03/15/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Joseph R. Keating

KEATING & BENNETT, LLP

1800 Alexander Bell Dr., Suite 200

Reston, VA 20191

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,406.

PATENT NUMBER 7564702.

TECHNOLOGY CENTER 3900.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



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MAR 15 2011

CENTRAL REEXAMINATION UNIT

KLARQUIST SPARKMAN, LLP : (For Patent Owner)
121 SW SALMON STREET :
SUITE 1600 :
PORTLAND, OR 97204 :

KEATING & BENNETT, LLP : (For Third Party
1800 ALEXANDER BELL DR. : Requester)
SUITE 200 :
RESTON, VA 20191 :

In re: Schlecht :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,406 : UNDER 37 CFR §§ 1.927 & 1.181
Deposited: July 23, 2010 :
For: U.S. Patent No.: 7,564,702 :

This is a decision on the petition filed by the third party requester on November 19, 2010, entitled "PETITION UNDER 37 CFR §§ 1.927 AND 1.181" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Granting the Request for *Inter Partes* Reexamination mailed October 19, 2010, which granted the request for reexamination for all of the requested claims, though it denied certain proposals.

The petition is before the Director of the Central Reexamination Unit.

The petition is dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,564,702 issued on July 21, 2009.
- A request for *inter partes* reexamination was filed July 23, 2010 and assigned control no. 95/001,406.
- Reexamination was requested of claims 1-9, 11-20, 22-26, 28-36, 38-47, 49-53, 55-62, 64-67, 69-76 and 78-89. The reexamination request was granted in an Order mailed October 19, 2010. The request was granted as to all requested claims, though the examiner determined that certain proposals did not raise a substantial new question of patentability.
- The instant petition was timely filed on November 19, 2010. The petition requests reconsideration and review of the proposed substantial new questions of patentability that were not granted in the Order. The petition states that those proposals involved claims 30-36, 39, 40, 42-47, 49, 50, 56-62, 64, 71, 72, 83, 84 and 87-88. Petition p. 1.

STATUTES, RULES AND PATENT EXAMINING PROCEDURES

37 CFR § 1.927 Petition to Review Refusal to Order *Inter Partes* Reexamination

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2648 Petition From Denial of Request (in part)

Except for the limited *ultra vires* exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester. No right to review exists as to that claim, because it will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937.

DECISION


The third party requester seeks review of the examiner's Order granting the request for reexamination. The examiner granted the request for reexamination for all of the requested claims, but denied particular proposals advanced in the request.

37 CFR § 1.927 permits supervisory review of an examiner's refusal to order *inter partes* reexamination. Here, the examiner did not refuse to order reexamination of any requested claim; the examiner granted the request as to all of the requested claims for reasons other than those advanced in the denied proposals. As stated in MPEP § 2648, no petition may be filed requesting review of a decision granting a request for reexamination of a specific claim, and no right to review exists as to that claim.

Reexamination has not been refused for any requested claims, therefore there is no right to petition from the examiner's grant of the request. Accordingly, the petition is dismissed.

CONCLUSION

1. The petition is dismissed as there is no right to review of the examiner's determination ordering reexamination. The examiner's findings are not disturbed.
2. The determination is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.
3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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24197	7590	06/27/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/27/2011

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Joseph R. Keating

KEATING & BENNETT, LLP

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,406.

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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.



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Klarquist Sparkman, LLP
121 S.W. Salmon Street
Suite 1600
Portland, OR 97204

MAILED

(For Patent Owner)

JUN 27 2011

CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
Reston, VA 20191

(For Third Party Requester)

In re Schlecht	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,406	:	DISMISSING
Filing Date: July 23, 2010	:	PETITION
For: U.S. Patent No.: 7,564,702	:	

This is a decision on the May 4, 2011 patent owner petition under 37 CFR 1.182, entitled "Petition to Stay *Inter Partes* Reexamination" (the May 4, 2011 patent owner petition under 37 CFR 1.182).

The May 4, 2011 patent owner petition under 37 CFR 1.182 and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The May 4, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO to **suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner argues that good cause exists to suspend the present proceeding because the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). Upon brief review of the multitude of court documents filed in the present proceeding, the Office has verified that the requester, Murata Manufacturing Co. Ltd., is a co-defendant in the copending litigation, which satisfies item A.²

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. The patent owner states that prior to trial, the district court instructed the parties to agree on a representative number of claims for trial management purposes, and that the parties agreed to try claims 56 and 71 as representative claims of the ‘702 patent. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of any court document that includes, for example, the court’s instructions regarding the requirement to select representative claims, such as the court’s order to select representative claims, or a court document that includes a statement by the patent owner regarding the court’s requirement to select representative claims. Furthermore, the patent owner has not pointed to, and provided as an attachment to the present petition, any court document that sets forth which claims of the ‘702 patent were the subject of the litigation *prior to* the court’s requirement to select representative claims. In other words, the patent owner has not provided evidence showing which group of claims is represented by the representative claims. For this reason, the

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner’s statement after brief review. However, if more than a brief review of the voluminous number of court documents is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

patent owner has not sufficiently shown that the claims at issue in the litigation are identical to the claims in reexamination, i.e., claims 1-9, 11-20, 22-26, 28-36, 38-47, 49-53, 55-62, 64-67, 69-76 and 78-89 of the '702 patent. Thus, item B has not been shown to have been satisfied.³

The patent owner asserts that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. To support its assertion, the patent owner points to exhibit A of the present petition, which is a court document, filed on November 29, 2010 by the co-defendants in the copending litigation, that identifies prior art "that may anticipate or showing [sic] the state of the art" pursuant to 35 U.S.C. 282, and that "reserves the right to modify or supplement this disclosure". As argued by the patent owner, this court document cites each of the thirteen references cited by the requester/co-defendant in the request for reexamination. The Office further notes that the request for reexamination was filed with the Office prior the commencement of the trial in the litigation. For this reason, the patent owner has sufficiently shown that any issues raised in the reexamination proceeding were either raised or could have been raised prior to trial in the litigation. Thus, item C has been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner states that the district court has entered a judgment on the jury verdict. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of the court's judgment to support its statement. Furthermore, the patent owner has not provided any evidence⁴ that an appeal has been filed with the Federal Circuit or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

³ Regarding patent owner's footnote no. 3, appearing on page 3 of the present petition, the patent owner is reminded that any evidence filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition in such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office's statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). In the present case, the patent owner has submitted, under 37 CFR 1.985, hundreds of pages of court documents as a "notice of concurrent proceeding" pursuant to 37 CFR 1.985, and has vaguely "pointed to" the documents cited in the present petition as having "been made of record in the '1406 Re-examination via Notice of Concurrent Proceedings/Court Action" (see footnote 3 of page 3 of the present petition). Due to the volume of petitions that are processed by the Office in reexamination proceedings, the time taken to peruse hundreds of pages of court documents in an effort to locate documents which may be, or which the patent owner asserts is, supportive of its petition is deemed to be overly burdensome, and prevents the Office from complying with its statutory mandate for special dispatch. For this reason, the patent owner must file, as an attachment to any renewed petition that may be filed, a copy of any evidentiary document that is alleged to be in support of the present petition, and must appropriately reference the attachment in the present petition, so that the supporting passages in the document that are alleged to support the present petition may be located after brief review. The patent owner is also reminded that the Office, in its sole discretion, may deem the volume of litigation papers filed under 37 CFR 1.985 to be too extensive, and may expunge all or part of the submission entitled "Notice of Concurrent Proceedings". "In such instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers". See MPEP 2686. For this reason, any additional papers submitted in this proceeding under 37 CFR 1.985 will be viewed with scrutiny.

⁴ Which must also be filed as an attachment to the present petition.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '702 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed before trial began. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.⁵ In the present case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. The patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not shown that the claims in suit are identical to the claims under reexamination in the present proceeding -- see the above discussion as to this point.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the May 4, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed**.

CONCLUSION

- The May 4, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The petition under 37 CFR 1.183 entitled "Petition to Waive Rules (37 CFR § 1.183)" (requesting waiver of 37 CFR 41.2 and 41.60), also filed by the patent owner on May 4, 2011, and requester's opposition to this petition, filed on June 14, 2011, **will be addressed in due course**.

⁵ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

6-24-11
Kenpet8/IP/suspend



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95/001,406	07/23/2010	7564702	36856.1759-702IPR	4429
24197	7590	06/30/2011	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive., Suite 200
Reston, VA 20191

Date:

MAILED

JUN 30 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001406
PATENT NO. : 7564702
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Portland, OR 97204

(For Patent Owner)

MAILED

JUN 30 2011

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive, Suite 200
Reston, VA 20191

(For *Inter Partes* Requester)

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,406
Filed: July 23, 2010
For: U.S. Patent No. 7,564,702

: **DECISION GRANTING**
: **PETITION AND *SUA SPONTE***
: **WAIVING PAGE LIMIT**
: **FOR REQUESTER'S COMMENTS**

This is a decision on the patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)," filed on May 4, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is granted for the reasons set forth here.

BACKGROUND

1. On July 21, 2009, United States Patent No. 7,564,702 ("the '702 patent") issued to Schlecht.
2. On July 23, 2010, a request for *inter partes* reexamination of the '702 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,406 ("the '1406 proceeding").
3. On October 19, 2010 the Office mailed an order granting *inter partes* reexamination in the '1406 proceeding.
4. On March 4, 2011 the Office issued a non-final Office action in the '1406 proceeding.
5. On May 4, 2011, patent owner filed the instant petition entitled, "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT SET BY 37 C.F.R. § 1.943(B)" ("the petition under 37 CFR 1.183"), concurrently with "SYNQOR INC.'S AMENDMENT AND RESPONSE TO THE NON-FINAL OFFICE ACTION," accompanied by a claim appendix.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

- In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be
- “suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner’s May 4, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the March 4, 2011 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner’s May 4, 2011 response. In particular, patent owner requests that the Office permit entry of the response, which totals “less than 90 pages of argument (excluding reference materials, the listing of claims, and fact declarations)...”¹

¹ Petition at page 3.

In support of waiver of 37 CFR 1.943(b), patent owner states that the March 4, 2011 Office action “incorporated by reference the bulk of the arguments in the Requester’s Request for Reexamination, effectively resulting in an office action comprising more than **500 pages** of rejections and findings (split into fourteen ‘issues’).”² Patent owner asserts that “[i]t is not realistic that a patent owner could fairly address the scope of rejections adopted by the Examiner in less than one tenth of the space than was used [to] set forth the reasoning for the rejections” and that the length of patent owner’s response “is not excessive in view of the effective length of the Office Action.”³

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Upon brief review, the May 4, 2011 response submission includes 82 pages of arguments.⁴ Based on the individual facts and circumstances of this case such as, for example, the size of the March 4, 2011 Office action, including the incorporation by reference of pages from the request for reexamination in the ‘1406 proceeding,⁵ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner’s response submission not exceed 82 pages.

Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s response to the March 4, 2011 Office action to exceed the page limit by 32 pages. This waiver makes patent owner’s May 4, 2011 response submission page-length compliant.

² *Id.* at page 2.

³ *Id.* at page 3.

⁴ The cover sheet and claims appendix are excluded from the regulatory page limit count.

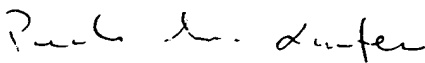
⁵ See March 4, 2011 Office action which, on its face, spans only 14 pages in length but relies heavily on incorporation by reference of more than 500 pages from the request for *inter partes* reexamination in the ‘1406 proceeding.

III. Time Period and Page Limit for Submission of Third Party Requester Comments

This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 82 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's May 4, 2011 response page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's May 4, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's May 4, 2011 response submission to exceed the page limit by 32 pages. This waiver makes patent owner's May 4, 2011 response submission page-length compliant.
2. This decision, *sua sponte*, waives the provisions of 37 CFR 1.943(b) to the extent that any written comments by third party requester filed in response to patent owner's response as set forth in this decision shall not exceed 82 pages in length, excluding reference materials, such as prior art references. **This waiver is conditional on the submission being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.** Requester has 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's May 4, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-28-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,406	07/23/2010	7564702	36856.1759-702IPR	4429
24197	7590	02/02/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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FEE 02 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001406

PATENT NO. : 7564702

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,406
Filed: July 23, 2010
For: U.S. Patent No.: 7,564,702

: **DECISION**
:
: **DISMISSING**
:
: **PETITION**

This is a decision on patent owner's May 4, 2011 combined petition entitled "Petition to Waive Rules (37 CFR § 1.183)" (patent owner's May 4, 2011 combined petition).

This decision also addresses requester's June 14, 2011 opposition paper entitled "Opposition to Petition Waive [*sic*] Rules (37 CFR § 1.183)" (requester's June 14, 2011 opposition).

Patent owner's May 4, 2011 combined petition, requester's June 14, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's May 4, 2011 combined petition under 37 CFR 1.182 and 1.183 is **dismissed**.

DECISION

The patent owner requests that the Office "waive" the provisions of 37 CFR 41.2 and 41.60 "so that [the patent owner] may compel the production of evidence [under 35 U.S.C. 24] from the relevant parties" and present the evidence to the Office.¹ The patent owner argues that "Congress intended that the Patent Owner would be able to compel the production of evidence from hostile parties (e.g., infringers)", and that "the trial record establishes the existence of substantial evidence [which is under a protective order by the court] that defeats the Requester's allegations of obviousness". Thus, the present combined petition is taken as:

- 1) a petition under 37 CFR 1.183 to "waive" the provisions of 37 CFR 41.2 and 41.60;
- 2) a petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding; and
- 3) a petition under 37 CFR 1.182 to permit the entry of the discovered evidence.

¹ See the last two lines of page 9 of the present petition.

37 CFR 41.2 provides, in pertinent part:

An appeal in an *inter partes* reexamination proceeding is not a contested case.

37 CFR 41.60 provides, in pertinent part:

An *inter partes* reexamination proceeding is not a contested case subject to part D [which governs interferences].

37 CFR 1.183 permits waiver of “any *requirement* of the regulations . . . which is not a requirement of the statutes . . .”. The above-quoted provisions, however, are *definitions*, not requirements. There is no requirement for the Office to waive. Furthermore, the Office cannot selectively “waive” the definition of any one *inter partes* reexamination proceeding, i.e., that it is not a contested case, while preserving the same definition for other *inter partes* reexamination proceedings, because to do so would be arbitrary and capricious. For this reason, patent owner’s petition under 37 CFR 1.183 to “waive” the relevant provisions of 37 CFR 41.2 and 41.60 is **dismissed**.

The patent owner also requests the Office, under 37 CFR 1.182, to authorize discovery in the present proceeding. Patent owner’s petition is, in essence, a request to review the Office’s interpretation that the *inter partes* reexamination statute does not authorize discovery in *inter partes* reexamination proceedings, which includes the interpretation that *inter partes* reexamination proceedings are not “contested cases” within the meaning of 35 U.S.C. 24.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

The clerk of any United States court for the district wherein testimony is to be taken for use *in any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office’s decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner’s response, an appeal stage, and the issuance of a certificate at the conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI)

adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (see Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments. An *inter partes* reexamination proceeding is otherwise modeled on *ex parte* proceedings such as initial examination or *ex parte* reexamination, which do not permit discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did “not subject the patent to any greater challenge in scope than currently exists today” but “merely allows a reexam requestor the option to further explain why a particular patent should not have been granted”).

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part (emphasis added):

Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for **initial examination** under the provisions of sections 132 and 133.

35 U.S.C. 132 and 133, which govern initial examination, do not provide any basis for the authorization of discovery under 35 U.S.C. 24. The initial examination of a patent application is not a “contested case in the Patent and Trademark Office” within the meaning of 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination “will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133.” The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, implies that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. Cf. *Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) (“In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*”) (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester’s written comments must be filed within thirty days of the date of service of patent owner’s response. There is no authorization for discovery. Furthermore, it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with “special dispatch” within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

“Special dispatch” is not defined by statute. . . . According to Webster’s New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that ‘reexamination proceedings will be “special” through their pendency’ in the office and provides for an accelerated schedule. MPEP § 2261.

Ethicon, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. The time needed to conduct the discovery, the additional, extensive consideration by the Office of that discovery, and the resolution of any issues, would be contrary to the statutory mandate for special dispatch. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for “special dispatch.” Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the “special dispatch” requirement in the statute, i.e., a finding of “good cause” by the Director, the Office has not authorized an exception to the “special dispatch” provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a) and (b)(2).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) (“The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the *ex parte* nature of the proceeding.”); 145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) (“Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced

if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.”).

It is clear that the Office’s construction of the statute has consistently been that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (see AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a “round table meeting” to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that “the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke *inter partes* reexamination and risk its estoppel effect.” *United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination* (2004) (available at http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm), at 4; see also Transcript of February 17, 2004 Roundtable Meeting (available at http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed “post-grant review process,” in which “[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger’s presenting sufficient grounds that one or more of the patent claims are unpatentable.” *Id.* at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

In this regard, on September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (conduct of *inter partes* review), which instructs the Director to “prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice.” See Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

The Act converts *inter partes* reexamination from an examinational to an adjudicative proceeding, and renames the proceeding “*inter partes* review.” The Act also makes the following improvements to this proceeding:

....

- Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.

H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at <http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf>).

Congress’s characterization of the provision for limited discovery in *inter partes* review as an “improvement” over *inter partes* reexamination settles any dispute concerning the proper

interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

Furthermore, an *inter partes* reexamination proceeding is not a contested case. The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. See, e.g., 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart". If Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled *inter partes* reexamination proceedings on interferences, which are contested cases, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery.

Finally, in quashing a subpoena served by the patent owner on the requester in merged *inter partes* reexamination proceeding control numbers 95/000,542 and 95/000,552 ("the merged proceeding"), the district court for the Eastern District of Virginia recently determined that an *inter partes* reexamination proceeding is not a contested case, and that discovery is not permitted in *inter partes* reexamination proceedings. See *Abbott Labs. v. Cordis Corp.*, Civil Action No. 1:11-MC-421, Order (E.D. Va. Jan. 20, 2012) (Hilton, J.), aff'g Order (Anderson, Mag. J.) (granting motion to quash); see Hr'g Tr. at 19-20 (E.D. Va. Dec. 9, 2011) (agreeing with the Office's December 7, 2011 final agency action in the merged proceeding when explaining reasons for granting motion to quash). See also the December 7, 2011 final agency action (in the merged proceeding) denying a petition by the patent owner (in that merged proceeding) requesting the Office to authorize the patent owner to compel discovery in that proceeding.

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings. Accordingly, patent owner's petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding, is **dismissed**. Given this dismissal, patent owner's petition under 37 CFR 1.182 to permit the entry of the discovered evidence is **dismissed as moot**.

The patent owner states that the evidence which patent owner wishes to obtain by discovery is subject to a June 19, 1999 protective order by the court in *SynQor, Inc. v. Artesyn Technologies, Inc., et al*, Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.). Even if the patent owner were to obtain the evidence desired, the Office would not review, permit the entry of, or otherwise consider such evidence, because the Office would not violate the court's protective order, also as argued by the requester. In order for such evidence to be entered and considered by the Office, the patent owner must provide evidence that the requester has consented to a waiver of the court's protective order, and that the court has granted such a waiver. The patent owner has apparently not obtained the requester's consent in view of the requester's argument, in its June 14, 2011 opposition, that the court's protective order "remains in full force and effect to this day", and that the Office cannot grant the patent owner the authority to violate the court's order. The patent owner must explain, in any response to this decision, why the patent owner believed,

at the time of filing the present petition, that it would not be a violation of the court's protective order if the Office were to grant the present petition.

The patent owner has recourse through the court to request the court's permission to submit the necessary materials in this proceeding, also as argued by the requester. Therefore, there are adequate remedies to address this situation.

The patent owner further states that documents, which are designated as exhibits D and E and which are attached to the present petition, were subject to the court's protective order, but were made public at trial by the requester. The patent owner also states that additional documents, which were filed on May 4, 2011 in a notice of concurrent proceedings, were also subject to the court's protective order, but were presented at trial by the requester's expert witness, Dr. Leeb. The patent owner has not, for example, provided *evidence* that these documents were made public by the requester, or that requester has consented to a waiver of the court's protective order with respect to these documents. However, the requester has had nearly nine months to object to the filing of the documents in the notice of concurrent proceedings, and to the filing of the documents attached to the present petition as exhibits D and E, during which time the requester has filed its June 14, 2011 opposition to the present petition and has filed comments, on July 25, 2011, on patent owner's May 4, 2011 response. To date, the requester has not presented any arguments that any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

In view of the above, patent owner's May 4, 2011 combined petition under 37 CFR 1.183 to "waive" the relevant provisions of 37 CFR 41.2 and 41.60, and under 37 CFR 1.182 to authorize discovery and to permit entry of the discovered evidence, is **dismissed**.

A decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)", patent owner's October 6, 2011 petition entitled "Renewed Petition to Stay *Inter Partes* Re-examination (37 CFR § 1.182)", and patent owner's January 30, 2011 "Petition under 37 CFR 1.183 to Waive Page Limit Set by 37 CFR § 1.943(B)" will each be separately mailed in due course.

CONCLUSION

- Patent owner's May 4, 2011 combined petition under 1.182 and 1.183 is **dismissed**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,406	07/23/2010	7564702	36856.1759-702IPR	4429
24197	7590	02/10/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/10/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Joseph R. Keating
KEATING & BENNETT, LLP
1800 Alexander Bell Drive., Suite 200
Reston, VA 20191

Date: FILED
FEB 10 2009
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001406
PATENT NO. : 7564702
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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(For Patent Owner)

MAILED
FEB 10 2012
CENTRAL REEXAMINATION UNIT

Murata Manufacturing Company, Ltd.
c/o Keating & Bennett, LLP
1800 Alexander Bell Drive
Suite 200
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(For *Inter Partes* Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,406
Filed: July 23, 2010
For: U.S. Patent No.: 7,564,702

DECISION
DISMISSING
AND EXPUNGING
IMPROPER PETITION

This is a decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)" (patent owner's September 29, 2011 petition).

Patent owner's September 29, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's September 29, 2011 petition under 37 CFR 1.182 is **dismissed**.

The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged** from the record by marking the paper "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The patent owner requests the entry of the September 29, 2011 declaration under 37 CFR 1.132 of Brooke Ekins, a legal assistant to counsel for the patent owner, who states that the documents filed concurrently with the declaration are true and correct copies of documents that were either issued by the court or filed in court by one of the parties, in the litigation styled *SynQor, Inc. v. Artesyn Technologies, Inc., et al*, Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.) and in the litigation styled *SynQor, Inc. v. Ericsson, Inc. et al*, Civil Action No. 2-11-CV-54 (E.D. Tex.).

The patent owner asserts that these documents were originally submitted on May 4, 2011 as part of a notice of concurrent proceedings. The patent owner further states that the present petition is

submitted because the patent owner believes that these documents “may not have been entered”, and that patent owner’s response, also filed on May 4, 2011, “might be deemed as an incomplete response”, because the patent owner relied upon certain of these documents in its May 4, 2011 supplemental response. The patent owner requests entry of these documents pursuant to 37 CFR 1.182 because the “rules do not generally provide for the proactive correction of a defect”.

A review of Office records, however, reveals that a notice of concurrent proceedings by the patent owner was received on May 4, 2011, and that patent owner’s May 4, 2011 response, in addition to its May 4, 2011 notice of concurrent proceedings, were entered. Office records fail to reveal that patent owner’s May 4, 2011 response, or for that matter, patent owner’s May 4, 2011 notice of concurrent proceedings, were determined by the Office to be defective.¹

37 CFR 1.182 provides, in pertinent part:

All situations **not specifically provided for in the regulations** of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed . . .

As presently argued by the patent owner, the declaration under 37 CFR 1.132 of Brooke Ekins (the Ekins declaration) is submitted to provide copies of documents on which the patent owner relied in its May 4, 2011 response. In other words, the Ekins declaration and its accompanying exhibits is a supplemental response by the patent owner, which is specifically governed by the provisions of 37 CFR 1.945(b). Thus, the present petition under 37 CFR 1.182 is improper because the regulations specifically provide for the entry of a supplemental response. Furthermore, to be considered, any supplemental response must be filed as a separate paper as required by 37 CFR 1.4(c), and not as an attachment to a petition, because 1) different matters may be considered by different branches or sections of the Office, and 2) it is not clear whether the attachment, itself, is meant to be the supplemental response, or whether another document, of which the attachment is a duplicate, is meant to be the supplemental response.

For the reasons given above, patent owner’s September 29, 2011 petition under 37 CFR 1.182 is **dismissed**. The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged from the record** by marking the paper “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

¹ In fact, patent owner’s May 4, 2011 response was directly addressed by the examiner in the November 28, 2011 action closing prosecution (ACP).

Additional Comments

Even if the Ekins declaration and its accompanying exhibits, which is a supplemental response by the patent owner, were properly filed as a separate paper, it would not be entitled to entry into the record because the patent owner has not provided a showing of a sufficient cause why the second supplemental response should be entered. 37 CFR 1.945(b) provides:

Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:

- (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
- (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
- (3) A compelling reason to enter the supplemental response.

Specifically, the patent owner has not provided any explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied. Furthermore, the Office has not found to be defective either 1) patent owner's May 4, 2011 notice of concurrent proceedings,² which, according to the patent owner, includes duplicates of the presently submitted exhibits to the Ekins declaration, or 2) patent owner's May 4, 2011 response. Thus, the patent owner has not provided a compelling reason to enter the supplemental response, i.e., the Ekins declaration and its accompanying exhibits, filed on September 29, 2011.

For these reasons, even if the Ekins declaration and its accompanying exhibits were properly filed as a separate paper, it would not be entitled to entry into the record, and would be expunged from the record pursuant to MPEP 2666, subsection III.

CONCLUSION

- Patent owner's September 29, 2011 petition under 1.182 is **dismissed**.
- Patent owner's September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper**

² In patent owner's May 4, 2011 combined petition to reopen prosecution, the patent owner stated that certain documents filed as part of patent owner's May 4, 2011 notice of concurrent proceedings were also subject to the a protective order by the court, but were made public at trial by requester's expert witness, Dr. Leeb. However, as discussed in the Office's February 2, 2012 decision dismissing the May 4, 2011 combined petition, while the patent owner has not provided evidence that these documents were made public by the requester, or that requester has consented to a waiver of any protective order by the court with respect to these documents, the requester has had nearly nine months to object to the filing of the documents, during which time the requester has filed its June 14, 2011 opposition to patent owner's May 4, 2011 petition and has filed comments, on July 25, 2011, on patent owner's May 4, 2011 response. To date, the requester has not presented any arguments that any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

paper. It will be **expunged from the record** by marking the paper “closed” and “non-public,” and will not constitute part of the record of the present reexamination proceeding.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon

Director

Office of Patent Legal Administration

27 2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,406	07/23/2010	7564702	36856.1759-702IPR	4429
24197	7590	02/24/2012	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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Date: MAR 10
FEB 24 2010
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001406
PATENT NO. : 7564702
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 24 2012

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CENTRAL REEXAMINATION UNIT

In re Schlecht	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,406	:	DISMISSING
Filing Date: July 23, 2010	:	PETITION
For: U.S. Patent No.: 7,564,702	:	

This is a decision on patent owner's October 6, 2011 petition, entitled "Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (patent owner's October 6, 2011 renewed petition).

This decision also addresses requester's October 27, 2011 opposition paper, entitled "Opposition to Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (requester's October 27, 2011 opposition).

Patent owner's October 6, 2011 renewed petition, requester's October 27, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's October 6, 2011 renewed petition is **dismissed**. The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):¹

[35 U.S.C. 314(c)]² thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

In the June 27, 2011 decision dismissing patent owner’s initial petition to suspend³ the present reexamination proceeding, the Office determined that elements A and E have been satisfied.

Regarding element B, the patent owner asserts that the claims at issue in the reexamination are identical to those in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). In patent owner’s initial petition, the patent owner stated that “[p]rior to trial, the District Court instructed the parties to agree on a representative number of claims for trial management purposes. SynQor [the patent owner] and the Defendants [including the third party requester of the present proceeding] agreed to try claims 56 and 71 as representative claims for the ‘702 patent [the patent under reexamination].” In the June 27, 2011 decision, the Office determined that element B had not been shown to have been satisfied, because the patent owner did not provide evidence of the court’s requirement to select “representative claims”, or evidence showing which claims were represented by the

¹ See particularly, MPEP 2686.04, subsections II(B) and III.

² 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

³Filed on May 4, 2011.

representative claims. With the present petition, the patent owner submits, among other exhibits, 1) Exhibit E, a copy of requester/defendant's December 2, 2009 invalidity contentions, which was apparently submitted in court, and which identifies all of the claims of the '702 patent that are under reexamination as the "asserted claims" of the '702 patent in the litigation; 2) Exhibit F, a copy of the court's March 25, 2010 order granting requester's motion to compel the patent owner "to reduce the number of claims it asserts"; 3) Exhibit O, a copy of the court's November 29, 2010 order limiting the patent owner to the assertion of ten claims at trial; and 4) Exhibit Y, a copy of the court's August 17, 2011 final judgment, in which the court refers to "claims 56 and 71 of the '702 patent" as the "asserted" claims of the '702 patent, and states that the jury failed to find that "any of the asserted claims are invalid". Finally, the patent owner states, on page 12 of the present petition, that it "ultimately chose to try the issue of infringement of the '702 Patent [solely] based on representative claims 56 and 71".

The patent owner has provided evidence that all of the patent claims under reexamination were originally asserted in the copending litigation (see, e.g. Exhibit F, as outlined above). However, the patent owner has not provided any evidence that the parties agreed, or that the court determined, that claims 56 and 71 of the '702 patent, which were the only claims of the '702 patent that were ultimately litigated, are "representative" of the claims that were originally asserted in the copending litigation. No evidence can be found which shows that the court referred to the claims in suit as "the representative claims". Rather, the court appears to have consistently referred to the claims in suit as "the asserted claims". Furthermore, the patent owner has not provided any evidence that the requester/co-defendant agreed that claims 56 and 71 would be "representative" of the claims originally asserted by the patent owner in the litigation. In fact, the requester, in its October 27, 2011 opposition, argues that it "had absolutely no input, say, or control over which claims of the '702 patent [that the patent owner] would present to the jury at trial in the Litigation". The evidence proffered by the patent owner only appears to show that the patent owner was given the opportunity to select which claims were to be litigated, and not that the parties agreed, or that the court determined, that the claims selected by the patent owner were to be "representative" of the claims originally asserted in the litigation. Thus, the patent owner has not provided evidence showing that the claims at issue in the reexamination are identical to those in the copending litigation. In fact, the evidence of record appears to show that they are not identical.

For the reasons given above, element B has not been shown to have been satisfied.

Regarding element C, the Office determined, in the June 27, 2011 decision, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. The patent owner had provided, with its May 4, 2011 petition, a copy of a court document, filed on November 29, 2010 by the co-defendants in the copending litigation that cites or incorporates a citation to all of the references cited by the requester/co-defendant in the request for reexamination. Upon reconsideration, however, this evidence is insufficient in view of the fact that the patent owner has failed to show that the claims at issue in the reexamination are identical to those in the copending litigation, and, in fact, appears to have shown that the claims were not identical. In the present case, the patent owner has not shown that any issues raised in the reexamination proceeding with respect to the non-litigated claims could have been raised by the requester in the copending litigation. The patent owner points to *Katz Interactive Call Processing Patent Litigation v. American Air*, 639 F.3d

1303, 97 USPQ2d 1737 (Fed. Cir. 2011) to show that “the Court’s judgment will have a *res judicata* effect against [the requester/co-defendant] on all claims of the ‘702 Patent even though only claims 56 and 71 were presented to the jury”. However, the decision in *Katz*, which the court expressly limited to the circumstances before it,⁴ is inapplicable here. The district court in *Katz* was seeking to eliminate duplicative claims, and allowed the plaintiff/patent owner the opportunity to select the claims that it wanted to assert. The issue on appeal was whether the district court’s approach was fair to the patent owner. The Federal Circuit accepted plaintiff/patent owner’s assertion that the district court’s judgments could preclude *the plaintiff/patent owner* from litigating the unselected claims in later actions brought against the same or other parties. The Federal Circuit, however, viewed the approach as fair because it gave the plaintiff/patent owner the opportunity to select which claims it would assert, and further gave the plaintiff/patent owner the ability to raise additional claims that were not duplicative. *Id.* In the present case, however, the patent owner has not pointed to any part of the *Katz* decision where the Federal Circuit suggested that the approach in *Katz* would likewise limit the *defendant* in *Katz* regarding whether the issue of invalidity of the unasserted claims may be raised in a future litigation. Unlike *Katz*, the issue here is not whether the patent owner had a fair opportunity to raise the unasserted claims in the district court. Instead, the question is whether the requester had a fair opportunity to litigate the validity of the claims that were not asserted against it. The patent owner has not shown that the requester in the present case had a fair opportunity. The patent owner selected which claims would be asserted, not the requester. The patent owner has not shown how the requester could have raised, in the copending litigation, any issues that were raised in the reexamination proceeding with respect to the non-litigated claims, also as argued by the requester in its October 27, 2011 opposition.⁵

“Good cause” for suspension pending the conclusion of litigation is based on a potential for the termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the copending litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the copending litigation as to that patent claim, because there would be no “final decision that the party has not sustained its burden of proving the invalidity” of the patent claim. Thus, there is no “potential for termination” of this reexamination proceeding as to the non-litigated claims. A suspension of the present reexamination proceeding would unfairly deprive the requester of its statutory right to a determination of the patentability of the claims that are not the subject of the litigation, and thus not potentially subject to the estoppel provisions of 35 U.S.C. 317.

Therefore, upon reconsideration, element C has not been shown to have been satisfied.

Regarding element D, the patent owner provides evidence that the proceedings in the district court have concluded, and that the district court has entered a final judgment on the jury verdict.

⁴ 639 F.3d at 1309.

⁵ The patent owner also argues that the requester/defendant, as in *Katz*, requested that the court compel the patent owner to reduce the number of asserted claims. Whether the court required the patent owner to select a reduced number of asserted claims at the request of the requester, however, does not alter the fact that the patent owner has not shown that the court determined, or that the requester agreed, that claim 1 was “representative” of the originally asserted claims, i.e., that the claims under reexamination and the claims in litigation are identical, and has not shown how the requester could have raised, in the copending litigation, any issues raised in the reexamination proceeding with respect to the non-litigated claims.

A brief review of the record reveals that the requester appealed the final judgment of the district court to the Federal Circuit on October 28, 2011. The requester, however, states in its October 28, 2011 appeal that “this matter is not yet ripe for appeal” because the district court “has not yet disposed of all of [the requester’s] pending claims”. Furthermore, even if it is later determined that the matter is ripe for appeal, the patent owner has not provided evidence that the appeal has been fully briefed. For these reasons, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office’s determination of “good cause” to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. In addition, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the claims under reexamination differ from those in the copending litigation. Furthermore, unlike *Sony*, the Office has already issued an action closing prosecution; while in *Sony*, an action on the merits had not yet been issued by the Office. Also, in *Sony*, an appeal to the Federal Circuit had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon. In the present case, however, there is evidence that the matter on appeal before the Federal Circuit may not be ripe for appeal, and even if it is later determined that the matter is ripe for appeal, the patent owner has not provided any evidence that the appeal has been fully briefed. In other words, the patent owner has not shown that a final decision *as to all claims under reexamination* is expected in the near future. Furthermore, the present proceeding has progressed on the merits. Without a final decision adverse to the requester as to *all* claims under reexamination, no estoppel can attach as to all claims, to mandate termination of the present ordered reexamination proceeding. The fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

Accordingly, patent owner’s October 6, 2011 renewed petition under 37 CFR 1.182 to suspend the present reexamination proceeding is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

CONCLUSION

- The October 6, 2011 patent owner renewed petition is **dismissed**.
- The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

- Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2 22 2012



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029
52450	7590	03/21/2011	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 03/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BARNES & THORNBURG LLP

750 17th STREET NW

SUITE 900

WASHINGTON, DC 20006-4675

MAILED

MAR 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001408

PATENT NO. : 7440565

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Attn: Dean McConnell
Krieg Devault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204-2079

: (For Patent Owner)

MAILED

MAR 21 2011

Attn: Christine McCarthy
Barnes & Thornburg, LLP
750 17th Street NW, Suite 900
Washington, DC 20006-4675

: **CENTRAL REEXAMINATION UNIT**
(For Third Party Requester)

In re McLarty et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,408
Filed: August 13, 2010
For: U.S. Patent No. 7,440,565 B2

:
: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.182**
:

This is a decision on the February 28, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition is dismissed.

BACKGROUND

- On July 26, 2010, a request for *inter partes* reexamination of all of the claims of U.S. Patent Number 7,440,565 B2, having 18 claims, was deposited by the third party requester. A corrected request, meeting the filing requirements of 37 C.F.R. § 1.915, was submitted on August 13, 2010, and the resulting reexamination proceeding was assigned control number 95/001,408 ("the '1408 proceeding").
- On October 21, 2010, reexamination was ordered, and an Office action rejecting claims 1-11, 13-16, and 18 was issued. The Office action confirmed the patentability of claims 12 and 17. The Office action set forth a 2 month period for patent owner's response.
- On January 5, 2010, patent owner submitted an Information Disclosure Statement (IDS) containing documents by Bedingfield, Tekelec, Inc. and airBand.

- On January 28, 2011, an Action Closing Prosecution (ACP) was issued. The ACP limited prosecution to claims 12 and 17 in accord with MPEP 2666.10. The ACP applied the newly submitted Bedingfield, Tekelec and airBand references to reject claims 12 and 17, which were previously confirmed as patentable.
- On February 28, 2011, patent owner filed the following papers:
 - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which includes proposed new claims 19-45. All of the remaining original patent claims, claims 12 and 17, remain unamended.
 - The instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 C.F.R. § 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in **accordance with the merits** of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 C.F.R. § 1.181 provides, in pertinent part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

37 C.F.R. § 1.951(a) provides:

After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

DECISION

In March of 2005, the Office issued a Notice titled “Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending.”¹ Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding.

By filing such a petition, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. Accordingly, relief in the form of a continuation of the reexamination prosecution (after a final Office action) was made available by the Office via a 37 C.F.R. § 1.182 petition, in appropriate circumstances. Any action by the Office in an *inter partes* reexamination proceeding, including action taken in response to a petition under § 1.182, must be consistent with its mandate under 35 U.S.C. 314 that reexamination proceedings must be conducted “with special dispatch within the Office.”

1. Other Avenues For Seeking Entry of the Claim Amendments Are Available

37 C.F.R. § 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, § 1.182 is not, according to the terms of the regulation, the appropriate mechanism for relief. 37 C.F.R. § 1.951(a) provides for the entry of comments and amendment after an ACP during the 1 month time period set for response in the ACP, subject to the criteria of 37 C.F.R. § 1.116. Since patent owner’s submission may be addressed through § 1.951, i.e., relief is still possible under one of the rules of practice, consideration of the present petition under 37 C.F.R. § 1.182 is premature.

The February 28, 2011, patent owner petition is filed under 37 C.F.R. § 1.182 requesting entry of amendments and remarks submitted on the same date therewith. As of the time of filing the petition under 37 C.F.R. § 1.182, the Office had not yet rendered a decision on the entry of the submission under 37 C.F.R. § 1.951(a), or under any other applicable section. Since the Office has not denied entry of the submission, the request for continuation of prosecution fails “to seek entry of an amendment and/or evidence that was denied entry . . . after an action closing prosecution,” as required for the procedure set forth in the March 2005 Notice.

For the instant petition to be proper for consideration and not premature, the instant petition must be filed (1) after the time for response under 37 C.F.R. § 1.951, (2) after entry of the amendment has been denied by the examiner in an action, and (3)(a) without a petition under 37 C.F.R. § 1.181 that could moot the petition under 37 C.F.R. § 1.182, or (3)(b) after within two months after such a petition is dismissed or denied. Since other avenues for entry of the amendment exist under the regulations, relief under § 1.182 which is designed for situations not otherwise

¹ 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

provided for would not be appropriate under the facts and circumstances of the instant proceeding.

2. The Amendment Need Advance, Not Delay, the Proceeding

Patent owner's petition does not does not present persuasive reasons why the Office should act to delay the proceeding in spite of its statutory mandate to handle reexamination proceedings with special dispatch. In accordance with the special dispatch requirement on the Office's handling of the proceeding, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition should therefore clearly discuss the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate.

Patent owner's arguments, in the instant petition, are that that the ACP should have instead been a non-final Office action, and that the ACP included new rejections for the first time for which patent owner should have a chance to respond through entry of claim amendments by reopening of prosecution.

Patent owner's first argument is that the examiner should have issued a non-final Office action rather than an ACP. This argument goes towards whether a specific action taken by an examiner, not related to the substantive merits of a claim, was proper in this proceeding. Such an argument is addressable by a petition under § 1.181, and is therefore not addressable in a petition under § 1.182.

Patent owner's second argument is that the ACP included new rejections for the first time for which patent owner should have a chance to respond through entry of claim amendments by reopening of prosecution. However, although the ACP included new rejections, patent owner's proposed amendment is not alleged to overcome those new rejections and thereby simplify and advance the proceeding. Patent owner does not propose to amend the two patent claims for which new rejections were applied in the ACP; thus, entry of the proposed amendments would not act to reduce or simplify any issues currently in the proceeding. Furthermore, the proposed amendment adds new claims, introducing new issues into this proceeding, while retaining the claims under rejection without change.

On balance, entry of the proposed amendment would not act to define the issues for appeal, or the issuance of a reexamination certificate. For this reason also, action by the Office to reopen the prosecution under § 1.182 would not be in furtherance of the Office's handling of the proceeding with special dispatch, and thus would not be appropriate under the facts and circumstances of the instant proceeding.

In summary, relief under § 1.182 is inappropriate as (1) the situation is not one that is "not specifically provided for" as required under § 1.182, and (2) Office action to grant such relief would have the effect of adding new issues, yet not resolving any of the current issues, such that the proceeding would in the aggregate be delayed rather than advanced by entry of the desired amendment and subsequent reopening of prosecution in the reexamination proceeding.

Accordingly, the petition is **dismissed**.

CONCLUSION

1. The instant petition under 37 C.F.R. § 1.182 is **dismissed**.
2. Prosecution is not being reopened by this decision.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

March 21, 2010



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029
52450	7590	08/08/2011	EXAMINER	
KRIEG, DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 08/08/2011

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WASHINGTON, DC 20006-4675

Date:

MAILED

AUG 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001408

PATENT NO. : 7440565

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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AUG 08 2011

Attn: Dean McConnell
Krieg Devault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204-2079

: (For Patent Owner)
CENTRAL REEXAMINATION UNIT

Attn: Christine McCarthy
Barnes & Thornburg, LLP
750 17th Street NW, Suite 900
Washington, DC 20006-4675

: (For Third Party Requester)

In re McLarty *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,408
Filed: August 13, 2010
For: U.S. Patent No. 7,440,565 B2

: DECISION
: DISMISSING PETITION
: UNDER 37 C.F.R. § 1.181
: AND EXPUNGING
: OPPOSITION PETITION

This is a decision on the May 9, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING REVERSAL OF THE DECISION DATED MARCH 21, 2011, DISMISSING PETITION UNDER 37 C.F.R. § 1.182" and on the June 8, 2011 third party requester petition entitled "OPPOSITION TO OWNER'S PETITION UNDER 37 C.F.R. § 1.181 REQUESTING REVERSAL OF THE DECISION DATED MARCH 21, 2011, DISMISSING PETITION UNDER 37 C.F.R. § 1.182."

The petitions are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is dismissed, and the third party opposition petition is refused entry and expunged from the file.

BACKGROUND

- On July 26, 2010, a request for *inter partes* reexamination of all of the claims of U.S. Patent Number 7,440,565 B2, having 18 claims, was deposited by the third party requester. A corrected request, meeting the filing requirements of 37 C.F.R. § 1.915, was submitted on August 13, 2010, and the resulting reexamination proceeding was assigned control number 95/001,408 ("the '1408 proceeding").
- On October 21, 2010, reexamination was ordered, and an Office action rejecting claims 1-11, 13-16, and 18 was issued. The Office action confirmed the patentability of claims 12 and 17. The Office action set forth a 2 month period for patent owner's response.

- On January 5, 2010, patent owner submitted an Information Disclosure Statement (IDS) containing documents by Bedingfield, Tekelec, Inc. and airBand.
- On January 28, 2011, an Action Closing Prosecution (ACP) was issued. The ACP limited prosecution to claims 12 and 17 in accord with MPEP 2666.10. The ACP applied the newly submitted Bedingfield, Tekelec and airBand references to reject claims 12 and 17, which were previously confirmed as patentable.
- On February 28, 2011, patent owner filed the following papers:
 - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which includes proposed new claims 19-45. All of the remaining original patent claims, claims 12 and 17, remain unamended.
 - The instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date.
- On March 21, 2011, the Office mailed a decision dismissing the February 28, 2011 petition.
- On March 29, 2011, third party requester filed a response under 37 C.F.R. § 1.947.
- On April 8, 2011, the Office issued a Right of Appeal Notice (RAN), rejecting claims 12 and 17, *i.e.*, all of the pending claims in the reexamination. The RAN refused entry of the February 28, 2011 amendment.
- On May 9, 2011, patent owner filed a notice of appeal. Patent owner also filed the following petitions:
 - "Petition Under 37 CFR § 1.183 to Suspend Rules," seeking to suspend the two month time limit as set forth in 37 C.F.R. § 1.181(f).
 - "Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution."
 - "Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice."
 - "Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182," the subject of the current decision.
- On May 23, 2011, third party requester filed a notice of cross-appeal.
- On June 8, 2011, third party requester filed the following petitions:
 - "Opposition to Owner's Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution."
 - "Opposition to Owner's Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice."

- “Opposition to Owner’s Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182,” the subject of the current decision.
- On July 25, 2011, patent owner filed an appellant’s brief.
- Also on July 25, 2011, third party requester filed an appellant’s brief.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 C.F.R. § 1.182 provides:

All **situations not specifically provided** for in the regulations of this part will be decided in **accordance with the merits** of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). (emphasis added)

37 C.F.R. § 1.181 provides, in pertinent part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

37 C.F.R. § 1.951(a) provides:

After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

37 C.F.R. § 1.4(c) provides:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

DECISION

A. Patent Owner's Petition

Patent owner petitions for reversal of the decision dated March 21, 2011. In this decision, the USPTO dismissed patent owner's February 28, 2011 petition under 37 C.F.R. § 1.182. Patent owner now contends that such dismissal was improper because the USPTO could have, but did not, consider whether relief was also proper under § 1.181.

1. Patent Owner Styled the February 28, 2011 Petition For Relief Under § 1.182

The patent owner's February 28, 2011 petition was properly decided only under § 1.182 for the following reasons. First, patent owner chose to title the petition "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION." Patent owner did not, for instance, title the petition as a request for § 1.182, or in the alternative, § 1.181. The title of the petition clearly indicated that relief was requested only under § 1.182.

Second, patent owner's February 28, 2011 petition specifically cited a March, 2005 USPTO Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."¹ Notice was provided therein that a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in the reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. The Notice stated that, by filing such a § 1.182 petition, the patent owner could request "continued prosecution" on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding, or after an action closing prosecution in an *inter partes* reexamination proceeding. In the February 2, 2011 petition, patent owner presented arguments to address these specific requirements (pages 6-8). Further, The Notice stated § 1.181 petitions and § 1.182 petitions to be separate alternatives, and the patent owner petition was clearly not directed to the first alternative.

Clearly, then, patent owner's desired relief was fairly determined to be under § 1.182.

2. Distinct Inquiries Must Be Contained In a Separate Paper to Avoid Confusion Under 37 C.F.R. § 1.4(c).

Section 1.4(c) requires that "since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects."

While patent owner also presented arguments asserting that the ACP was improperly made

¹ 1292 Off. Gaz. Pat. Office 20, March 1, 2005.

(pages 4-6), the patent owner failed to state that relief was being sought under § 1.181 for review of an examiner's action. This presentation of a second distinct subject or inquiry in the February 28, 2011 petition resulted in two consequences adverse to the USPTO's ability to address the petition in the manner now desired by patent owner.

First, the inclusion of multiple inquiries in a single paper causes confusion as to which rule or rules should be applied to determining whether the petition should be granted. In this case, patent owner requested relief only under § 1.182, *i.e.*, for relief not otherwise provided for. If patent owner had sought relief on the basis that the examiner had taken an action or made a requirement that was not in accordance with procedure, there is a rule that provides for it, *i.e.*, § 1.181. Since § 1.182 is only for relief "not specifically provided for in the regulations," § 1.182 is not appropriate for determining relief that is provided for in § 1.181. Thus a petitioner that requests relief only under § 1.182 could not expect that, under the rules, relief that is separately provided for under § 1.181 would also be considered.

This is not merely a technical distinction. Each of the separate rules governing petitions provides different types of relief and have different requirements. To properly determine whether relief may be granted, the Office must be able to determine whether the asserted facts in the petition meet the requirements of the appropriate rule. Where petitioner to state a set of facts and request relief only under a single rule, petitioner is directing the Office to determine whether the facts are of sufficient character so as to justify relief under that rule. Petitioner can not expect that relief under rules not set forth in the petition will be considered by the Office. Section 1.4(c) requires that different inquiries be presented in separate papers to avoid exactly this type of confusion.

Second, § 1.4(c) is designed to avoid the situation in which distinct matters are raised in a single paper, but each inquiry would be considered by a different section of the Office. While a petition under § 1.182 is generally addressed by the Office of Patent Legal Administration, a petition under § 1.181 for supervisory review of an examiner's action or requirement is generally addressed by the Central Examination Unit.

Thus, it is inappropriate for a request for review of an examiner's decision to be included in the same paper as a request for relief not provided for under the rules, as different sections of the Office would handle the separate requests.

For the above reasons, the February 28, 2011 petition cannot be taken as a petition for relief both under § 1.181 (for review of the examiner's decision to designate the January 8, 2011 petition as an ACP) and under § 1.182 (to reopen prosecution after ACP and enter claim amendments). Section 1.4(c) precludes such an interpretation of the February 28, 2011 petition. Clearly, the petition was properly addressed under the sole specified rule, § 1.182.

3. Other Avenues For Seeking Entry of the Claim Amendments Were Available.

It is noted that patent owner was notified in the March 21, 2011 decision that relief under § 1.181 (from an examiner's action or requirement) would not be provided through the February 28, 2011 petition under § 1.182. Patent owner was not precluded by the two month period for filing a petition to address the ACP, as set forth in § 1.181(f), since that period did not expire

until March 28, 2011, two months after the January 28, 2011 ACP was issued. Patent owner had the opportunity, at that point, to file a separate petition under § 1.181 for the desired relief. Furthermore, § 1.181(f) states only that a petition not filed within two months of the mailing date of the action from which relief is requested “may be dismissed as untimely.”

4. Other Avenues for Relief Remain Available.

Patent owner is not, through this decision, being denied the opportunity to pursue relief under § 1.181. Patent owner currently has outstanding petitions for such relief, entitled “Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution” and “Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice.” Patent owner’s request for relief on the basis that the February 28, 2011 Office action should not have closed prosecution will therefore be addressed in due course.

B. Requester’s Opposition Petition

With respect to the June 8, 2011 requester paper opposing patent owner’s petition under 37 CFR 1.181, neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the third party requester to file an opposition to, or comment on, the patent owner’s petition to request review of a decision dismissing a petition requesting continued reexamination. A request for continued reexamination is **not** a response to an “Office action on the merits.” Rather, it goes to an issue that goes to formal requirements and is a matter within the discretion of the Office in balancing the equities as to the “special dispatch” requirement and the needs of a specific situation. Stated differently, as pointed out above, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to the USPTO Director to provide relief not expressly provided for by the rules. The latter is clearly a matter within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester’s participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition that requests continuing reexamination. No mechanism has been provided for the third party requester to file a paper, such as the present paper, that is in response to an event other than a patent owner response to an Office action. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

A third party requester’s opposition to a patent owner’s petition requesting review of a decision dismissing a request for continuing reexamination is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is also not permitted as a submission of written comments to a patent owner’s response to an Office action, since such third party written comments are the subject of a separate paper. Third party requester’s opposition to patent owner’s petition is therefore not enterable into the record.

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office,² the consideration of a request for continued reexamination (including a review of a decision on the request) is clearly within the Office's jurisdiction,³ and the Office may exercise its discretion to grant such relief to provide a limited reopening of prosecution. Therefore, the requester's June 8, 2011 opposition is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

In view of the above, the opposition will be refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a) - "[I]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's October 19, 2009 opposition to the patent owner's petition for continuing reexamination filed on October 8, 2009 does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding, the requester's paper opposing patent owner's request for revival will be expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. The patent owner petition under 37 C.F.R. § 1.181 is **dismissed**.
2. The third party opposition petition is **refused entry** and **expunged** from the file.
3. Prosecution is not being reopened by this decision.
4. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 8, 2011
Kenpet8/

² Compare the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act. Such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding.

³ As to a patent owner's petition requesting continuing reexamination being a matter within the jurisdiction of the Office, 35 U.S.C. § 314(a) provides that reexamination will be conducted "according to the procedures established for initial examination under the provisions of sections 132 and 133." The Office clearly has the authority to reopen prosecution, in exercising its discretion.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029
52450	7590	08/17/2011	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 08/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

BARNES & THORNBURG LLP

750 17th STREET NW

SUITE 900

WASHINGTON, DC 20006-4675

Date:

MAILED

AUG 17 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001408

PATENT NO. : 7440565

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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AUG 17 2011

CENTRAL REEXAMINATION UNIT

Attn: Dean McConnell
Krieg Devault LLP
One Indiana Square, Suite 2800
Indianapolis, IN 46204-2079

: (For Patent Owner)

Attn: Christine McCarthy
Barnes & Thornburg, LLP
750 17th Street NW, Suite 900
Washington, DC 20006-4675

: (For Third Party Requester)

In re McLarty *et al.*
Inter Partes Reexamination Proceeding
Control No. 95/001,408
Filed: August 13, 2010
For: U.S. Patent No. 7,440,565 B2

: **DECISION**
: **DISMISSING PETITION**
: **UNDER 37 C.F.R. § 1.183**
: **TO SUSPEND § 1.181(f)**
:

This is a decision on the May 9, 2011 patent owner petition entitled "PETITION UNDER 37 CFR § 1.183 TO SUSPEND RULES."

The petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is **dismissed**.

BACKGROUND

- On July 26, 2010, a request for *inter partes* reexamination of all of the claims of U.S. Patent Number 7,440,565 B2, having 18 claims, was deposited by the third party requester. A corrected request, meeting the filing requirements of 37 C.F.R. § 1.915, was submitted on August 13, 2010, and the resulting reexamination proceeding was assigned control number 95/001,408 ("the '1408 proceeding").
- On October 21, 2010, reexamination was ordered, and an Office action rejecting claims 1-11, 13-16, and 18 was issued. The Office action confirmed the patentability of claims 12 and 17. The Office action set forth a 2 month period for patent owner's response.
- On January 5, 2010, patent owner submitted an Information Disclosure Statement (IDS) containing documents by Bedingfield, Tekelec, Inc. and airBand.

- On January 28, 2011, an Action Closing Prosecution (ACP) was issued. The ACP limited prosecution to claims 12 and 17 in accord with MPEP 2666.10. The ACP applied the newly submitted Bedingfield, Tekelec and airBand references to reject claims 12 and 17, which were previously confirmed as patentable.
- On February 28, 2011, patent owner filed the following papers:
 - A paper entitled “RESPONSE TO ACTION CLOSING PROSECUTION,” which includes proposed new claims 19-45. All of the remaining original patent claims, of which claims 12 and 17 are subject to further prosecution, remain unamended.
 - A petition entitled “PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION,” requesting entry of the amendment and remarks filed on the same date.
- On March 21, 2011, the Office mailed a decision dismissing the February 28, 2011 petition.
- On March 29, 2011, third party requester filed comments under 37 C.F.R. § 1.947.
- On April 8, 2011, the Office issued a Right of Appeal Notice (RAN), rejecting claims 12 and 17, *i.e.*, all of the pending claims in the reexamination. The RAN refused entry of the February 28, 2011 proposed amendment.
- On May 9, 2011, patent owner filed a notice of appeal. Patent owner also filed the following petitions:
 - “Petition Under 37 CFR § 1.183 to Suspend Rules,” seeking to suspend (a) the two month time limit as set forth in 37 C.F.R. § 1.181(f) and (b) the limitation provision of 37 C.F.R. § 1.957(c), the subjects of the current decision.
 - “Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution.”
 - “Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice.”
 - “Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182.”
- On May 23, 2011, third party requester filed a notice of cross-appeal.
- On June 8, 2011, third party requester filed the following petitions:
 - “Opposition to Owner’s Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution.”
 - “Opposition to Owner’s Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice.”
 - “Opposition to Owner’s Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182.”
- On July 25, 2011, patent owner filed an appellant’s brief.

- Also on July 25, 2011, third party requester filed a cross-appellant's brief.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.181 provides, in pertinent part:

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court
- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.4(c) provides:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

DECISION

A. Patent owner's request to waive § 1.181(f) is dismissed on its merits.

Patent owner petitions for waiver of the provision of Rule 1.181(f) stating that any petition under §§ 1.181, 1.182, or 1.183 "may be dismissed as untimely" if not filed "within two months of the mailing date of the action or notice from which relief is requested." Patent owner's petition is

submitted under § 1.183, which permits waiver of a rule, which is not a requirement of the statutes, in an “extraordinary situation, when justice requires” the requested relief. Relief may be granted, therefore, only if the existence of an extraordinary situation such that justice requires relief can be found in the current instance.

In this instance, relief under § 1.183 is not needed. The “Petition Under 37 C.F.R. § 1.181 Requesting Withdrawal of Right of Appeal Notice” and the “Petition Under 37 C.F.R. § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182” were filed within two months of the April 8, 2011 RAN and March 21, 2011 decision on petition. With respect to the “Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution,” the following is pointed out:

Patent owner submitted, on February 28, 2011, a timely § 1.182 petition for the same relief desired in the May 9, 2011 petition under § 1.181, and that prior timely petition was dismissed by notifying petitioner that relief under § 1.181 (from an examiner’s action or requirement) would not be provided through the February 28, 2011 petition under § 1.182. Patent owner had two months from that notification to file a petition, as set forth in § 1.181(f), and has filed the pending “Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution” within the two months.

Since relief under § 1.183 is not needed, no extraordinary situation exists such that justice requires waiver of § 1.181(f) and the petition is dismissed as to this aspect.

B. Patent owner’s request to waive § 1.957(c) is not considered pursuant to § 1.4(c).

Section 1.4(c) requires that “each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.”

The instant petition also requests waiver of § 1.957(c) to permit the entry of a multitude of new claims after the ACP, based upon facts different than those discussed above. This is clearly a distinct subject and inquiry from waiver of § 1.181(f) as discussed above. As the language of § 1.4(c) is mandatory - “must be contained in a separate paper” - rather than permissive, this second inquiry will not be addressed in this decision. Patent owner may file a separate petition for this relief. However, it is not recommended that patent owner file a new petition under § 1.183, in view of the following:

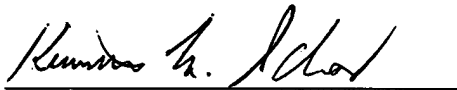
37 C.F.R. § 1.183 does not provide relief in the instant scenario, given patent owner’s stated intent. It is noted that the present May 9, 2011 petition at page 2 states with respect to patent owner’s intent:

5. Owner elected not to respond to the initial Office Action because the Examiner had confirmed claims 12 and 17 in the initial Office Action. This decision was made not because Owner agreed with the proposed rejections of claims 1-11, 13-16 and 18, but rather to expedite the issuance of a reexamination certificate in this case for the purpose of expediting resolution of the pending litigation between the parties. In short, Owner chose not to respond to the initial Office Action

solely because of the pending litigation between the parties, with the intent to accept a reexamination certificate confirming the patentability of claims 12 and 17 and address patentability issues regarding the subject matter of claims I-II, 13-16 and 18 outside of this proceeding (i.e., in related *inter partes* reexamination proceeding Control No. 95/001,409 and/or in a continuing regular utility patent application pending in the U.S. Patent and Trademark Office or to be filed at a later time).

CONCLUSION

1. The patent owner petition under 37 C.F.R. § 1.183 is **dismissed**.
2. Pursuant to 37 C.F.R. § 1.4(c), consideration of waiver of § 1.957(c) is not reached in this decision.
3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

August 17, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029
52450	7590	02/17/2012	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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750 17th STREET NW
SUITE 900
WASHINGTON, DC 20006-4675

Date: **MAILED**
FEB 17 2012
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001408
PATENT NO. : 7440565
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Dean E. McConnell : (For Patent Owner)
KRIEG DEVAULT, LLP :
One Indiana Square :
Suite 2800 :
Indianapolis, IN 46204 :

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FEB 17 2012

CENTRAL REEXAMINATION UNIT

Christine H. McCarthy :
BARNES & THORNBURG, LLP :
750 17th Street, NW : (For Third Party
Suite 900 : Requester)
Washington, DC 20006 :

In re: McLarty et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/001,408 :
For: U.S. Patent No.: 7,440,565 :

This is a decision on a petition filed by the patent owner: a petition filed on May 9, 2011, entitled "PETITION UNDER TO 37 C.F.R. § 1.181 TO WITHDRAW THE FINALITY OF ACTION CLOSING PROSECUTION" [hereinafter "petition 1"], and a petition filed by Third Party Requestor on June 8th, 2011, entitled "OPPOSITION TO OWNER'S PETITION TO WITHDRAW THE FINALITY OF ACTION CLOSING PROSECUTION" [hereinafter "petition 2"].

Petition 1 is treated as a petition under 37 CFR § 1.181. Petition 2 is treated also as a petition under 37 CFR § 1.181 as a submission in opposition to Petition 1.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. Petition 1 is **dismissed as untimely** for reasons set forth below, without consideration of the merits. In light of the Office's decision with regards to Petition 1, petition 2 is **dismissed as moot**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,440,565 issued on October 21, 2008.
- A corrected request for *inter partes* reexamination was August 13, 2010 and assigned control no. 95/001,408.
- *Inter partes* reexamination was ordered on October 21, 2010.
- A Non-final Rejection was mailed on October 21, 2010.
- An Action Closing Prosecution (ACP) was mailed on January 28, 2011.
- Patent Owner's Response to an ACP was received by the Office and serviced to the Third Party Requestor on February 28, 2011.
- The Third Party Requestor's Comments responsive to the Patent Owners comments after an ACP were received and serviced to the Patent Owner on March 29, 2011.
- A Right of Appeal Notice (RAN) was mailed on April 8, 2011.
- Patent Owner filed a Petition under 37 CFR 1.183 "TO SUSPEND RULES" on May 9, 2011.
- Patent Owner filed a Petition under 37 CFR 1.181 "REQUESTING WITHDRAWAL OF RIGHT OF APPEAL NOTICE" on May 9, 2011.
- Patent Owner filed a Petition "petition 1" on May 9, 2011.
- The Third Party Requester filed a Petition "petition 2" in opposition to petition 1 on June 8, 2011.
- The Third Party Requester filed a Petition in opposition to Patent Owner's petition requesting the withdrawal of the RAN on June 8, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is **not** extendable. (emphasis added)

DECISION

Petition 1

Patent owner ["petitioner"] brings before the Office a petition under 37 CFR 1.181 to review and withdraw the Action Closing Prosecution (ACP), dated January 28, 2011. The petitioner filed the petition on May 9, 2011. The action from which relief is requested is the ACP, which was mailed on January 28, 2011. The petitioner further filed a petition under 37 CFR 1.183, also dated May 9, 2011, requesting suspension of time limit of two month to seek relief under 37 CFR 1.181. In regards to the 1.183 petition, a decision was rendered dated August 17, 2011 dismissing the petition on grounds that no extraordinary situation exists such that justice requires a waiver of 1.181(f). Therefore, in light of the decision of the 1.183 decision the petition was filed over **two** months from the mailing date of the action (January 28, 2011) from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is **not** extendable.

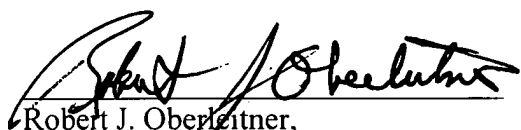
Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

Petition 2

Third Party Requester ["petitioner"] argues in petition 2 that Patent Owner's May 9, 2011 Petition (petition 1) is without merit and should be dismissed. In light of the Office's decision with regards to Petition 1 (see above), the petition 2 is **dismissed as moot**.

CONCLUSION

1. The petition filed May 9, 2011 (petition 1), is **dismissed** as untimely and the petition filed on June 8, 2011 (petition 2), is **dismissed** as moot.
2. Telephone inquiries related to this decision should be directed to Sudhanshu C. Pathak, Supervisory Patent Reexamination Examiner, at (571) 272-5509 or in his absence to the undersigned at (571) 272-0700.



Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029
52450	7590	04/09/2012	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 04/09/2012

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BARNES & THORNBURG LLP

750 17th STREET NW

SUITE 900

WASHINGTON, DC 20006-4675

Date:

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APR 09 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001408

PATENT NO. : 7440565

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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: (For Patent Owner)
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CENTRAL REEXAMINATION UNIT

BARNES & THORNBURG, LLP
750 17th Street NW, Suite 900
Washington, DC 2006-4675

: (For Third Party Requester)
:
:

In re McLarty *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,408
Filed: 13 August 2010
For: U.S. Patent No. 7,440,565

: DECISION DENYING
: PETITION UNDER
: 37 C.F.R. § 1.181
: AND DISMISSING
: OPPOSITION PETITION

This is a decision addressing patent owner's petition, filed 9 May 2011, entitled "PETITION UNDER 37 CFR § 1.181 REQUESTING WITHDRAWAL OF RIGHT OF APPEAL NOTICE" [hereinafter, "the petition"] and third party requester's petition, filed 8 June 2011, entitled "OPPOSITION TO OWNER'S PETITION UNDER 37 CFR § 1.181 REQUESTING WITHDRAWAL OF RIGHT OF APPEAL NOTICE" [hereinafter, "the opposition"]. This decision solely addresses issues raised under 37 CFR 1.181, e.g., whether the examiner followed the laws and procedures in denying entry of the amendment in the right of appeal notice (RAN).

The petition is before the Director of the Central Reexamination Unit for decision.

For the reasons set forth below, the patent owner's petition is DENIED, and the third party's opposition petition is DISMISSED as untimely.

STATEMENT OF FACTS RELEVANT TO THE DECISION

- On 21 October 2008, Patent No. 7,440,565 (the '565 patent) issued with 18 claims.
- On 26 July 2010, third party requester [hereinafter, "the requester"] deposited a request for *inter partes* reexamination of all of the claims of the '565 patent.
- On 13 August 2010, requester submitted a corrected request, meeting the filing requirements of 37 C.F.R. § 1.915, and the Office assigned the resulting reexamination proceeding control number 95/001,408 (hereinafter, "the '408 proceeding").
- On 21 October 2010, the Office ordered reexamination and issued an Office action on the merits, which rejected claims 1-11, 13-16, and 18. The Office action confirmed the patentability of claims 12 and 17. The Office action set forth a 2 month period for patent owner's response.
- On 5 January 2010, patent owner submitted an Information Disclosure Statement (IDS) containing documents by Bedingfield, Tekelec, Inc. and airBand.
- On 28 January 2011, the Office issued an action closing prosecution (ACP). The ACP limited prosecution to claims 12 and 17 in accordance with MPEP 2666.10. The ACP applied the newly submitted Bedingfield, Tekelec and airBand references to reject claims 12 and 17, which were previously confirmed as patentable.
- On 28 February 2011, patent owner filed the following papers:
 - A paper entitled "RESPONSE TO ACTION CLOSING PROSECUTION," which included proposed new claims 19-45. All of the remaining original patent claims, i.e., claims 12 and 17, remain unamended.
 - A petition entitled "PETITION UNDER 37 CFR § 1.182 REQUESTING CONTINUED REEXAMINATION," requesting entry of the amendment and remarks filed on the same date.
- On 21 March 2011, the Office mailed a decision dismissing the 28 February 2011 petition.
- On 29 March 2011, requester filed comments under 37 CFR 1.947.
- On 8 April 2011, the Office issued a right of appeal notice (RAN), rejecting claims 12 and 17, i.e., all of the pending claims in the reexamination. The RAN refused entry of the 28 February 2011 amendment.

- On 9 May 2011, patent owner filed a notice of appeal. Patent owner also filed the following petitions:
 - “Petition Under 37 CFR § 1.183 to Suspend Rules,” seeking to suspend the two month time limit as set forth in 37 C.F.R. § 1.181(f).
 - “Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution.”
 - “Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice,” which is the subject of the current decision.
 - “Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182.”
- On 23 May 2011, requester filed a notice of cross-appeal.
- On 8 June 2011, requester filed the following petitions:
 - “Opposition to Owner's Petition Under 37 CFR § 1.181 To Withdraw the Finality of Action Closing Prosecution.”
 - “Opposition to Owner's Petition Under 37 CFR § 1.181 Requesting Withdrawal of Right of Appeal Notice,” which is the subject of the current decision.
 - “Opposition to Owner's Petition Under 37 CFR § 1.181 Requesting Reversal of the Decision Dated March 21, 2011, Dismissing Petition Under 37 C.F.R. § 1.182,” which was expunged from the record by the decision on 8 August 2011.
- On 25 July 2011, patent owner filed an appellant’s brief.
- Also on 25 July 2011, requester filed an appellant’s brief.
- On 8 August 2011, the Office mailed a decision dismissing the 9 May 2011 patent owner petition requesting reversal of the Office’s previous decision, and refusing entry to and expunging the 8 June 2011 requester’s opposition thereof.
- On 17 August 2011, the Office mailed a decision dismissing the 9 May 2011 patent owner petition filed under 37 CFR 1.183.
- On 23 August 2011, requester filed a respondent brief.
- On 21 November 2011, the Office issued an examiner’s answer.
- On 17 February 2012, the Office mailed a decision dismissing the 9 May 2011 patent owner petition requesting withdrawal of the ACP, and dismissing the 8 June 2011 requester’s opposition thereof.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 1.116, states in part:

(b) After a final rejection or other final action (§ 1.113) in an application or in an *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

37 CFR 1.181, states in part:

(a) Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

37 CFR 1.951, states:

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

MPEP 2667(II)(B)(3), states in part:

Thus, for example, in instances where there is a right to file an opposition to a petition, any such opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party, to ensure consideration. Any such opposition that is filed after the two-week period will remain in the record, even though it is not considered.

MPEP 2673.01, states in part:

I. MANDATORY REOPENING

Where a submission after Action Closing Prosecution (ACP) has been filed pursuant 37 CFR 1.951(a) (and 37 CFR 1.951(b)) and the examiner decides to modify his/her position, the examiner should ordinarily reopen prosecution, in accordance with the following guidelines.

The patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. A Right of Appeal Notice (RAN) cannot be issued until the patent owner has had the opportunity to address each and every rejection prior to the appeal stage. Thus, the examiner should reopen prosecution where any new ground of rejection is made or any additional claim is rejected.

...

II. DISCRETIONARY REOPENING

In addition to the above situation which *requires* reopening of prosecution, the examiner should be liberal in reopening prosecution where the equities of the situation make such appropriate, because patent owner cannot continue the proceeding by refiling under 37 CFR 1.53(b) or 1.53(d), nor by filing a Request for Continued Examination under 37 CFR 1.114.

In example of this would be as follows. Patent owner might submit an amendment after the ACP which would make at least one claim patentable, except for one or two minor changes needed to obviate a rejection. The examiner **cannot** telephone the owner to obtain the minor change(s) and then issue a RAN because interviews are not permitted in an *inter partes* reexamination proceeding. Also, the examiner **cannot** make the changes by issuing an examiner's amendment coupled with a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) because of the presence of the third party requester, i.e., the third party requester is entitled to a RAN so that the claims found patentable can be appealed. Yet, in this situation, it would be inequitable to send the claims to appeal based on the minor points that could be easily corrected. Accordingly, the examiner would reopen prosecution (since 37 CFR 1.953 requires reopening where a RAN is not issued) and issue a new ACP suggesting the amendment which will make the claims patentable. The third party requester would then have an opportunity to comment on the newly-found-patentable claims after the patent owner submits the suggested amendment pursuant to 37 CFR 1.951(a).

DECISION ON PETITION

The patent owner seeks relief under 37 C.F.R. 1.181 to have the right of appeal notice (RAN) dated 8 April 2011 withdrawn and to have the amendment dated 28 February 2011 entered into the proceeding record. Petition, p. 5. The patent owner specifically requests that the Director find that the RAN improperly denied entry of the proposed amendment dated 28 February 2011 because patent owner has shown good and sufficient reason why the proposed amendment was necessary and not earlier presented. *See, e.g.*, Petition, p. 5.

In response to patent owner's arguments for entering the 28 February 2011 proposed amendment in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so. At the outset, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing a RAN and/or an ACP. As set forth below, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue a RAN, and did not categorically deprive the patent owner of its statutory rights to present amendments and evidence in reexamination proceedings.

Additionally, upon review of the record, it is clear that the 28 February 2011 amendments do more than merely cancel claims, adopt examiner's suggestions, remove issues for appeal, or in some other way require only a cursory review by the examiner. *See*, 37 CFR 1.116(b) and MPEP 2673. For example, the amendments add new claims 19-45 that contain limitations that were not previously claimed. The examiner made a showing of why entry of the amendment would be an undue burden as required by 37 CFR 1.116 and MPEP 2673. *See* RAN, p. 5. Specifically, the examiner cited to a petition decision that explained that the proposed amendments would introduce new issues to the proceeding without reducing or simplifying any issues currently in the proceeding. *Id.* Therefore, the record shows that the examiner properly determined that the proposed post-ACP amendment should not be entered under either 37 CFR 1.116(b)(1) or (b)(2).

Furthermore, patent owner has not shown that the examiner erred in concluding on pages 2-5 of the RAN that the proposed amendment and showing, made on pages 20-21 of the response dated 28 February 2011, did not satisfy 37 CFR 1.116(b)(3). In this petition, patent owner specifically asserts that the RAN contained two errors when setting forth its reasons to support the denial of entry of the proposed new claims 19-45 under 37 CFR 1.116(b)(3). Petition, p. 8. First, patent owner asserts that the examiner applied an incorrect standard for ascertaining whether the amendments comply with 37 CFR 1.116(b)(3) when the examiner stated that "it has not been shown that the Patent Owner could not have submitted these claims prior to ACP". Petition, p. 8 (citing to page 4 of the RAN). However, while the examiner does make the aforementioned statement, the examiner goes on to explain that "[t]he Patent Owner's rationale is based on.

rejections of originals [sic] claims 12 and 17” and that “[t]he Patent Owner has not explained why new claims 19-45 are necessary and was [sic] not earlier presented.” RAN, p. 4 (emphasis in original). Taking these statements by the examiner in context, patent owner has not shown that the examiner applied an incorrect standard, as more fully explained below.

As set forth above, 37 CFR 1.116(b)(3) requires a showing of good and sufficient reason why the amendment was necessary and was not earlier presented. In the response, dated 28 February 2011, patent owner only asserted that entry of the amendments is proper under 37 CFR 1.116(b)(3), as follows:

Because all of the rejections of claims 12 and 17 that have been asserted in the January 28, 2011, Office Action are based in part on the above-identified references, because no rejection of claims 12 and 17 were asserted in the initial Office Action dated October 21, 2010, and because Owner had no knowledge of these references at the time its prior response period ended, Owner had no previous opportunity to evaluate these references or these rejections, or submit arguments or claim amendments formulated to address such rejections, at any prior point in the course of this proceeding.

Response, dated 28 February 2011, pp. 20-21. However, as correctly noted by the examiner, this rationale is based solely on the rejection of original claims 12 and 17. *See*, RAN, p. 4. Also, as noted by the examiner, the response filed on 28 February 2011 does not amend claims 12 and 17. *See, id.* Rather, the response only proposes new claims 19-45, where none of these claims depend upon claims 12 and 17. Thus, this showing, which only discusses the rejection of claims 12 and 17, does not set forth good and sufficient reason why the amendment, i.e. the addition of new claims 19-45 without any amendment to claims 12 and 17, is necessary and was not earlier presented.

The second error alleged by patent owner is the RAN’s citation, in its justification for denying entry of the proposed amendment, of the 21 March 2011 decision dismissing patent owner’s 28 February 2011 petition filed under 37 CFR 1.182. Petition, p. 10. Specifically, patent owner alleges that this citation was directed to the Office’s determination “that Rule 182 requires Owner to show that the proposed amendment does not add new issues that would result in the proceeding in the aggregate being delayed rather than advanced by entry of the proposed amendment and reopening of prosecution.” Petition, p. 10. According to patent owner, this citation “does not address the question of whether the Patent Owner has shown ‘good and sufficient reasons why the amendment is necessary and was not earlier presented.’” *Id.* However, this citation does address issues that are pertinent to 37 CFR 1.116(b)(3).

Rule 116(b)(3) is discretionary since it only sets forth that “[a]n amendment touching the merits of the application or patent under reexamination *may* be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.” (emphasis added). Thus, an examiner must look at a variety of factors when determining whether to enter

an amendment under 37 CFR 1.116(b)(3). For example, the MPEP directs an examiner to “be liberal in reopening prosecution where the equities of the situation make such appropriate”. MPEP 2673.01(II). One of the factors that an examiner must weigh includes the delay imposed by entering the amendment given that the mandate of “special dispatch” permeates every aspect of reexamination. *See e.g.*, 35 USC 314(c). Thus, it was appropriate for the examiner to cite to and rely on the determinations made in the 21 March 2011 petition decision, which go to the equities of the situation, when assessing whether to enter the amendment under 37 CFR 1.116.

The examiner needs only to state a single reasonable basis for denying entry, and upon review of the record at the time of the RAN, the record supports the examiner’s analysis. In other words, the record does not show that the examiner’s actions were arbitrary and capricious.

In addition, patent owner currently argues in the petition that “the amendment is necessary in order to give Owner a full and fair opportunity to have patent claims affirmed on reexamination that encompass subject matter to which it is entitled”. Petition, p. 5. However, patent owner has not cited any supporting authority for the proposition that a patent owner is entitled to have a full and fair opportunity to have patent claims *affirmed* on reexamination that encompass subject matter to which it is entitled. While the MPEP does caution examiners that “[a] Right of Appeal Notice (RAN) cannot be issued until the patent owner has had the opportunity to address each and every rejection prior to the appeal stage,” MPEP 2673.01(I), this does not go as far as patent owner’s statement to require patent owner to have a full and fair opportunity to have patent claims *affirmed* on reexamination. Further, in this case, patent owner was given an opportunity to address each and every rejection, namely the rejections of claims 12 and 17, prior to the appeal stage since patent owner had the opportunity to file comments on the rejection of claims 12 and 17 in the response of 28 February 2011. In view of the foregoing, the record supports the examiner’s determination to issue a RAN, such that the examiner’s actions were not arbitrary and capricious.

In summary, the examiner appropriately applied Office policies and procedures in determining that the post-ACP amendment should not be entered, and issued a RAN in the interest of “special dispatch.” In addition, the current petition does not make a showing of a good and sufficient reason why the 28 February 2011 amendment is necessary and was not earlier presented. For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in deciding to not enter the post-ACP amendments.

Therefore, the patent owner's petition is denied.

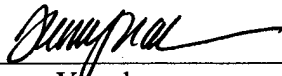
DECISION ON OPPOSITION

As noted above, requester filed an opposition on 8 June 2011 to the patent owner's petition filed on 9 May 2011. However, any "opposition must be filed within two weeks of the date upon which a copy of the original petition was served on the opposing party". MPEP 2667(II)(B)(3). Here, requester filed the opposition on 8 June 2011. Patent owner served a copy of the petition on requester on 9 May 2011. Since 8 June 2011 is more than two weeks after 9 May 2011, the opposition is untimely and the opposition will not be considered on the merits. The opposition will remain in the record, even though it is not considered, per MPEP 2667(II)(B)(3).

Therefore requester's opposition is dismissed as untimely.

CONCLUSION

1. Patent owner's petition under 37 CFR 1.181, filed 28 February 2011, is DENIED for the reasons discussed above.
2. Requester's opposition to patent owner's petition is DISMISSED as untimely.
3. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,409	08/13/2010	7680256	51783-2 (256)	6267
52450	7590	02/18/2011	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 02/18/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BARNES & THORNBURG LLP

750 - 17TH STREET, NW

SUITE 900

WASHINGTON, DC 20817

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FEB 8 2001
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001409

PATENT NO. : 7680256

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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KRIEG DEVAULT LLP
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INDIANAPOLIS, IN 46204-2079

(For Patent Owner)

MAILED

FEB 18 2011

CENTRAL REEXAMINATION UNIT

CHRISTINE H. MCCARTHY, ESQ.
BARNES & THORNBURG LLP
750 - 17TH STREET, NW, SUITE 900
WASHINGTON, DC 20006-4675

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,409
Filed: August 13, 2010
For: U.S. Patent No. 7,680,256

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION**
:

This is a decision on patent owner's petition paper entitled "PETITION PURSUANT TO 37 C.F.R. §1.181 OR, ALTERNATIVELY, 37 C.F.R. §1.182 OR ALTERNATIVELY 37 C.F.R. § 1.183 TO SUSPEND THE PAGE AND WORD COUNT LIMITATIONS OF 37 C.F.R. § 1.943," filed on December 7, 2010. The patent owner petition is taken as a petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) that the response by the patent owner not exceed fifty (50) pages length. Patent owner subsequently filed its response under 37 CFR 1.945 on December 22, 2010.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in the response by the patent owner is granted to the extent that the page limit for the response by the patent owner is extended to not exceed 51 pages in length.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the October 22, 2010 non-final Office action, and requests that the page limit be extended to 100 pages.¹ Patent owner subsequently filed a response to the non-final Office action on December 22, 2010.

In support of its request for waiver of the rule, patent owner argues that additional pages are needed to "address the voluminous *inter partes* request as well as the 79 page Non-Final Office Action."²

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's December 22, 2010 response includes 33 pages of remarks and 15 pages of claim support, both of which are subject to the 50 page limit.

The patent owner response is also accompanied by a declaration of Brandon D. McLarty under 37 CFR 1.132 (attached as Exhibit 2) and two diagrams (attached as Exhibits A and 3) illustrating the relationship between the claimed invention and the Cinema reference.

¹ Petition at page 4.

² *Id.*

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 2–page declaration of McLarty contains legal arguments. Examples of legal arguments in the McLarty declaration, which are not exhaustive, that count toward the page limit are:

In paragraph 5, on page 1, declarant McLarty argues that “CINEMA's actual network relationship to the claimed invention is illustrated in Ex. A attached hereto.”

In paragraph 8, on page 2, declarant McLarty argues the following: “Owner's claimed communication network would, and should, when read in light of the specification of the ‘256 Patent, be properly construed as an Internet-based communication network in communication with at least a public switched telephone network, a VoIP network, and a wireless network when read in light of the specification of the ‘256 Patent.”

The two diagrams, illustrating how the Cinema prior art reference relates to the presently claimed invention are extensions of declarant McLarty’s legal arguments regarding the Cinema reference, and therefore count toward the page limit. Since the two diagrams are identical, only one is counted toward the page limit.

Accordingly, the December 22, 2010 patent owner response *in toto* is 51 pages in length.

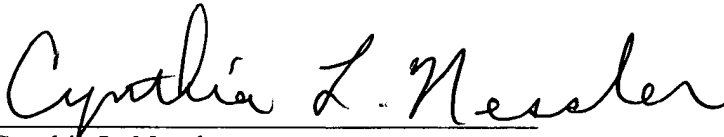
37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner’s response to run 51 pages in length is appropriate in the interest of justice.

Accordingly, the patent owner’s petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the patent owner’s response

to exceed the page limit by up to one page. This waiver makes the patent owner's December 22, 2010 response page-length compliant.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's response filed on December 22, 2010 may exceed the page limit by up to one page. This waiver makes the December 22, 2010 patent owner response page-length compliant.
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2/7/11
Cindypet8/IP/length



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,409	08/13/2010	7680256	51783-2 (256)	6267
52450	7590	04/13/2011	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001409
PATENT NO. : 7680256
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,409
Filed: August 13, 2010
For: U.S. Patent No. 7,680,256

: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on third party requester's petition paper entitled "PETITION TO WAIVE PAGE LIMIT FOR REQUESTER'S COMMENTS ON OWNER'S RESPONSE AND FIRST OFFICE ACTION," filed on January 21, 2011.

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is dismissed as moot.

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APR 13 2011
CENTRAL REEXAMINATION UNIT

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on January 21, 2011. In support of its request for waiver of the rule, third party requester argues that additional pages are needed to address patent owner's characterization of the prior art references and the claimed features and to provide detailed analysis of the newly added claims and their rejections under 35 U.S.C. §§ 102 and 103.¹ In addition, third party requester argues that a number of new claims in the amendment appears to be unsupported by the originally filed specification and would require a clear explanation of the basis for rejections under 35 U.S. C. 112, first paragraph.²

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's January 21, 2011 written comments include 50 pages of remarks,³ which are within the 50 page limit of 37 CFR 1.943(b).

Accordingly, third party requester's petition under 37 CFR 1.183 is **dismissed as moot**, as the comments submission of January 21, 2011 is page-length compliant.

¹ Petition at 2.

² *Id.*

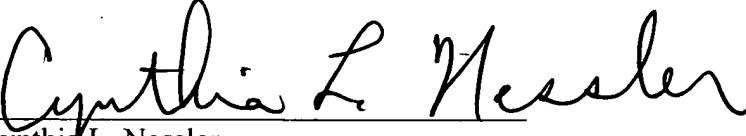
³ The table of contents is not counted toward the page limit.

IV. Correspondence Address of Record for the Third Party Requester

The Office notes that the address of record for the third party requester, as indicated on page 2 of the July 26, 2010 "Request for *Inter Partes* Reexamination Transmittal Form", is the address corresponding to customer number 23646, and is shown in the caption of this decision, i.e., the address of Barnes & Thornburg, LLP, at the Pennsylvania Avenue address in Washington, D.C. (the Pennsylvania Avenue address). The Office is correcting the address of record in the database of the Central Reexamination Unit (CRU), as of the mail date of this decision, to indicate the Pennsylvania Avenue address. A courtesy copy of this decision is being sent to Christine McCarthy, of Barnes & Thornburg LLP, at the 17th street address of this law firm in Washington, D.C. also as indicated in the caption of this decision. **All future correspondence, however, will be mailed only to the Pennsylvania Avenue address.**

CONCLUSION

- The third party requester petition under 37 CFR 1.183 is **dismissed as moot**, as third party requester's January 21, 2011 comments submission is page-length compliant.
- The official correspondence address of record for the third party requester is the address corresponding to customer number 23646, as shown in the caption of this decision. A courtesy copy of this decision is being sent to Christine McCarthy, of Barnes & Thornburg LLP, at the 17th street address of this law firm in Washington, D.C., as indicated in the caption of this decision. **All future correspondence, however, will be mailed only to the Pennsylvania Avenue address.**
- Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.


Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

4/12/11
Cindypet8/IP/length



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,409	08/13/2010	7680256	51783-2 (256)	6267
52450	7590	02/17/2012	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BARNES & THORNBURG LLP

750 - 17TH STREET, NW

SUITE 900

WASHINGTON, DC 20817

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001409

PATENT NO. : 7680256

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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KRIEG DEVAULT LLP
ONE INDIANA SQUARE
SUITE 2800
INDIANAPOLIS, IN 46204-2079

(FOR PATENT OWNER)

MAILED

FEB 17 2012

CENTRAL REEXAMINATION UNIT

BARNES & THORNBURG LLP
750 17TH STREET NW
SUITE 900
WASHINGTON DC 20817

(FOR THIRD PARTY REQUESTER)

In re McLarty et al.
Reexamination Proceeding
Control No. : 95/001,409
Filed: August 13, 2010
Patent No. 7,680,256

: DECISION
: DISMISSING
: PETITION
: UNDER 37 CFR 1.181
:

The above reexamination proceeding is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit Director of the Central Reexamination Unit, after receipt of a April 14, 2011 third party requester's petition, entitled "Petition under 37 C.F.R. § 1.181 to Withdraw Action Closing Prosecution." The petition is requesting that certain newly proposed rejections the requester's comments of January 21, 2011 be considered by the examiner, or alternatively, that requester be permitted to file replacement comments.

The third party requester's petition is dismissed for the reasons set forth below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. On March 16, 2010, the Office issued U.S. Patent No. 7,680,256 (the '256 patent) to McLarty et al.
2. The '256 patent is subject to litigation in the United States District Court for the Southern District of Indiana, in One Number Corporation v. Google Inc., Civil Action No. 1:10CV-00312-RLY-TAB. The initial complaint was filed March 16, 2010. The court proceeding is stayed pending results of reexamination. See page 4 in the "Tab 1" exhibit attached to the January 17, 2012 appellant brief.
3. On August 13, 2010, a corrected request for inter partes reexamination of all the claims (claims 1-13) of the '256 patent was filed by third party requester (requester) Google, Inc. The request was assigned Control No. 95/001,409 (the '409 proceeding).
4. On October 22, 2010, the Office issued an order granting the '409 request for inter partes reexamination. The order stated that all the claims of the '256 patent, claims 1-13, would be subject to reexamination. On the same day, the Office issued a non-final Office action in the '409 proceeding.
5. On December 22, 2010, patent owner timely filed a response to the non-final Office action. The response included proposed amendments to patent claims 1, 3, 4, and 13 and added proposed new claims 14-43.
6. On January 5, 2011, the patent owner filed an information disclosure statement that included the several "Tekelec" documents (hereinafter "Tekelec references") and "airBand Configuration of Find-Me Feature" 2005 (hereinafter "airBand").
7. On January 21, 2011, third party requester submitted comments. The comments included numerous new proposed rejections. See pages 24-50 of the comments.
8. On March 11, 2011, the Office issued an Action Closing Prosecution (ACP) in the '409 proceeding confirming claim 12, indicating claims 29-41 and 43 as patentable, and rejecting claims 1-11, 13-28, and 42. The ACP considered most of the newly proposed rejections raised by the January 21, 2011. The ACP stated that certain newly proposed rejections based on Tekelec references and airBand were deemed improper and not considered because the amendment did not necessitate the new grounds of rejection. See, e.g., page 119 of the ACP. The ACP also acknowledged that the information disclosure statements of January 5, 2011 were considered.
9. On April 11, 2011, the patent owner filed a response to the ACP. The response included further amendments to claims 1, 13, 21, 24, 28, 29, 36, and 41 and cancelled claims 5-9 and 11.
10. On April 14, 2011, third party requester filed the instant petition under 37 CFR 1.181 requesting consideration of newly proposed rejections based on Tekelec references and airBand in the January 21, 2011 requester comments.

11. On May 11, 2011, requester filed comments on the ACP and the April 11, 2011 patent owner's response.

12. On October 3, 2011, the Office issued a Right of Appeal Notice (RAN) in the '409 proceeding, which entered the April 11, 2011 amendment and considered both the patent owner's and requester's comments. The RAN confirmed claims 10 and 12, indicated claims 5-9 and 11 as cancelled, indicated claims 1-4, 13-19, and 21-43 as patentable, and rejected claim 20. The RAN also considered the newly raised proposed rejections of the January 21, 2011 comments that were not considered in the ACP. See, e.g., paragraphs 39-45 on pages 105-111, of the RAN. See especially pages 108-109 pertaining to Issue 35 and the limitations of patent claim 5.

13. On November 2, 2011, the requester filed a notice of appeal.

14. On January 17, 2012, the requester filed an appellant's brief. The brief contains arguments of the nonadoption of the proposed rejection of claim 43-45 based on Tekelec and/or airBand, including the proposed rejection labeled Issue 44. See pages 19-22 of the brief.

15. On January 27, 2012, the Office issued a notice that found the January 17, 2012 appellant brief noncompliant with 37 CFR 41.67 due to an incomplete summary of the claimed subject matter and gave the requester one month to submit a replacement brief.

DECISION

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

...

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35 U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

As pointed out, the third party requester filed an April 14, 2011 petition, which is a petition requesting consideration of newly proposed rejections for claims 5-12 and 43 based on Tekelec references and/or airBand in the January 21, 2011 replacement comments or alternatively, a time period of 15 days to file rectified comments. See pages 4-6 of the April 14, 2011 petition. Specifically, the petitioner requests consideration of the new proposed rejections, labeled Issues 35-40 and 44, discussed on pages 118-123 and 125-126 of the ACP. See page 3 of the petition.

Claims 5-9 and 11:

The relief requested in the April 14, 2011 petition as to claims 5-9 and 11 is rendered moot due to the cancellation of these claims from the reexamination proceeding. Specifically, patent owner's amendment of April 11, 2011 resulted in the cancellation of claims 5-9 and 11, which will be effective when the reexamination certificate issues. For this reason, the relief requested in the April 14, 2011 petition as to claims 5-9 and 11 is rendered moot, and is hereby dismissed.

Claim 10, 12, and 43:

Upon review of the record, the Director finds there are not good and sufficient reasons to significantly delay prosecution by withdrawing the ACP so for the reasons set forth below. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage Office personnel to look at the facts involved in a particular proceeding and to weigh the equities before petition decisions and notices. Second, prosecution has advanced in this proceeding to the point where the patentability determination of claims 10, 12, and 43 is on appeal. During the appeal, the requester has full rights to appeal the finding of patentability of claims 10, 12, and 43 based upon any and all of the proposed rejections for these claims as properly presented in the request for reexamination and/or in the January 21, 2011 comments. Because of the RAN, as further discussed below, the requester has rights to present arguments against the patentability of claim 10, 12, and 43. Third, although the ACP stated that certain newly proposed rejections based on the Tekelec references and/or airBand were deemed improper and not considered, the RAN did consider these newly proposed rejections. Specifically, the RAN addressed the merits of these proposed rejections in Issues 35-40 on pages 105-111 and in Issue 44 on page 113. For example, page 109 of the RAN states that Tekelec fails to teach the "temporarily deactivate" limitation of patent claim 5. This limitation is present patent claims 10 and 12 and proposed new claim 43 based on their dependency on patent claim 5. See pages 110-111 and 113 of the RAN. Therefore, upon review of the record, the RAN did give consideration of the newly raised proposed rejections based on Telekec references and

airBand in regard to claims 10, 12, and 43. Accordingly, the ACP's finding that certain proposed rejections of the January 21, 2011 comments were improper and not considered was effectively withdrawn by the examiner in the RAN. In summary, the requested relief of consideration of the certain proposed rejections was given in the RAN. Thus, the requester's April 14, 2011 petition is moot, and hereby, dismissed.

Moreover, the record in this reexamination proceeding is long and complex with numerous petitions and petition decisions of record. As discussed above, prosecution in this proceeding has advanced to the point of appeal. It would clearly be against the statutory mandate of special dispatch to withdraw the ACP and remove the proceeding from appeal. As discussed above, the RAN effectively withdrew the finding that certain proposed rejections were not considered by addressing the merits of these proposed rejections by giving reasons for nonadoption. The record shows that issues have been developed and are ready for appeal. In addition, the record shows that litigation is stayed pending the results of reexamination. See Tab 1 of the January 17, 2012 brief. Given the facts of this proceeding and the fact that the statutory mandate of special dispatch must not be ignored, it is not justifiable to further delaying prosecution by withdrawing the ACP.

The record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP and a RAN, and did not categorically deprive the petitioner of its statutory rights to present comments and proposed rejections in reexamination proceedings. Therefore, for all these reasons, the ACP will not be withdrawn and the April 14, 2011 petition is, hereby, dismissed.

CONCLUSION

1. The April 14, 2011 third party requester's petition is dismissed.
2. Telephone inquiries related to this decision should be directed Sudhanshu Pathak, Supervisory Patent Examiner, at (571) 272-5509.



Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,410	07/27/2010	6543911		7248

64828 7590 05/25/2011

Harold McGurk
The Law Office of Clay McGurk
P.O. BOX 1488
Orange, CA 92856

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 05/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

KENYON & KENYON LLP

ONE BROADWAY

NEW YORK, NY 10004

Date:

MAILED

MAY 25 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001410

PATENT NO. : 6543911

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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P.O. BOX 6127
LAGUNA NIGUEL, CA 92677

(For Patent Owner)

KENYON & KENYON LLP
One Broadway
New York, New York, 10004

(For Third Party Requester)

MAILED

MAY 25 2011

CENTRAL REEXAMINATION UNIT

In re: Rizkin et alia
Reexamination Proceeding
Control No. 95/001,410
Filed: July 27, 2010
For: U.S. Patent No. 6,543,911

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the April 8, 2011 third party requester petition entitled "PETITION UNDER 37 C.F.R. §1.183," requesting (1) waiver of the provision of 37 CFR 1.951(b) limiting requester to "once" filing comments after an Action Closing Prosecution and (2) entry into the record of its replacement comments.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, the petition under 37 CFR 1.183 is **dismissed**.

DECISION

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In the present petition under 37 CFR 1.183, third party requester requests (1) waiver of the provision of 37 CFR 1.951(b) limiting requester to "once" filing comments after an Action Closing Prosecution and (2) entry into the record of its replacement comments. Third party requester asserts that the replacement comments attached as Exhibit B to the present petition consist of only the material from its expunged March 14, 2011 Comments that the Office found to be proper in the April 1, 2011 Office decision addressing the March 25, 2011 third party requester petition under 37 CFR 1.181.

Third party requester has concurrently filed a renewed petition under 37 CFR 1.181 on April 8, 2011 requesting reconsideration of the April 1, 2011 Office decision and entry of its expunged March 14, 2011 Comments.

Since the concurrently filed April 8, 2011 renewed petition under 37 CFR 1.181 to request entry of the third party requester's expunged March 14, 2011 comments has not yet been decided, the instant petition under 37 CFR 1.183 is premature – if the § 1.181 petition should be granted, then there would be no need for a waiver under 37 CFR 1.183. Since the present petition under 37 CFR 1.183 is premature, it is dismissed as such. Stated another way, the relief requested in the petition under 37 CFR 1.183 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the March 14, 2011 comments submissions is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.183 would be premature. Third party requester retains the option of seasonably filing a renewed petition under 37 CFR 1.183, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further challenge under 37 CFR 1.181 is filed by the requester seeking entry of its March 14, 2011 comments submission, requester may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is **dismissed** as premature.

CONCLUSION

1. The third party requester petition under 37 CFR 1.183 filed on April 8, 2011 is **dismissed** as being premature.
2. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5-24-2011
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,410	07/27/2010	6543911		7248
64828	7590	07/08/2011	EXAMINER	
Harold McGurk The Law Office of Clay McGurk P.O. BOX 1488 Orange, CA 92856			ART UNIT	PAPER NUMBER

DATE MAILED: 07/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date: **MAILED**

JUL 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001410
PATENT NO. : 6543911
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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LAW OFFICE OF CLAY MCGURK
P.O. BOX 6127
LAGUNA NIGUEL CA 92677

(For Patent Owner)

MAILED

JUL 08 2011

CENTRAL REEXAMINATION UNIT

KENYON & KENYON LLP
One Broadway
New York, New York, 10004

(For Requester)

In re: Rizkin et alia
Reexamination Proceeding
Control No. 95/001,410
Request Deposited: July 27, 2010
For: U.S. Patent No. 6,543,911

:
: **DECISION DISMISSING**
: **PETITION UNDER**
: **37 CFR 1.181**
:

This decision addresses the April 8, 2011 third-party requester paper entitled "REQUEST FOR RECONSIDERATION AND RENEWED PETITION UNDER 37 C.F.R. §1.181".

The petition is **dismissed** for the reasons set forth below.

A review of the record indicates:

1. In the order granting reexamination mailed on September 23, 2010, the examiner granted the request to reexamine claim 6 (the only claim requested for reexamination) over the Mueller, Nichols, and Brown references only and denied the request to reexamine over the other references.
2. The examiner rejected claim 6 as being anticipated by Mueller, Nichols, and Brown in the non-final office action mailed on September 23, 2010.
3. Patent Owner (PO) argued for the patentability of claim 6 over Mueller, Nichols, and Brown and presented new claims 8-10 in the response of November 23, 2010.

Art Unit: 3992

4. On December 23, 2010, Third-Party Requester (3PR) timely commented on the PO response of November 23, 2010.
5. On January 13, 2011, the examiner issued an Action Closing Prosecution (ACP) taking into consideration the PO response and the 3PR comments. The ACP found the PO arguments persuasive as to claim 6 after taking into consideration the 3PR comments, and withdrew the three anticipation rejections over the Mueller, Nichols, and Brown references. The examiner found that new claim 8-10 were broader than original claims and rejected claims 8-10 under 35 USC 314.
6. PO timely responded to the ACP on February 11, 2011 and cancelled new claims 8-10.
7. On March 14, 2011, 3PR timely filed comments.
8. The 3PR comments were expunged in a decision mailed March 16, 2011.
9. On March 25, 2011, 3PR filed a petition to review the expungement. As part of the 224-page filing, the entirety of the March 14, 2011 comments was resubmitted.
10. For the same reasons the March 14, 2011 comments were expunged, the 224-page petition of March 25, 2011 was expunged in the decision mailed April 1, 2011.
11. On April 8, 2011, 3PR filed the present petition.

Petitioner argues that "the entire discussion in VWGoA's March Comments submission was limited to issues raised in the ACP, and...should be entered and considered."

At issue is a proposed anticipation rejection of claim 6 by Simon presented in 3PR's comments after PO's response to the ACP when PO did not amend claim 6.

MPEP 2672(IV) states, in part:

Where the patent owner files comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), the third party requester may once file comments (pursuant to 37 CFR 1.951(b)) responding to the patent owner's comments and/or proposed amendment, and/or the issues raised in the ACP. See 35 U.S.C. 314(b)(2)...If the third party requester's comments go beyond the scope of responding to the patent owner's comments, and/or proposed amendments, and/or the issues raised in the ACP, then the third party requester's comments will be returned as improper; if the comments have been scanned into the Image File Wrapper (IFW) for the reexamination proceeding prior to the discovery of the impropriety, they should be expunged from the record, with notification being sent to the party that submitted the comments. No additional opportunity will be given for the third

Art Unit: 3992

party requester to correct the defect unless a petition under 37 CFR 1.183 is granted to waive 37 CFR 1.951 as to its one opportunity limitation. Any replacement third party requester comments under 37 CFR 1.951 (that are submitted in the rare instance where a petition is granted must be strictly limited to (i.e., must not go beyond) the content of the original comments submission.

The ACP mentions Simon on pages 5 and 7 as follows:

Here, reexamination of claim 6 was granted as to the SNQs over **Muller, Nichols, and Brown**. As such, no right of review exists as to **Simon, Harris, and Naka** because claim 6 will be reexamined in view of all the prior art during reexamination under 37 CFR 1.937.

However, the order granting the request to reexamine claim 6, mailed Sept. 23, 2010, determined that the references of proposed SNQs (A)-(B) and (F)-(G) did not raise a SNQ for the reasons set forth in the determination mailed Sept. 23, 2010. As such, the *inter partes* reexamination was not granted to resolve any questions of patentability with respect to these other references, i.e. **Simon, Harris, Naka, and Muth**.

PO's response to the ACP does not mention Simon.

Petitioner argues that various other papers from earlier in prosecution mention Simon. However, this is not germane to the issue of whether 3PR may present a new rejection of claim 6 based on Simon in their comments after PO response to the ACP.

The closest issue in petitioner's arguments is the examiner reiterating in the ACP that no SNQ was raised as to the Simon reference. However, the examiner reiterating the status of various references that did not raise an SNQ can not be considered an issue raised by the examiner in the ACP mailed January 13, 2011 because this was a decision made in the order granting reexamination mailed September 23, 2010

Since proposing a new anticipation rejection based on the Simon reference is not responsive to an issue raised in the ACP, the comments went beyond what is permitted. Therefore, the decisions to expunge the comments of March 14, 2011 and the petition of March 25, 2011 were proper. Accordingly, the present petition is dismissed.

Petitioner seeks alternate relief under 37 CFR 1.183 in the present petition.

Art Unit: 3992

37 CFR 1.4(c) states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The alternate relief is **dismissed** procedurally under 37 CFR 1.4(c). This decision does not address the merits of any requested alternate relief.

CONCLUSION

1. The 3PR petition listed above is **dismissed**. The comments of March 14, 2011 remain expunged. The petition of March 25, 2011, which included a copy of the March 14, 2011 comments remains expunged.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,410	07/27/2010	6543911		7248

64828 7590 08/03/2011

Harold McGurk
The Law Office of Clay McGurk
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Orange, CA 92856

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 08/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

MAILED

AUG 03 2011

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

CENTRAL REEXAMINATION UNIT

REEXAMINATION CONTROL NO. : 95001410

PATENT NO. : 6543911

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAILED
AUG 03 2011
(For Patent Owner)
CENTRAL REEXAMINATION UNIT

Kenyon & Kenyon LLP
One Broadway
New York, New York, 10004

(For Third Party Requester)

In re Rizkin et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,410
Filed: July 27, 2010
For: U.S. Patent No. 6,543,911

:
: **DECISION**
: **DISMISSING PETITIONS**
: **UNDER § 1.183**
:

This is a decision on the July 5, 2011 and July 12, 2011 third party requester petitions entitled "Renewed Petition Under 37 C.F.R. § 1.183 to Extend the Deadline for VWGoA to File an Appeal Brief" and "Second Renewed Petition Under 37 C.F.R. § 1.183 to Extend the Deadline for VWGoA to File an Appeal Brief."

This decision further addresses the July 12, 2011 petition entitled "Renewed Petition Under 37 C.F.R. § 1.183," seeking to enter third party requester comments and an evidence submission.

The third party requester petitions are before the Office of Patent Legal Administration.

The petitions under 37 C.F.R. § 1.183 to request rule waiver and an extension of time are **dismissed**.

The petition under 37 C.F.R. § 1.183 to enter third party requester comments and an evidence submission is **dismissed**.

BACKGROUND

- On July 27, 2010, a request for *inter partes* reexamination of claim 6 of U.S. Patent 6,543,911 was filed by a third party requester. This proceeding was accorded control number 95/000,446 ("the '446 proceeding"). Reexamination was ordered on September 23, 2010, and a non-final Office action was issued on the same date.

- Prosecution progressed until, on March 16, 2011, a Right of Appeal Notice was issued by the Office, in which unamended patent claim 6 was confirmed as patentable.
- On April 8, 2011, third party requester filed petitions under §§ 1.181 and 1.183.
- On April 18, 2011, third party requester filed a Notice of appeal and a petition entitled “PETITION UNDER 37 CFR § 1.183,” requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until two months after decision on an April 8, 2011 petition under § 1.183.
- On May 25, 2011, the Office issued a decision dismissing requester’s April 8, 2011 petition under § 1.183.
- On June 5, 2011, the Office granted the third party requester’s April 18, 2011 petition under § 1.183 to extend the period for filing an appeal brief until July 18, 2011.
- On July 5, 2011, third party requester filed a petition under 37 C.F.R. § 1.183, requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until two months after a decision was issued on the April 8, 2011 petition under § 1.181.
- On July 8, 2011, the Office issued a decision dismissing requester’s April 8, 2011 petition under § 1.181.
- On July 12, 2011, third party requester filed the following papers:
 - A petition under 37 C.F.R. § 1.183 requesting entry of replacement comments and an evidence submission *nunc pro tunc*.
 - A petition under 37 C.F.R. § 1.183 requesting a waiver of the prohibition on requesting an extension of time to file an appeal brief until August 17, 2011.
- On July 18, 2011, third party requester filed an appellant’s brief.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314(b) states:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner’s response thereto, if those written comments are

received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

37 C.F.R. § 1.951(b) states:

When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

37 C.F.R. § 1.953(c) states, in pertinent part:

The Right of Appeal Notice shall set a one-month time period for either party to appeal.

37 C.F.R. § 41.63(c) states:

Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

37 C.F.R. § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.61(b) states:

- (1) Within fourteen days of service of a requester's notice of appeal under paragraph (a)(2) of this section and upon payment of the fee set forth in § 41.20(b)(1), an owner who has not filed a notice of appeal may file a notice of cross appeal with respect to the final rejection of any claim of the patent.
- (2) Within fourteen days of service of an owner's notice of appeal under paragraph (a)(1) of this section and upon payment of the fee set forth in § 41.20(b)(1), a requester who has not filed a notice of appeal may file a notice of cross appeal with respect to any final decision favorable to the patentability, including any final determination not to make a proposed rejection, of any original, proposed amended, or new claim of the patent.

37 CFR § 41.66 states, in pertinent part:

- (a) An appellant's brief must be filed no later than two months from the latest filing date of the last-filed notice of appeal or cross appeal or, if any party to the proceeding is entitled to file an appeal or cross appeal but fails to timely do so, no later than two months from the expiration of the time for filing (by the last party entitled to do so) such notice of appeal or cross appeal. The time for filing an appellant's brief or an amended appellant's brief may not be extended.

DECISION

A. Petition for Entry of Comments and Evidence Submission

Patent owner's July 12, 2011 petition requests entry of comments and evidence, including the declaration of Dr. Bruce Buckman discussed in these comments, submitted therewith. The petition desires entry of the requester's comments as a replacement to the comments filed on March 14, 2011, which were denied entry and expunged in an Office decision issued on March 16, 2011.

At the time the petition was submitted, third party requester had filed a notice of appeal. Entry of the evidence submitted with the comments was barred by 37 C.F.R. § 41.63(c). Patent owner seeks to waive that prohibition through the July 12, 2011 petition. Such waiver requires a finding of extraordinary circumstances in the proceeding such that justice requires such relief.

Petitioner premises the case for extraordinary relief on the following: (1) the comments consist of only the portions of the March 14, 2011 submission that the Office has confirmed as proper, (2) the March 14, 2011 comments were filed timely in good faith, (3) failure to grant the petition would cause injustice by leaving the record of the proceedings incomplete, and (4) no undue hardship or prejudice would accrue to the patent owner.

Petitioner casts the instant petition as the fourth in a line of requests for relief by third party requester to enter comments responsive to the January 13, 2011 ACP and the February 11, 2011

patent owner's response. Thus, petitioner is seeking entry of comments including an evidence submission following petitioner's appeal in the proceeding, rather than seeking review of prior Office decisions.¹ The petition must therefore set forth extraordinary circumstances such the proceeding be withdrawn from appeal, reset to a pre-RAN stage, and have entered the comments and evidence submission.

Petitioner's first contention, that the proposed comments submission consists of only "proper" comments and submission, is duly noted. However, the fact that there is nothing improper about the comments and submission is not support for the existence of an extraordinary circumstance such that justice demands their entry. A submission barred by the rules may be otherwise unobjectionable, yet fail to be supported by extraordinary circumstances such that the reexamination proceeding should be regressed to an earlier stage for its consideration.

As the petition is being considered on its own merits, petitioner's second premise, that the March 14, 2011 comments were filed in good faith, is of lesser relevance to the determination.

Petitioner's next contention is that failure to enter the comments and evidence submission would "leave the record of the proceedings incomplete," by failing to enter the desired evidence submissions to provide objective evidence addressing reasoning taken by the examiner in the ACP. If the evidence submissions for which entry is desired in the instant petition were the only evidence available to rebut the examiner's position taken in the ACP, such would weigh towards grant of the instant petition. However, the requester has other sources already made of record in the proceeding which can be, and have been, used to rebut the examiner's position. The appellant's brief filed on July 18, 2011 relies upon the Brown reference to support the issue for which the July 12, 2011 evidence submissions were sought to provide support. Failure to have entered the desired evidence submissions would remove some, but not all, documents supporting the third party requester's arguments against the patentability of the claim under appeal. Thus, while the record may not include all possible evidentiary submissions, the record includes at least one document from which the requester can rely, and has relied in the appellant's brief filed on July 18, 2011, to support his contentions.

Petitioner's final contention is that granting the petition would not impose any undue hardship or prejudice on the patent owner. It is not a persuasive argument to state that the actual delay is harmless. As stated in *Myers v. Feigelman*, 455 F.2d 586, 601, "the rules are designed to provide an orderly procedure and the parties are entitled to rely on their being followed in the absence of such circumstances as might justify waiving them under Rule 183. To hold that they may be ignored, in the absence of such circumstances, merely because no special damage has been shown would defeat the purpose of the rules."²

¹ Prior petitions under § 1.181 address the correctness in the examiner's action of refusing entry of the original comments. The instant petition under § 1.183 does not address prior action by the examiner, as illustrated by the fact the comments submitted with the instant § 1.183 petition are not the same as those submitted originally; and explicitly omit the material of the earlier-filed comments that was held to be improper.

² *Myers v. Feigelman*, 455 F.2d 586, 601, 172 USPQ 580, 584 (CCPA 1972). *Accord B and E Sales Co. v. Andrew Jergens Co.*, 7 U.S.P.Q.2d at 1908 (stating "the mistake was the result of counsel's failure to review the rule. Similarly rejected is petitioner's argument that the lack of substantive injury or harm to respondent is a basis for granting an extension of time. As indicated in *In re Sivertz*, *supra*, 227 USPQ at 256, lack of injury to another party or to the public is not recognized as a sufficient basis for waiving provisions of the rules. "To do otherwise would defeat the purpose of the rule." *Id.*")

Additionally, as the proceeding has taken over four months to proceed from the prior March 14, 2011 requester comments to the current stage at which requester has submitted an appellant's brief, at least a similar delay would be expected should the instant petition be granted. The requester, in the instant petition, predicts a delay of "several months."³

In weighing the impact of the omission of the requested submissions on the proceeding, it must be recognized that § 41.63(c) acts to refuse admission of any evidentiary submission by either party following an appeal in the proceeding. Presumably, many submissions may, like petitioner's requested submission, lend additional support to a line of reasoning to be brought before the Board of Appeals. However, it is clear that the mere usefulness or relevance of a post-appeal submission cannot support its entry, else § 41.63(c) would be negated. Section 1.183 permits waiver of § 41.63(c) only in the presence of extraordinary circumstances such that justice requires such waiver.

Having weighed all of the facts and circumstances pertinent to the petition, third party requester has failed to establish the existence of an extraordinary circumstance such that justice requires entry of the comments and evidence submission filed with the petition. For that reason, relief may not be provided under § 1.183, and third party requester's July 12, 2011 petition under § 1.183 is **dismissed**.

B. Petitions for Extension of Time

The present third party requester petitions for rule waiver to permit an extension of time to file an appellant's brief were filed on July 5, 2011, and July 12, 2011, subsequent to the filing of a Notice of Appeal. Under 37 C.F.R. § 41.66(a), the time for filing an appellant's brief may not be extended; therefore, an extension of time may not be granted absent an Office decision waiving § 41.66(a). Rule waiver requires a finding of extraordinary circumstances in the proceeding such that justice requires such relief.

The submission of patent owner's appellant's brief on July 18, 2011 renders the petitions for extension of time to file said brief moot. However, even if the question had not been rendered moot through the filing of the brief, the petitions would not have been granted for the following reasons.

In this instance, third party requester filed petitions for extension of time (1) to obtain a decision on the petition under § 1.181 and (2) for a 30 day period, presumably in connection with the petition filed under § 1.183 for waiver to permit entry of comments and an evidence submission.

With respect to the first petition for extension of time filed on July 5, 2011, a decision was rendered on the petition under § 1.181 on July 8, 2011. Since the decision was rendered prior to the due date for the filing of the appellant's brief, there would have existed no extraordinary circumstances such that justice would have required an extension of time to file the brief.

With respect to the second petition for extension of time filed on July 12, 2011, this petition was grounded upon the rationale that such extension would prevent unnecessary expenditure of

³ Petition at 25.

resources and uncertainty as to what materials would be properly citable in the preparation of a brief that would be subject to revision should requester's petition requesting entry of comments and an evidence submission be granted. The sufficiency of the risk of "unnecessary expenditure of resources" to give rise to an "extraordinary situation" is weighed in these situations against the facts and circumstances specific to this proceeding.

It is first recognized that the general relief sought, which is that of submission of proper third party comments to the January 13, 2011 ACP and the February 11, 2011 patent owner's response. The initial submission by third party requester on March 14 was expunged from the record as being in conflict with Office regulations and procedure.⁴ A requester petition filed on May 25, 2011 seeking entry of those comments was expunged by the Office in a decision issued on April 1, 2011. Requester's petition for reconsideration of that petition filed on April 8, 2011 was dismissed by the Office on July 8, 2011. The aforementioned petition under § 1.183 seeking entry of comments and an evidence submission thus represents requester's fourth attempt at submitting comments to the ACP/patent owner's response. This is weighed against the statutory and regulatory admonition that requester be given only a single opportunity to submit comments;⁵ indeed, the § 1.183 petition requesting entry of comments and an evidence submission stands dismissed in the instant decision as detailed above.

It is also recognized that the July 12, 2011 petition for extension of time was the third request for extraordinary relief to extend the proceeding for third party requester to seek relief via petition. One previous such request had been granted in an Office decision issued on June 5, 2011, extending the proceeding for 1 month. Furthermore, the July 12, 2011 petition was filed less than a week prior to the due date for the appellant's brief.

Based upon the totality of the facts and circumstance in the proceeding, there would have existed no extraordinary circumstances such that justice would have required an extension of time to file the brief. In view of this, and the July 18, 2011 filing of the appellant's brief, the July 5, 2011 and July 12, 2011 requester petitions to extend the time for filing an appellant's brief are dismissed.

CONCLUSION

1. The July 5, 2011 and July 12, 2011 petitions under 37 C.F.R. § 1.183 to request rule waiver and an extension of time are dismissed.
2. The petition under 37 C.F.R. § 1.183 to enter third party requester comments and an evidence submission is dismissed.

⁴ Decision Expunging/Returning Papers in Reexamination, issued on March 16, 2011.

⁵ 35 U.S.C. § 314(b); 37 C.F.R. § 1.947; and 37 C.F.R. § 1.951(b).

3. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

August 3, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,411	08/25/2010	7,644,122	FABO-005/00US	5232
66385	7590	07/15/2011	EXAMINER	
TECHCOASTLAW 2032 Whitley Ave HOLLYWOOD, CA 90058			ART UNIT	PAPER NUMBER

DATE MAILED: 07/15/2011

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3175 HANOVER STREET
PALO ALTO, CA 94304

Date: **MAILED**
JUL 15 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001411
PATENT NO. : 7644122
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

JUL 15 2011

Heidi Keefe
Cooley LLP
3175 Hanover Street
Palo Alto, CA 94304

(For *Inter Partes* Requester) **ESTABLISHED REEXAMINATION UNIT**

Inter Partes Reexamination Proceeding
Control No. 95/001,411
Filed: August 25, 2010
For: U.S. Patent No. 7,644,122

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the patent owner paper entitled "PETITION TO WAIVE THE RULES PURSUANT TO 37 CFR 1.183," filed on May 12, 2011.

The patent owner petition is before the Office of Patent Legal Administration for consideration.

The patent owner petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

BACKGROUND

1. On January 5, 2010, United States Patent No. 7,644,122 ("the '122 patent") issued to Weyer et al.
2. On July 30, 2010, a request for *inter partes* reexamination of the '122 patent was deposited by a third party requester, which request was assigned Reexamination Control No. 95/001,411 ("the '1411 proceeding").
3. On August 25, 2010, a corrected request for *inter partes* reexamination was filed by the third party requester in the '1411 proceeding, and the '1411 proceeding was assigned a filing date of August 25, 2010.
4. On October 6, 2010, the Office mailed an order granting *inter partes* reexamination in the '1411 proceeding, concurrently with a non-final Office action.

5. The '1411 proceeding progressed to the point when, on April 15, 2011, the Office issued an Action Closing Prosecution (ACP).
6. On May 8, 2011, the patent owner filed "PATENT OWNER'S COMMENTS ON ISSUES RAISED IN ACTION CLOSING PROSECUTION PURSUANT TO 37 CFR 1.951(a)" ("the May 8, 2011 submission under 37 CFR 1.951(a)").
7. On May 10, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" ("the notice of defective paper").
8. On May 12, 2011, the patent owner filed the instant petition entitled "PETITION TO WAIVE THE RULES PURSUANT TO 37 CFR 1.183" ("the petition under 37 CFR 1.183").
9. On May 16, 2011, the patent owner filed "PATENT OWNER'S [ABRIDGED] COMMENTS ON ISSUES RAISED IN ACTION CLOSING PROSECUTION PURSUANT TO 37 CFR 1.951(a)."
10. On June 15, 2011, the third party requestor filed "THIRD PARTY REQUESTER'S COMMENTS IN RESPONSE TO THE ACTION CLOSING PROSECUTION AND PATENT OWNER'S RESPONSE TO ACTION CLOSING PROSECUTION IN *INTER PARTES* REEXAMINATION."

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

37 CFR 1.951 provides:

(a) After an Office action closing prosecution in an inter partes reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. The comments can include a proposed amendment to the claims, which amendment will be subject to the criteria of § 1.116 as to

whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

(b) When the patent owner does file comments, a third party requester may once file comments responsive to the patent owner's comments within 30 days from the date of service of patent owner's comments on the third party requester.

II. Patent Owner Petition Under 37 CFR 1.183

On May 12, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its May 8, 2011 submission under CFR 1.951(a), which petitioner asserts "is 162 pages in length."¹ In support of waiver of 37 CFR 1.943(b), patent owner asserts that "[t]he ACP was 59 pages long, 52 pages longer than the first Office Action," that "[i]n the ACP the Examiner, for the first time, included over two hundred thirty (230) 'Findings of Fact' to support the Examiner's rejections," and that "[i]n addition, the Examiner withdrew numerous rejections, modified others, and issued new rejections of new claims 16-26."²

Patent owner also asserts that "[b]ecause of the length of the ACP and the large number of issues raised by the Examiner in the ACP, the Patent Owner presented each of the issues raised by the Examiner, followed directly by the Patent Owner's with respect to that particular issue."³ Further, petitioner asserts that "[a]lthough the resulting document is 162 pages in length, the Patent Owner believes that the length is not excessive under the circumstances, and in fact clearly lays out the issues in a clear, logical fashion," and that "although the length could be reduced by removing the quotations from the ACP (which represent about 1/3 of the total length), the Patent Owner believes that the resulting document would be harder to understand and would create more work for the Examiner if citations to the ACP were included instead of the quotations themselves."⁴

The instant petition under 37 CFR 1.183 has been fully considered. 37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

¹ Petition under 37 CFR 1.183 at page 2.

² *Id.*

³ *Id.*

⁴ *Id.*

In this instance, evaluation of the May 8, 2011 submission under 37 CFR 1.951(a) indicates that patent owner extensively repeats information that is already of record in the '1411 proceeding by wholesale insertion of entire portions of the April 15, 2011 ACP directly into the text of the submission under 37 CFR 1.951(a) itself. While, in some circumstances, judicious repetition of information that is already of record may be deemed necessary to lend clarity to a response, in this instance, the repetition of material that is already of record is not only extensive, but also includes extraneous material. For example, the May 8, 2011 submission under 37 CFR 1.951(a) includes block copies of the examiner's summary of the proceeding to date, repeats the statutory bases for the rejections, repeats entire pages of the ACP presenting rejections being *withdrawn*, etc. Thus, patent owner has not made a showing in support of its request for waiver of the 50-page limit of 37 CFR 1.943(b) that it attempted to draft a patent owner's response in compliance with the 50-page limit. Rather, the May 8, 2011 submission under 37 CFR 1.951(a) shows that patent owner made little attempt to economize its remarks by judiciously limiting its repetition of information that is already of record in the '1411 proceeding.

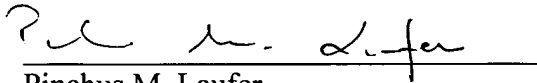
In view of the above, the facts and circumstances in this particular instance do not give rise to an extraordinary situation in which justice requires waiver of the page limit of 37 CFR 1.943(b) to permit patent owner's May 8, 2011 submission under 37 CFR 1.951(a) to exceed the regulatory page limit by approximately 112 pages. Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

In view of the May 10, 2011 notice of defective paper, patent owner's May 8, 2011 submission under 37 CFR 1.951(a) was previously expunged from the record of the '1411 proceeding by marking it "closed" and "non-public" in the image file wrapper (IFW) of the '1411 proceeding. The copy of patent owner's May 8, 2011 submission under 37 CFR 1.951(a) submitted with the instant petition under 37 CFR 1.183 as "Exhibit B" will likewise be expunged from the record by marking it "closed" and "non-public" in IFW of the '1411 proceeding. In view of the timely patent owner May 16, 2011 submission under 37 CFR 1.951(a) and requester's timely June 15, 2011 comments pursuant to 37 CFR 1.951(b), the examiner in the '1411 proceeding will take the case up for action in due course. See MPEP 2673 (I).

CONCLUSION

1. Patent owner's May 12, 2011 petition under 37 CFR 1.183 is dismissed.
2. The copy of patent owner's May 8, 2011 submission under 37 CFR 1.951(a) submitted as "Exhibit B" to the May 12, 2011 petition under 37 CFR 1.183 will be expunged from the record by marking it "closed" and "non-public" in IFW of the '1411 proceeding.
3. In view of the timely patent owner May 16, 2011 submission under 37 CFR 1.951(a) and requester's timely June 15, 2011 comments pursuant to 37 CFR 1.951(b), the examiner in the '1411 proceeding will take the case up for action in due course.

4. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

A handwritten signature in cursive script, appearing to read "Pinchus M. Laufer", is written above a horizontal line.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

07-14-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,411	08/25/2010	7,644,122	FABO-005/00US	5232
66385	7590	10/03/2011	EXAMINER	
TECHCOASTLAW 2032 Whitley Ave HOLLYWOOD, CA 90058			ART UNIT	PAPER NUMBER

DATE MAILED: 10/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes
FACEBOOK, INC.

v.

Frank Michael Weyer

Inter Partes Reexamination Control No. 95/001,411

Patent 7,644,122

Technology Center 3900

DECISION ON PETITION

This is a decision on patent owner's "Petition to Waive the Rules Pursuant to 37 C.F.R. § 1.183," filed August 30, 2011 (present petition). In the petition, patent owner requests waiver of 37 C.F.R. §1.943(c), to permit patent owner to file an appellant brief no longer than 60 pages or 28,000 words. The petition fee of \$400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's credit card on August 31, 2011.

Inter Partes Reexamination Control No. 95/001,411
Patent No. 7,644,122

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief
Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,644,122, on August 25, 2010, which was assigned control no. 95/001,411.
2. On October 6, 2010, reexamination was ordered in the '1411 proceeding, and a non-final Office action was mailed, rejecting claims 1-15.
3. Patent owner filed a response to the non-final Office action on November 16, 2010, including an amendment adding claims 16-26; and requester filed comments on December 16, 2010, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
4. On April 15, 2011, an Action Closing Prosecution (ACP) was mailed, rejecting claims 1- 26.
5. Patent owner filed a response to the ACP on May 16, 2011, and requester filed comments on June 15, 2011, both within the 50 page limit pursuant to 37 C.F.R. § 1.943(b).
6. On August 19, 2011, a Right of Appeal Notice (RAN) was mailed, rejecting claims 1- 26.
7. Patent owner filed a Notice of Appeal on August 22, 2011, appealing the rejections of claims 1- 26.
8. Patent owner filed the present petition on August 30, 2011
9. Requester filed a Notice of Cross Appeal on September 6, 2011, appealing the examiner's refusal to adopt numerous proposed grounds of rejection concerning claims 1-26.

DISCUSSION

In the present petition, patent owner requests waiver of the limits of 37 C.F.R. § 1.943(c), which limits patent owner's appellant brief to thirty pages or 14,000 words in length. The patent owner is seeking permission to file an appellant brief no longer than 60 pages or 28,000 words.

Extension of the limits is requested for the following reasons stated by patent owner:

1. The reexamination request is over 400 pages long.
2. The ACP is 59 pages long, and for the first time set forth over 230 findings of fact to support the examiner's rejections of claims 1-26.
3. The effective length of the RAN is over 80 pages in length as a result of incorporating the requester's comments by reference.
4. The patent owner was barely able to address the examiner's findings of fact and rejections in the ACP in a 50 page response.
5. In the appellant's brief, patent owner will need to address not only the examiner's findings of fact and rejections in the ACP, but also the requester's comments, which the examiner expressly incorporated by reference, as well as comply with the requirements of 37 C.F.R. § 41.67.

RELEVANT AUTHORITY

37 CFR § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as

Inter Partes Reexamination Control No. 95/001,411
Patent No. 7,644,122

may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR § 1.943(c) provides:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) provides:

With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c). Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding

Inter Partes Reexamination Control No. 95/001,411
Patent No. 7,644,122

rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) provides:

For additional information with respect to the length of papers, see Subsection I.A.2 above.

ANALYSIS

Patent owner's petition has been considered fully. The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Upon review of the prosecution history of this proceeding, it is noted that the patent owner and third party requester responses and comments prior to appeal have been within the page limit requirements. However, the appellant is seeking to file an appellant brief that is significantly longer, whereas the rules require that the appellant brief be more limited than pre-appeal responses. Patent owner is requesting permission to file an appellant brief that is stated to be not more than 60 pages or 28,000 words, which is twice the limit of 30 pages or 14,000 words.

Petitioner's reasons provided in support of waiving the page/word limits focus on the lengths of the reexamination request, the Office actions and requester comments in the prosecution history. However, the record reveals that in response to the non-final Office action, patent owner chose to present an additional 11 claims in his amendment without canceling any of the original 15 patent claims. It is not surprising that patent owner is now challenged by the page and word limit, given that the number of claims being examined has increased from 15 to 26, and is now almost twice the

Inter Partes Reexamination Control No. 95/001,411
Patent No. 7,644,122

number of original patent claims. Hence, the challenge presented is of the patent owner's making.

Prior to appeal, the examiner included new rejections in the ACP, necessitated by patent owner's amendment adding claims 16-26. Patent owner responded to the rejections in the ACP within the 50 page limit. Petitioner indicates that the RAN repeats all of the rejections contained in the ACP, and incorporates requester's comments. Petitioner explains appellant's challenge in complying with the page/word limits, but is silent as to what, if anything, appellant has done to reduce the size of the appellant brief. The page and word limits are designed intentionally to focus the issues and require a concise presentation of arguments.

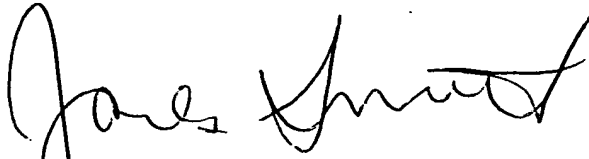
A persuasive showing has not been made that this situation is extraordinary nor that justice requires that more pages/words be allotted to appellant's brief than to pre-appeal responses.

The present petition is **denied**.

DECISION

In view of the foregoing, the present petition is DENIED.

The appellant briefs are due pursuant to 37 C.F.R. § 41.66(a).



James Donald Smith
Chief Administrative Patent Judge

Inter Partes Reexamination Control No. 95/001,411
Patent No. 7,644,122

Counsel for Patent Owner:

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Counsel for Third Party Requester

HEIDI KEEFE COOLEY LLP
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	04/11/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 04/11/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

APR 11 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

(For Patent Owner)

NOVAK, DRUE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the February 9, 2011 third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

The petition is before the Office of Patent Legal Administration for decision.

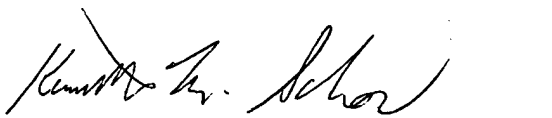
The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on February 9, 2011. On March 25, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's January 10, 2011 response submission is defective and setting a time period of 15 days for patent owner to file a corrected response submission. The notice of non-compliance also states that since a proper response from the patent owner has not been made, the third party requester will have the opportunity to file new comments within 30 days of service of a corrected patent owner response submission. Accordingly, requester's February 9, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently filed comments submission is moot, and requester's February 9, 2011 petition is **dismissed as moot**.

CONCLUSION

1. Third party requester's February 9, 2011 petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" is dismissed as moot.
2. Telephone inquiries with regard to this decision should be directed to Maria Nuzzolillo, at 571-272-8150 or Nicole Dretar Haines, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

04-11-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	05/06/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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HOUSTON, TX 77002

Date:

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MAY 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Robert Greene Sterne : (For Patent Owner)
STERNE, KESSLER, GOLDSTEIN :
& FOX P.L.L.C. :
1100 NEW YORK AVE., NW :
WASHINGTON, DC 20005 :

MAILED

MAY 06 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUISIANA STREET :
53RD FLOOR :
HOUSTON, TX 77002 :

In re: Puente et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,413 :
Deposited: August 4, 2010 :
For: U.S. Patent No.: 7,148,850 :

This is a decision on a petition filed by the patent owner on January 10, 2011 entitled "Petition Under 37 C.F.R. § 1.182 to Strike Cohen as a Substantial New Question of Patentability, and to Withdraw Claim Rejections Based on Cohen" [hereinafter "petition"] and is a request that a reference and the accompanying rejections based on the reference be withdrawn because no substantial new question of patentability has been raised.

The petition was filed as a 1.182 petition, but is being treated as a petition under 1.181.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. Also before the Assistant Deputy Commissioner for Patent Operations is an opposition to the petition, filed by the third party requester on February 9, 2011.

The petition is dismissed as untimely.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,148,850 issued on December 12, 2006.
- A request for *inter partes* reexamination was filed on August 4, 2010 and assigned control number 95/001,413.
- Reexamination was ordered and mailed together with a first action on the merits on October 8, 2010. The examiner found *inter alia* that a substantial new question of patentability was raised by a reference to Cohen.
- On November 9, 2010, patent owner requested a one-month extension of time to reply to the Office action. The extension was granted in a decision mailed November 17, 2010.
- On January 10, 2011, the patent owner filed the instant petition with a response to the first action.
- On February 9, 2011, the third party requester filed an opposition to the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions not specifically provided for

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP § 1002 Petitions to the Director of the USPTO (in part)

37 CFR 1.181(f) provides that any petition under that rule which is not filed “within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.” Often, the “action or notice from which relief is requested,” for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a 3-month period for reply. Under such circumstances, if applicant requests reconsideration, under 37 CFR 1.111(b), of the requirement for a new drawing, the examiner’s action on this request, if adverse, establishes the beginning of the 2-month period for filing the petition. The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period. The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided. A number of sections (e.g., 37 CFR 1.377, 37 CFR 1.378, 37 CFR 1.644, and 37 CFR 1.740) specify the time period within which a petition must be filed (or may be dismissed as untimely). The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed. The 2-month period is not extendable under 37 CFR 1.136(a) since the time is within the discretion of the Director of the USPTO.

DECISION

First, as a procedural matter, the petition was filed under 37 CFR § 1.182. That rule is the catch-all for questions not specifically provided for. The petition, however, is not appropriate under this rule as it is provided for elsewhere in the regulations. 37 CFR § 1.181(a)(1) provides for a petition from any action by the examiner which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. 37 CFR § 1.181(a)(3) permits a petition to invoke the Director's supervisory authority in "appropriate circumstances." The petition is questioning the examiner's determination under 35 U.S.C. § 312(a) that a substantial new question of patentability was raised, and 35 U.S.C. § 312(c) specifically states that such decision is final and non-appealable. This is therefore a petition from an action by the examiner that is not subject to appeal to the Board or the court, a situation provided for in 1.181(a)(1). Additionally, the petition is essentially arguing that the grant of the request based on Cohen is *ultra vires*, a situation that MPEP 2646 states falls within the "appropriate circumstances" of 1.181(a)(3). The question raised in the petition is provided for in the regulations and therefore is improper under 37 CFR § 1.182. It is treated as a petition under 37 CFR § 1.181.^{1,2}

The Order Granting the Reexamination Request was mailed on October 8, 2010 along with the first action on the merits. Patent owner therefore had a two-month time period to petition from that action of the examiner under 37 CFR § 1.181(f). The petition was not received until January 10, 2011, outside of the two-month time period. The petition is therefore dismissed as untimely in accordance with 37 CFR § 1.181(f).

While it is true that petitioner received an extension of time, this extension was, as titled in the November 9, 2010 petition, a "Petition for Extension of Time to File Response to First Office Action." The request was therefore only for an extension for filing the response to the Office action, not a request for extension of the time period requirement of 37 CFR § 1.181(f). In any case, § 1.181(f) itself states that the two-month time period therein is not extendable. Additionally, the MPEP explains that the time period of § 1.181(f) is independent of the time period to respond to an Office action. MPEP 1002 ("The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period."). Thus, any extension of time in this case was not applicable to the requirements of 37

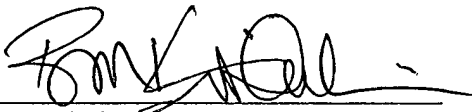
¹ The opposition states at p. 3 n. 1 that while a 1.181 petition is permitted in certain circumstances, the petition is not a 1.181 petition, and no 1.181 petition could be filed due to the facts of this case and the lateness of such a petition. As stated above, the facts do support the filing of a 1.181 petition, and nothing prevents the Office from treating it as such, given that it was timely filed and otherwise meets the requirements under 1.181.

² Note that this does not change the result discussed herein. As described in MPEP 1002, the time period requirement of 37 CFR § 1.181(f) also applies to petitions under § 1.182, therefore regardless of the treatment of the petition, it is subject to the 2-month period.

CFR § 1.181(f): The petition was not filed within the 2-month period set forth in 37 CFR § 1.181(f), therefore it is dismissed as untimely.

CONCLUSION

1. The petition is improper under 37 CFR § 1.182 as filed because the question is provided for elsewhere, but is considered as a petition under 37 CFR § 1.181 for vacating the Order as *ultra vires*. The petition is dismissed under 37 CFR § 1.181(f) as being untimely.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Bruce Kisliuk

Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	06/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET, FIFTY-THIRD FLOOR

HOUSTON, TX 77002

Date:

MAILED

JUN 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



MAILED

JUN 08 2011

CENTRAL REEXAMINATION UNIT

(For Patent Owner)

(For *Inter Partes* '593 Requester)

(For *Inter Partes* '1413 Requester)

(For *Inter Partes* '598 Requester)

• • • • •

**: DECISION, *SUA SPONTE*,
: MERGING
: *INTER PARTES*
: PROCEEDINGS**

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,148,850 B2 (the '850 patent) issued to Carles Puente Baliarda *et al.* on December 12, 2006.
2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/001,413 (the '1413 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. A first Office action on the merits was issued in this proceeding on the same date, rejecting all pending claims under reexamination. Patent owner filed a response on April 11, 2011;¹ the response did not include any proposed amendment to the claims. Third party requester filed comments on May 2, 2011.
3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,593 (the '593 *inter partes* proceeding), and a filing date of December 22, 2010, the date which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on February 3, 2011. No action on the merits has been issued in this proceeding.
4. On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent was filed by a third party requester; the request was assigned control number 95/000,598 (the '598 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 4, 2011. No action on the merits has been issued in this proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

¹ An earlier-filed patent owner response was refused entry, and additional time was given for a proper response.

As evidenced by the above review of facts, the '1413, '593, and '598 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, and 68-70 of the '850 patent have been mailed in each of the reexamination proceedings, and a decision under 37 C.F.R. § 1.989(a) is timely. The '593, and '598 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued. The '1413 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to the reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1413, '593, and '598 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1413, '593, and '598 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).² First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters'

² Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "*Inter Partes* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

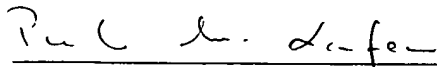
CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,413, *inter partes* Reexamination Control No.95/000,598, and *inter partes* Reexamination Control No. 95/000,593 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

Inter partes Reexamination Control No. 95/001,413,
inter partes Reexamination Control No.95/000,598, and
inter partes Reexamination Control No. 95/000,593.

-7-

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

June 7, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET, FIFTY-THIRD FLOOR

HOUSTON, TX 77002

Date:

MAILED

JUN 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

MORRISON & FOERSTER LLP

12531 HIGH BLUFF DRIVE

SUITE 100

SAN DIEGO, CA 92130-2040

Date:

MAILED

JUN 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,598	12/03/2010	7148850	3008.009REX2	8625
26111	7590	06/21/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/21/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

BAKER BOTTS LLP
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980

MAILED

JUN 21 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000598

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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WASHINGTON, DC 20005

(For Patent Owner)

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12531 HIGH BLUFF DRIVE, SUITE 100
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(For 95/000,593 Third Party Requester)

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(For 95/000,598 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/000,598
Filed: December 3, 2010
For: U.S. Patent No. 7,148,850

**DECISION
ON PETITIONS
UNDER 37 CFR 1.183**

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,413.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,413.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

BACKGROUND

1. On December 12, 2006, U.S. patent number 7,148,850 (the '850 patent) issued to Baliarda *et al.*
2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '850 patent, which request was assigned Reexamination Control No. 95/001,413 (the '1413 proceeding).
3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1413 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.¹
5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).
9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the

¹ On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.

October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

10. On June 8, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1413 proceeding with *inter partes* reexamination proceeding control no. 95/000,593 (the '593 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a

response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 50 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).² Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."³ Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."⁴

² Patent owner petition under 37 CFR 1.183 at page 2.

³ *Id.* (stating that "[i]n addition to the Corrected Response, a number of Rule 132 declarations are filed herewith: Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages); and, Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages), and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

⁴ *Id.*

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.⁵ Additionally, patent owner asserts that “the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 7 pages, it incorporates by reference almost 500 pages of arguments and detailed claim charts.”⁶ Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁷ As evidence of the reformatting and further editing made to reduce page length, patent owner submitted as “Exhibit 1” a redlined document comparing patent owner’s January 10, 2011 original response submission to patent owner’s April 11, 2011 corrected response submission. “Exhibit 1” has been expunged from the record of the ‘1413 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),⁸ and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span approximately 475 pages.⁹ Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s April 11, 2011 corrected response submission. This waiver makes patent owner’s April 11, 2011 corrected response submission page-length compliant.

⁵ Id. at pages 2-4.

⁶ Id. at page 5.

⁷ Id.

⁸ 49 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 14-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 45-page “Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132” are subject to the regulatory page limit count, such that the total number of pages of the patent owner’s April 11, 2011 corrected response submission exceeds the 50-page limit.

⁹ On its face, the substantive portion of the October 8, 2010 Office action spans only 5 pages, but it incorporates by reference more than 200 pages, in addition to approximately 270 pages of claim charts, from the ‘1413 request for *inter partes* reexamination.

IV. Third party requester petition of May 2, 2011

On May 2, 2011, the '1413 requester filed, in the '1413 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1413 requester asserts that the May 2, 2011 comments submission includes "49 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best's expert report."¹⁰ The '1413 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 49 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best's [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language" such that no waiver would be needed.¹¹

In support of its request for waiver of the rule, the '1413 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 132 page response."¹² The '1413 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 83 pages."¹³ The '1413 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."¹⁴

Based on the specific facts set forth in the '1413 requester's petition under 37 CFR 1.183, the '1413 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),¹⁵ and the

¹⁰ Third party requester petition under 37 CFR 1.183 at page 1.

¹¹ *Id.* at page 4. The '1413 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1413 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

¹² *Id.* at page 2.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ Upon brief review, it appears that 49 pages of the remarks portion of the '1413 requester's May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, portions of the

individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1413 requester's May 2, 2011 comments submission exceeds 50 pages. Accordingly, the '1413 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 8, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

submitted declarations are deemed to include legal argument and are subject to the regulatory page limit count, such that the total number of pages of the '1413 requester's May 2, 2011 comments submission exceeds the 50-page limit.

Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1413 proceeding with the '593 and '598 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,593 third party requester and the 95/000,598 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.
2. The '1413 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1413 requester's May 2, 2011 comments submission. This waiver makes the '1413 requester's May 2, 2011 comments submission page-length compliant.
3. The 95/000,593 third party requester and the 95/000,598 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-17-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	09/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET, FIFTY-THIRD FLOOR

HOUSTON, TX 77002

Date:

MAILED**SEP 08 1****CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	09/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130-2040

Date:

MAILED**SEP 08 2011****CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,598	12/03/2010	7148850	3008.009REX2	8625
26111	7590	09/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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BAKER BOTTS LLP

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

Date:

MAILED

SEP 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000598

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,413 + 95/000,593 +
95/000,598

1. THIS IS A DECISION ON THE PETITION FILED on 08/31/2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on 07/29/2011, which sets a two (2) month period for filing a response thereto, be extended by two (2) months.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☒ Other/comment: Requests for extensions of time for more than one (1) month will not be granted unless extraordinary circumstances are involved; e.g., death or incapacitation of the patent owner.
 - B. ☐ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/ for Mark Reinhart

SPE, Art Unit 3992

[Signature]

(Title)



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(For *Inter Partes* '593 Requester)

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(For *Inter Partes* '598 Requester)

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1000 Louisiana Street
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(For *Inter Partes* '1413 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No.: 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/000,598
Filed: December 03, 2010
For: U.S. Patent No. 7,148,850

Inter Partes Reexamination Proceeding
Control No: 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,598, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/000,598 is hereby **severed** from the merged proceeding of inter partes reexamination control numbers 95/000,598, 95/000,593 and 95/001,413.

Inter partes reexamination proceeding 95/000,598, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of inter partes reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of inter partes reexamination proceeding control number 95/000,598 (the '598 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that "... HTC [the defendant/requester of the '598 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '593 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 29, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '850 patent, which is the patent under reexamination in the '598 proceeding, are listed in the consent judgment as claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, 68, 69, and 70, which are, with the exception of claim 68, identical to the claims that were requested to be reexamined by HTC in the '598 proceeding,² and are identical (i.e., including claim 68) to the claims under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '850 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '598 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598, 95/000,593 and 95/001,413.

Inter partes reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue**.³ Any rejection proposed by HTC (the requester of the '598 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

² Claim 68 was not specifically requested to be reexamined in the request of the '598 proceeding, but is currently under reexamination in the merged proceeding.

³ As pointed out above, this decision does not address the September 29, 2011 petition to terminate the '593 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.⁴

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,593 and 95/001,413, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,593 and 95/001,413 will otherwise remain, in general, as outlined by the decision, mailed on June 8, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '598 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,598 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,598 (the '598 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,598, 95/000,593 and 95/001,413.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,593 and 95/001,413 **will continue** in the manner set forth in this decision.
- The prosecution of the '598 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '598 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '598 proceeding, as set forth in this decision.

⁴ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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SUITE 100
SAN DIEGO, CA 92130-2040

MAILED

Date: **DEC 12 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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HOUSTON, TX 77002

Date: **MAILED**

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413
PATENT NO. : 7148850
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

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(For *Inter Partes* '593 Requester)

DEC 12 2011

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(For *Inter Partes* '1413 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No.: 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 04, 2010
For: U.S. Patent No. 7,148,850

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:¹

1. The September 29, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 29, 2011 petition to terminate); and
2. The September 29, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 29, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 29, 2011, patent owner's petition to expunge filed on September 29, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,598, was granted. *Inter partes* reexamination proceeding 95/000,598 was severed from the merger of *inter partes* reexamination proceedings 95/000,598, 95/000,593 and 95/001,413, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,593 and 95/001,413.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,593, filed on September 29, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 29, 2011, is **dismissed**.

DECISION

The September 29, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,593 (the '593 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '593 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '850 patent's claims 1, 4, 6, 16, 17, 19, 21, 22, 24-26, 28, 29, 35, 38, 40, 45-48, 51, 53, 57, 58, 61, 65, 66, 68-70, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 29, 2011 petition to

expunge, discussed below), the patent owner informs the Office that “[t]he Final Consent Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 29, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 29, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘850 patent’”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘593 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘593 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an

² The September 29, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 29, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

obligation to “provide an administrative record showing the evidence on which the findings are based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 29, 2011 petition to terminate is dismissed.

The September 29, 2011 Petition to Expunge

On September 29, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 29, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “ . . . entered a Final Consent Judgment against Kyocera [the requester of the ‘593 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 29, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the

requester of the '593 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 29, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 29, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,593 is **dismissed**.
- Patent owner's September 29, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 29, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script that reads "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon

Director

Office of Patent Legal Administration



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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HOUSTON, TX 77002

MAILED

FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,593	12/22/2010	7,148,850	3008.009REX1	2593
26111	7590	02/22/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
ART UNIT			PAPER NUMBER	

DATE MAILED: 02/22/2012

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FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000593

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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(For 95/000,593 Third Party Requester)

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HOUSTON, TX 77002

(For 95/001,413 Third Party Requester)

MAILED

FEB 22 2012

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No. 7,148,850

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:
:
:
: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.183**

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 4, 2010
For: U.S. Patent No. 7,148,850

:
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:

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,593, 95/000,598 and 95/001,413.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

RELEVANT BACKGROUND

1. On December 12, 2006, U.S. patent number 7,148,850 (the '850 patent) issued to Carles Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '850 patent were filed, which requests were assigned Reexamination Control Nos. 95/000,593, 95/000,598, and 95/0001,413, and for each of which reexamination was instituted by the Office.

3. On June 8, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1413 proceeding with the ‘593 and ‘598 proceedings (the merged proceeding).
4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (petition under 37 CFR 1.183).¹
6. On December 12, 2011, the Office issued a “DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER,” terminating the 95/000,598 proceeding and severing the 95/000,598 proceeding from the merged proceeding.²

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an

¹ On September 8, 2011, the Office mailed a decision granting a one-month extension of time for patent owner’s response to the July 29, 2011 Office Action.

² The merged proceeding continues as to the ‘593 and ‘1413 proceedings.

attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.³ Patent owner asserts that the argument portion of the October 31, 2011 response submission is 95 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.⁴ Patent owner states that it concurrently filed "a number of 132 Declarations" but asserts that the declarations are "drawn to fact, not argument, and thus does [sic] not count towards the 50-page limit."⁵ Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO

³ Because the '598 proceeding has been terminated, this decision does not address the instant petition with respect to the '598 proceeding.

⁴ Patent owner petition under 37 CFR 1.183 at page 2.

⁵ *Id.* at page 4 (identifying a declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (38 pages), and a declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (45 pages)).

holds count towards the 50 page limit....”⁶ Patent owner asserts that both the response and the 132 declaration satisfy formatting guidelines for waiver of the regulatory page limit.⁷

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.⁸ Additionally, patent owner asserts that although the Office action “constitutes only 36 pages, it incorporates by reference over 1200 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”⁹ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”¹⁰ Thus, patent owner asserts that “the scope and complexity of the Office Action, as well as its efforts to efficiently prepare the Response, establish that more pages are needed (beyond what is permitted by 37 CFR 1.943(b)) to fully and adequately respond to the Office Action.”¹¹

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),¹² and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),¹³ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,593 third party requester and the 95/001,413 third party requester have 30 days from the date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

⁶ Id. at page 2.

⁷ Id. at pages 2 and 7 (stating that the response and 132 declarations satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

⁸ Id. at pages 4-7.

⁹ Id. at page 3.

¹⁰ Id.

¹¹ Id.

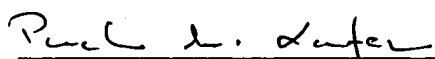
¹² 94 pages of the remarks portion of patent owner’s October 31, 2011 response submission count toward the page limit (the cover page, pages of the table of contents, and the last page that only includes a signature are excluded from the page count, as is the 15-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s October 31, 2011 response submission exceeds the 50-page limit by at least 44 pages, without including any portions of the declarations that also count toward the regulatory page limit.

¹³ On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 43 pages, but in setting forth the rejections that have been adopted, it incorporates by reference nearly 900 pages from the ‘1413, ‘593 and ‘598 requests for *inter partes* reexamination, far exceeding the number of pages of patent owner’s proposed response, including any pages of the accompanying declarations that also count toward the regulatory page limit.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's October 31, 2011 response submission. This waiver makes patent owner's October 31, 2011 response submission page-length compliant.
2. The 95/001,413 third party requester and the 95/000,593 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 31, 2011 petition under 37 CFR 1.183 and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-7717 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

02-21-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,413	08/04/2010	7148850	3008.009REX0	1117
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT PAPER NUMBER	

DATE MAILED: 02/27/2012

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001413 + 95000593

PATENT NO. : 7148850

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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FEB 27 2012

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Inter Partes Reexamination Proceeding
Control No. 95/000,593
Filed: December 22, 2010
For: U.S. Patent No.: 7,148,850

Inter Partes Reexamination Proceeding
Control No. 95/001,413
Filed: August 04, 2010
For: U.S. Patent No. 7,148,850

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,413 (the '1413 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1413 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,598. *Inter partes* reexamination proceeding 95/000,598 was severed from the merger of *inter partes* reexamination proceedings 95/000,598, 95/000,593 and 95/001,413, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,593 and 95/001,413.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,593 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,593 (the '593 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,148,850 (the '850 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '593 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 29, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 29, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '593 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '593 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,593 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414	08/04/2010	7,202,822	3008.002REX0	1120
26111	7590	04/11/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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APR 11 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001414
PATENT NO. : 7202822
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Patent Owner)

MAILED

APR 11 2011

NOVAK, DRUE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

(For Third Party Requester) REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the February 9, 2011 third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."

The petition is before the Office of Patent Legal Administration for decision.

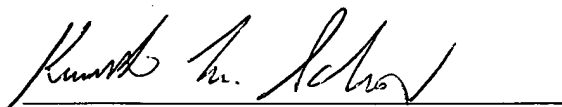
The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirements of 37 CFR 1.943(b) for its comments submission filed on February 9, 2011. On March 25, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's January 10, 2011 response submission is defective and setting a time period of 15 days for patent owner to file a corrected response submission. The notice of non-compliance also states that since a proper response from the patent owner has not been made, the third party requester will have the opportunity to file new comments within 30 days of service of a corrected patent owner response submission. Accordingly, requester's February 9, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently filed comments submission is moot, and requester's February 9, 2011 petition is **dismissed as moot**.

CONCLUSION

1. Third party requester's February 9, 2011 petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" is dismissed as moot.
2. Telephone inquiries with regard to this decision should be directed to Maria Nuzzolillo, at 571-272-8150 or Nicole Dretar Haines, Office of Patent Legal Administration, at (571) 272-7717.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

04-11-2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414	08/04/2010	7,202,822	3008.002REX0	1120
26111	7590	05/06/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
ART UNIT			PAPER NUMBER	

DATE MAILED: 05/06/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAY 06 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001414
PATENT NO. : 7202822
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Robert Greene Sterne : (For Patent Owner)
STERNE, KESSLER, GOLDSTEIN :
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1100 NEW YORK AVE., NW :
WASHINGTON, DC 20005 :

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MAY 06 2011

CENTRAL REEXAMINATION UNIT

NOVAK DRUCE & QUIGG, LLP : (For Third Party
(NDQ REEXAMINATION GROUP) : Requester)
1000 LOUISIANA STREET :
53RD FLOOR :
HOUSTON, TX 77002 :

In re: Baliarda *et al.* :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,414 :
Deposited: August 4, 2010 :
For: U.S. Patent No.: 7,202,822 :

This is a decision on a petition filed by the patent owner on January 10, 2011 entitled "Petition Under 37 C.F.R. § 1.182 to Strike Cohen as a Substantial New Question of Patentability, and to Withdraw Claim Rejections Based on Cohen" [hereinafter "petition"] and is a request that a reference and the accompanying rejections based on the reference be withdrawn because no substantial new question of patentability has been raised.

The petition was filed as a 1.182 petition, but is being treated as a petition under 1.181.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. Also before the Assistant Deputy Commissioner for Patent Operations is an opposition to the petition, filed by the third party requester on February 9, 2011.

The petition is dismissed as untimely.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,202,822 issued on April 10, 2007.
- A request for *inter partes* reexamination was filed on August 4, 2010 and assigned control number 95/001,414.
- Reexamination was ordered and mailed together with a first action on the merits on October 8, 2010. The examiner found *inter alia* that a substantial new question of patentability was raised by a reference to Cohen.
- On November 9, 2010, patent owner requested a one-month extension of time to reply to the Office action. The extension was granted in a decision mailed November 17, 2010.
- On January 10, 2011, the patent owner filed the instant petition with a response to the first action.
- On February 9, 2011, the third party requester filed an opposition to the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.182 Questions not specifically provided for

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP § 1002 Petitions to the Director of the USPTO (in part)

37 CFR 1.181(f) provides that any petition under that rule which is not filed “within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.” Often, the “action or notice from which relief is requested,” for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a 3-month period for reply. Under such circumstances, if applicant requests reconsideration, under 37 CFR 1.111(b), of the requirement for a new drawing, the examiner’s action on this request, if adverse, establishes the beginning of the 2-month period for filing the petition. The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period. The 2-month period for filing timely petitions set forth in 37 CFR 1.181(f) applies to any petition under 37 CFR part 1, except as otherwise provided. A number of sections (e.g., 37 CFR 1.377, 37 CFR 1.378, 37 CFR 1.644, and 37 CFR 1.740) specify the time period within which a petition must be filed (or may be dismissed as untimely). The 2-month time period in 37 CFR 1.181(f) applies to a petition under any section (e.g., 37 CFR 1.182 and 37 CFR 1.183) that does not specify the time period within which a petition must be filed. The 2-month period is not extendable under 37 CFR 1.136(a) since the time is within the discretion of the Director of the USPTO.

DECISION

First, as a procedural matter, the petition was filed under 37 CFR § 1.182. That rule is the catch-all for questions not specifically provided for. The petition, however, is not appropriate under this rule as it is provided for elsewhere in the regulations. 37 CFR § 1.181(a)(1) provides for a petition from any action by the examiner which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. 37 CFR § 1.181(a)(3) permits a petition to invoke the Director's supervisory authority in "appropriate circumstances." The petition is questioning the examiner's determination under 35 U.S.C. § 312(a) that a substantial new question of patentability was raised, and 35 U.S.C. § 312(c) specifically states that such decision is final and non-appealable. This is therefore a petition from an action by the examiner that is not subject to appeal to the Board or the court, a situation provided for in 1.181(a)(1). Additionally, the petition is essentially arguing that the grant of the request based on Cohen is *ultra vires*, a situation that MPEP 2646 states falls within the "appropriate circumstances" of 1.181(a)(3). The question raised in the petition is provided for in the regulations and therefore is improper under 37 CFR § 1.182. It is treated as a petition under 37 CFR § 1.181.^{1,2}

The Order Granting the Reexamination Request was mailed on October 8, 2010 along with the first action on the merits. Patent owner therefore had a two-month time period to petition from that action of the examiner under 37 CFR § 1.181(f). The petition was not received until January 10, 2011, outside of the two-month time period. The petition is therefore dismissed as untimely in accordance with 37 CFR § 1.181(f).

While it is true that petitioner received an extension of time, this extension was, as titled in the November 9, 2010 petition, a "Petition for Extension of Time to File Response to First Office Action." The request was therefore only for an extension for filing the response to the Office action, not a request for extension of the time period requirement of 37 CFR § 1.181(f). In any case, § 1.181(f) itself states that the two-month time period therein is not extendable. Additionally, the MPEP explains that the time period of § 1.181(f) is independent of the time period to respond to an Office action. MPEP 1002 ("The petition must be filed within this period even though the period for reply to the rejection of the claims may extend beyond the 2-month period."). Thus, any extension of time in this case was not applicable to the requirements of 37

¹ The opposition states at p. 3 n. 1 that while a 1.181 petition is permitted in certain circumstances, the petition is not a 1.181 petition, and no 1.181 petition could be filed due to the facts of this case and the lateness of such a petition. As stated above, the facts do support the filing of a 1.181 petition, and nothing prevents the Office from treating it as such, given that it was timely filed and otherwise meets the requirements under 1.181.

² Note that this does not change the result discussed herein. As described in MPEP 1002, the time period requirement of 37 CFR § 1.181(f) also applies to petitions under § 1.182, therefore regardless of the treatment of the petition, it is subject to the 2-month period.

CFR § 1.181(f). The petition was not filed within the 2-month period set forth in 37 CFR § 1.181(f), therefore it is dismissed as untimely.

CONCLUSION

1. The petition is improper under 37 CFR § 1.182 as filed because the question is provided for elsewhere, but is considered as a petition under 37 CFR § 1.181 for vacating the Order as *ultra vires*. The petition is dismissed under 37 CFR § 1.181(f) as being untimely.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

A handwritten signature in black ink, appearing to read 'B. Kisliuk', written over a horizontal line.

Bruce Kisliuk

Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit



MAILED

JUN 6 7 2011

(For Patent Owner)

(For *Inter Partes* '592 Requester)

(For *Inter Partes* '1414 Requester)

(For *Inter Partes* '610 Requester)

10

**: DECISION, *SUA SPONTE*,
: MERGING
: *INTER PARTES*
: PROCEEDINGS**

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,202,822 (the '822 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.
2. On August 4, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/001,414 (the '1414 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest. Reexamination was ordered on October 8, 2010. An action on the merits was issued on that same date, rejecting all of the claims under reexamination. Patent owner responded on April 11, 2011;¹ no amendments to the claims were proposed in that response. Third party requester submitted comments on May 2, 2011.
3. On November 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,592 (the '592 *inter partes* proceeding), and a filing date of December 16, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest. Reexamination was ordered on January 31, 2011. No action on the merits has been issued in this proceeding.
4. On December 16, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was filed by third party requester; the request was assigned control number 95/000,610 (the '610 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest. Reexamination was ordered on February 1, 2011. No action on the merits has been issued in this proceeding.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

¹ An earlier patent owner response was refused entry, and additional time given for a proper response.

As evidenced by the above review of facts, the '1414, '592, and '610 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent have been mailed in both the '592 and '610 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53 of the '822 patent was mailed in the '1414 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '592 and '610 proceedings are at the same stage, in which no Office action on the merits has been issued. The '1414 proceeding is at a stage following issuance of the first Office action on the merits and subsequent to reception of both patent owner and third party requester responses.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1414, '610, and '592 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1414, '610, and '592 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C.

314(b)(2).² First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent.

² Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "*Inter Partes* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

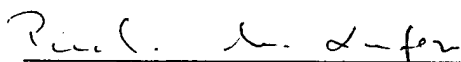
G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester

intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,414, *inter partes* Reexamination Control No.95/000,610, and *inter partes* Reexamination Control No. 95/000,592 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

June 7, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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(For 95/000,610 Third Party Requester)

MAILED

JUN 21 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/000,610
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

DECISION
ON PETITIONS
UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,414.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,414.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are granted to the extent set forth below.

BACKGROUND

1. On April 10, 2007, U.S. patent number 7,202,822 (the '822 patent) issued to Baliarda *et al.*
2. On August 4, 2010, a third party requester filed a request for *inter partes* reexamination of the '822 patent, which request was assigned Reexamination Control No. 95/001,414 (the '1414 proceeding).
3. On October 8, 2010, the Office issued an order granting *inter partes* reexamination in the '1414 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On January 10, 2011, patent owner filed a response to the October 8, 2010 Office action.¹
5. On February 9, 2011, third party requester filed comments after the October 8, 2010 Office action and patent owner's January 10, 2011 response, concurrently with a petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's January 10, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 11, 2011, the Office mailed a decision, dismissing as moot, the February 9, 2011 "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)."
8. Also, on April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the October 8, 2010 Office action (patent owner corrected response submission).
9. On May 2, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" (requester petition under 37 CFR 1.183), concurrently with requester's comments after the October 8, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

¹ On November 17, 2010, the Office mailed a decision granting patent owner's November 9, 2010 petition for a one-month extension of time.

10. On June 7, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1414 proceeding with *inter partes* reexamination proceeding control no. 95/000,592 (the ‘592 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,610 (the ‘610 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner’s response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner’s response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed

response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 62 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the corrected response submission.² Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."³ Nonetheless, patent owner also requests waiver of the 50-page limit "for any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts."⁴

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.⁵ Additionally, patent owner asserts that "the full

² Patent owner petition under 37 CFR 1.183 at page 2.

³ *Id.* at page 4 (stating that the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)" and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (45 pages)," are filed herewith and noting in FN 3 that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

⁴ *Id.* at page 6.

⁵ *Id.* at pages 4-6.

length of the Corrected Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 9 pages, it incorporates by reference over 450 pages of arguments and detailed claim charts set forth by the third party requester in its request for reexamination.”⁶ Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁷ As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner’s January 10, 2011 original response submission to patent owner’s April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the ‘1414 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),⁸ and the individual facts and circumstances of this case (such as the length of the October 8, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s April 11, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the October 8, 2010 Office action, which has been determined to span more than 400 pages.⁹ Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s April 11, 2011 corrected response submission. This waiver makes patent owner’s April 11, 2011 corrected response submission page-length compliant.

IV. Third party requester petition of May 2, 2011

On May 2, 2011, the ‘1414 requester filed, in the ‘1414 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The ‘1414 requester asserts that the May 2, 2011 comments submission

⁶ Id. at page 2.

⁷ Id. at page 3.

⁸ 69 pages of the remarks portion of patent owner’s April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 17-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the total number of pages of the patent owner’s April 11, 2011 corrected response submission exceeds the 50-page limit.

⁹ On its face, the substantive portion of the October 8, 2010 Office action spans only approximately 7 pages, but it incorporates by reference approximately 178 pages, in addition to approximately 220 pages of claim charts, from the ‘1414 request for *inter partes* reexamination.

includes “61 pages of double spaced 12 pt font arguments, a 13 page declaration from Dr. Balanis under 37 C.F.R. § 1.132 and a 21 page excerpt of Dr. Best’s expert report.”¹⁰ The ‘1414 requester asserts, however, that “[i]f the Office agrees with [patent owner’s] interpretation of MPEP § 2667(I)(A)(2), then Samsung’s Comments are only 61 pages as Dr. Balanis’s declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue and the excerpts of Dr. Best’s [sic] expert report primarily address the background of antennas and how one of ordinary skill in the art would understand certain claim language.”¹¹

In support of its request for waiver of the rule, the ‘1414 requester asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 144 page response.”¹² The ‘1414 requester asserts that it “has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit” and “is asking for significantly fewer total pages than [sic] the Patent Owner has submitted,” *i.e.*, requester “is only asking for a total of 95 pages.”¹³ The ‘1414 requester also asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner.”¹⁴

Based on the specific facts set forth in the ‘1414 requester’s petition under 37 CFR 1.183, the ‘1414 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),¹⁵ and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the ‘1414 requester’s May 2, 2011 comments submission exceeds 50 pages. Accordingly, the ‘1414 requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of

¹⁰ Third party requester petition under 37 CFR 1.183 at page 1.

¹¹ *Id.* at page 4. The ‘1414 requester is cautioned that statements submitted in opposition to patent owner’s petition under 37 CFR 1.183 are improper and may result in the requester’s petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the ‘1414 requester presents arguments against patent owner’s position set forth in patent owner’s petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner’s response to an Office action on the merits. Patent owner’s petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner’s corrected response submission, however, is not a “response” to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner’s petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper “closed” and “not public” in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

¹² *Id.* at page 2.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ 62 pages of the remarks portion of the ‘1414 requester’s May 2, 2011 comments submission count toward the page limit. Thus, the total number of pages of the ‘1414 requester’s May 2, 2011 comments submission exceeds the 50-page limit.

the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's June 7, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. [footnote omitted]

Thus, because the patent owner's April 11, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1414 proceeding with the '592 and '610 proceedings, the entry of patent owner's April 11, 2011 corrected response submission triggers a right for the 95/000,592 third party requester and the 95/000,610 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 11, 2011 corrected response submission. This waiver makes patent owner's April 11, 2011 corrected response submission page-length compliant.
2. The '1414 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1414 requester's May 2, 2011 comments submission. This waiver makes the '1414 requester's May 2, 2011 comments submission page-length compliant.
3. The 95/000,592 third party requester and the 95/000,610 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 11, 2011 petition under 37 CFR 1.183 and entering patent owner's April 11, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-17-2011



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Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No.: 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/000,610
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

Inter Partes Reexamination Proceeding
Control No: 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,610, filed on September 16, 2011, is granted.

Inter partes reexamination proceeding control number 95/000,610 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,610, 95/000,592 and 95/001,414.

Inter partes reexamination proceeding 95/000,610, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,610 (the '610 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '610 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '592 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '822 patent, which is the patent under reexamination in the '610 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35, 44, 46, 48, 52, and 53, which are identical to the claims that were requested to be reexamined by HTC in the '610 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '822 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '610 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610, 95/000,592 and 95/001,414.

Inter partes reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue**.² Any rejection proposed by HTC (the requester of the '610 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

² As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '592 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.³

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,592 and 95/001,414, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,592 and 95/001,414 will otherwise remain, in general, as outlined by the decision, mailed on June 7, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".⁴

The '610 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,610 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,610 (the '610 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,610, 95/000,592 and 95/001,414.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,592 and 95/001,414 **will continue** in the manner set forth in this decision.
- The prosecution of the '610 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '610 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '610 proceeding, as set forth in this decision.

³ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

⁴ The statement at the bottom of page 4 of the June 7, 2011 decision, that "because the '1414 *inter partes* third party requester does not propose any rejection of claim 8 in the request for reexamination, the '1414 requester has no appeal rights as to those claims as they appear in the '822 patent", was made in error. The requester of the '1414 proceeding did propose rejections of claim 8 in the request filed in that proceeding, and does have appeal rights as to claim 8 as it appears in the '822 patent.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414	08/04/2010	7,202,822	3008.002REX0	1120
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,592	12/16/2010	7,202,822	3008.002REX1	8986
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000592
PATENT NO. : 7202822
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: **MAILED**
DEC 12 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001414
PATENT NO. : 7202822
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(For Patent Owner)

MAILED

DEC 12 2011

Morrison & Foerster, LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

(For *Inter Partes* '592 Requester) **CENTRAL REEXAMINATION UNIT**

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1414 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No.: 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:¹

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,610, was granted. *Inter partes* reexamination proceeding 95/000,610 was severed from the merger of *inter partes* reexamination proceedings 95/000,610, 95/000,592 and 95/001,414, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,592 and 95/001,414.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,592, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,592 (the '592 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '592 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '822 patent's claims 1, 4, 5, 7-9, 12, 13, 15, 18, 20-25, 29-31, 35 44, 46, 48, 52 and 53, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘822 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘592 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘592 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

² The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘592 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘592 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

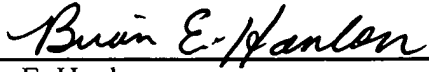
The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,592 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon", written over a horizontal line.

Brian E. Hanlon

Director

Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414 + 95/000592	08/04/2010	7,202,822	3008.002REX0	1120
26111	7590	02/23/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-23-12

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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001414 - 951006592
PATENT NO. : 7202822
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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(For 95/000,592 Third Party Requester)

CENTRAL REEXAMINATION UNIT

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HOUSTON, TX 77002

(For 95/001,414 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No. 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

:
:
:
: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.183**
:
:
:

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,592, 95/000,610 and 95/001,414.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

RELEVANT BACKGROUND

1. On April 10, 2007, U.S. patent number 7,202,822 (the '822 patent) issued to Carles Puente Baliarda *et al.*
2. Subsequently, three requests for *inter partes* reexamination of the '822 patent were filed, which requests were assigned Reexamination Control Nos. 95/000,592, 95/000,610, and 95/0001,414, and for each of which reexamination was instituted by the Office.

3. On June 7, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1414 proceeding with the ‘592 and ‘610 proceedings (the merged proceeding).
4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (petition under 37 CFR 1.183).¹
6. On December 12, 2011, the Office issued a “DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER,” terminating the 95/000,610 proceeding and severing the 95/000,610 proceeding from the merged proceeding.²

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which

¹ On September 14, 2011, the Office mailed a decision granting a one-month extension of time for patent owner’s response to the July 29, 2011 Office Action.

² The merged proceeding continues as to the ‘592 and ‘1414 proceedings.

petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.³ Patent owner asserts that the argument portion of the October 31, 2011 response submission is 87 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.⁴ Patent owner states that it concurrently filed "a number of 132 declarations" but asserts that the declarations are "drawn to fact, not argument, and thus does [sic] not count towards the 50-page limit."⁵ Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit...."⁶ Patent owner asserts that

³ Because the '610 proceeding has been terminated, this decision does not address the instant petition with respect to the '610 proceeding.

⁴ Patent owner petition under 37 CFR 1.183 at page 2.

⁵ *Id.* at page 4 (identifying a declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (38 pages), and a declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (45 pages)).

⁶ *Id.* at page 2.

both the response and the 132 declaration satisfy formatting guidelines for waiver of the regulatory page limit.⁷

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.⁸ Additionally, patent owner asserts that although the Office action “constitutes only 40 pages, it incorporates by reference over 1200 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”⁹ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”¹⁰ Thus, patent owner asserts that “the scope and complexity of the Office Action, as well as its efforts to efficiently prepare the Response, establish that more pages are needed (beyond what is permitted by 37 CFR 1.943(b)) to fully and adequately respond to the Office Action.”¹¹

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),¹² and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),¹³ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/000,592 third party requester and the 95/001,414 third party requester have 30 days from the date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

⁷ Id. at pages 2 and 7 (stating that the response and 132 declarations satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

⁸ Id. at pages 4-7.

⁹ Id. at page 3.

¹⁰ Id.

¹¹ Id.

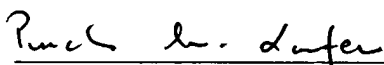
¹² 87 pages of the remarks portion of patent owner’s October 31, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 16-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s October 31, 2011 response submission exceeds the 50-page limit by at least 37 pages, without including any portions of the declarations that also count toward the regulatory page limit.

¹³ On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 40 pages, some of which pertain to rejections that have been withdrawn and not adopted, but in setting forth the rejections that have been adopted, it incorporates by reference over 1000 pages from the ‘1414, ‘592 and ‘610 requests for *inter partes* reexamination, far exceeding the number of pages of patent owner’s proposed response, including any pages of the accompanying declarations that also count toward the regulatory page limit.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, “[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner’s completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so.” Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner’s October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.
2. The 95/001,414 third party requester and the 95/000,592 third party requester each has 30 days from the mailing date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183 and entering patent owner’s October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-7717 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

02-21-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,414	08/04/2010	7,202,822	3008.002REX0	1120
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG, LLP

(NDQ REEXAMINATION GROUP)

1000 LOUISIANA STREET, FIFTY-THIRD FLOOR

HOUSTON, TX 77002

Date:

MAY 11 2012

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001414 + 95000592

PATENT NO. : 7202822

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED
FEB 27 2012

Morrison & Foerster, LLP
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San Diego, CA 92130-2040

(For *Inter Partes* '592 Requester)

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
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Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1414 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,592
Filed: December 16, 2010
For: U.S. Patent No.: 7,202,822

Inter Partes Reexamination Proceeding
Control No. 95/001,414
Filed: August 4, 2010
For: U.S. Patent No. 7,202,822

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,414 (the '1414 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1414 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,610. *Inter partes* reexamination proceeding 95/000,610 was severed from the merger of *inter partes* reexamination proceedings 95/000,610, 95/000,592 and 95/001,414, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,592 and 95/001,414.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,592 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,592 (the '592 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,202,822 (the '822 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '592 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '592 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '592 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,592 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,416	11/04/2010	6514187	34297/35	3098
23556 / 7590	04/13/2011		EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. Tara Pohlkotte 2300 Winchester Rd. NEENAH, WI 54956			ART UNIT	PAPER NUMBER

DATE MAILED: 04/13/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 4-13-11

Brian Comack, Esq.
AMSTER ROTHSTEIN EBENSTEIN, LLP
90 Park Avenue
New York, NY 10016

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001416
PATENT NO. : 6514187
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Inter Partes Reexamination Proceeding
Control No. 95/001,416
Filed: November 4, 2010
For: U.S. Patent No. 6,514,187

:
: **DECISION**
: **ON**
: **PETITIONS**
:

This is a decision on the patent owner's petition of February 14, 2011, entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943 PURSUANT 37 C.F.R § 1.183" and third party requester's petition of March 16, 2011 entitled "REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 TO WAIVE PAGE LENGTH REQUIREMENT OF 37 C.F.R. § 1.943(b)."

The patent owner and third party requester petitions are before the Office of Patent Legal Administration for decision.

The patent owner's petition is **granted in-part** and the third party requester's petition is **granted**, for the reasons set forth below.

BACKGROUND

1. On February 4, 2003, US patent number 6,514,187 ('187) issued to Coenen, *et al.*
2. On November 4, 2010 third party requester filed a "SECOND CORRECTED REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT NO. 6,514,187," which request was assigned reexamination control number 95/001,416 (the '1416 proceeding).
3. On December 14, 2010 the Office mailed an order granting *inter partes* reexamination in the '1416 proceeding. Concurrently on December 14, 2010, the Office mailed a first office action on the merits.
4. On February 14, 2011, patent owner filed the instant patent owner petition entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943 PURSUANT 37 C.F.R § 1.183" (the

patent owner petition under 37 CFR 1.183), concurrently with patent owner's response submission.

5. On March 16, 2011 third party requester filed the instant requester petition entitled "REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 TO WAIVE PAGE LENGTH REQUIREMENT OF 37 C.F.R. § 1.943(b)" (the requester petition under 37 CFR 1.183), concurrently with requester's comment submission.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Patent Owner Petition Under 37 CFR 1.183

Patent owner's February 14, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the December 14, 2010 Office action, has been fully considered.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's February 14, 2011 response. In particular, patent owner requests that the Office permit the February 14, 2011 response to have "as many as sixty (60) pages."¹ In support of waiver of 37 CFR 1.943(b), patent owner states that "[t]he Request was three hundred and five (305) pages in length, had over twenty (20) different Exhibits attached thereto, and proposed over sixty (60) different rejections of the claims of the '187 patent" and that the December 14, 2010 Office action "adopted thirty-one (31) of the Requesters proposed rejections."² Patent owner asserts that it "believes that a sixty page limitation would be equitable in light of the voluminous number of rejections and would provide the Patent Owner a fair opportunity to address each of the grounds of rejection adopted by the Office."³

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting the February 14, 2011 response submission that is in excess of 50 pages. Upon brief review, the February 14, 2011 response submission includes 52 pages of arguments. The February 14, 2011 response also includes an appendix "A" presenting amended and new claims, an appendix "B" showing support for the new claims, and an appendix "C" including a Circular published by the Italian Patent Office and an accompanying English-language translation thereof. The pages of the appendix "C" Italian Patent Office Circular and accompanying translation thereof are directed to establishing the date of a printed publication and are excluded from the page limit count. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count, no pages of appendix "A" count toward the page limit, but the 1-page appendix "B," showing support for the new claims, is included in

¹ Patent owner petition under 37 CFR 1.183 at page 1.

² *Id.*

³ *Id.*

the page limit count. Thus, 53 pages of the February 14, 2011 response submission are being included in the page count.

Based on the individual facts and circumstances of this case such as, for example, the size of the December 14, 2010 Office action, including the number of rejections and incorporation by reference of pages from the request for reexamination in the '1416 proceeding,⁴ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though patent owner's February 14, 2011 response submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response submission not exceed 53 pages.

As pointed out above, in the instant petition under 37 CFR 1.183, petitioner requests that the Office waive the page length requirement for patent owner's February 14, 2011 response submission, to provide an extra 10 pages beyond the regulatory page limit; however, based on the above discussion, only 3 pages are needed. Accordingly, patent owner's petition under 37 CFR 1.183 is granted in-part and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the December 14, 2010 Office action to exceed the page limit by 3 pages. This waiver makes patent owner's February 14, 2011 response submission page-length compliant.

III. Third Party Requester Petition Under 37 CFR 1.183

Third party requester's March 16, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered.

In the instant petition under 37 CFR 1.183, third party requester requests "[t]hat it be granted a waiver of the page length requirement set forth in 37 C.F.R. § 1.943(b) and allowed an additional 9 pages...."⁵ In support of waiver of 37 CFR 1.943(b), requester states that the "Patent Owner's February 14, 2011 response included presentation of 57 new claims (including 9 new independent claims), greatly increasing the number of claims under the present reexamination from 25-82."⁶ Furthermore, requester states "[t]he patent owner's newly added claims introduce new limitations that are not present in any of the original claims of '187 Patent under reexamination."⁷ Requester further asserts that "[t]he patent owner's presentation of 57 new claims and the corresponding need to raise and discuss additional prior art and additional grounds for rejection to address the new subject matters included in those new claims place an unreasonable and nearly impossible burden on the requester to fully address all of the issues."⁸

⁴ See December 14, 2010 Office action at pages 2-25. It is noted that, on its face, the substantive portion of the December 14, 2010 Office action, setting forth the rejections of the claims that were adopted by the examiner, appears to span only about 35 pages but relies heavily on incorporation by reference of approximately 300 pages from the request for *inter partes* reexamination in the '1416 proceeding to set forth the rejections.

⁵ Requester petition under 37 CFR 1.183 at page 2.

⁶ Id. at pages 1-2.

⁷ Id. at page 2.

⁸ Id.

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting the March 16, 2011 comments submission that is in excess of 50 pages. Upon brief review, the March 16, 2011 comments submission includes 59 pages of comments. Additionally, requester submitted a declaration under 37 CFR 1.132 by Marchitelli, with accompanying exhibits. No pages of the Marchitelli declaration are being counted toward the page limit, because the Marchitelli declaration and accompanying exhibits are directed to establishing the date of a printed publication. Thus, 59 pages of the March 16, 2011 comments submission are being included in the page count.

Based on the individual facts and circumstances of this case such as, for example, the 57 claims newly added by patent owner, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Thus, even though requester's March 16, 2011 comments submission exceeds the 50-page limit, it is still deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester's March 16, 2011 comments submission not exceed 59 pages. Accordingly, requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester's comments submission exceed the page limit by up to 9 pages. This waiver makes third party requester's March 16, 2011 comments submission page-length compliant.

CONCLUSION

1. Patent owner's February 14, 2011 petition under 37 CFR 1.183 is granted in-part and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's February 14, 2011 response submission to exceed the regulatory page limit by 3 pages. This waiver makes patent owner's February 14, 2011 response submission page-length compliant.
2. Third party requester's March 16, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's March 16, 2011 comments submission to exceed the regulatory page limit by 9 pages. This waiver makes requester's March 16, 2011 comments submission page-length compliant.
3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 and Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

04-12-2011
Kenpet8/lp...



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,417	08/16/2010	7244519	1095 7000	3598
25074	7590	07/01/2011	EXAMINER	
ALLEGHENY TECHNOLOGIES 1000 SIX PPG PLACE PITTSBURGH, PA 15222			ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2011

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Date:

MAILED

JUL 01 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001417
PATENT NO. : 7244519
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAILED

JUL 01 2011

CENTRAL REEXAMINATION UNIT

In re Festeau et al.
Inter Partes Reexamination Proceeding
Control No. 95/001417
Filed: August 16, 2010
For: U.S. Patent No. 7,244,519

: DECISION
: DISMISSING PETITION
: AND
: EXPUNGING IMPROPER
: PAPERS

This is a decision on the third party requester's paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR 1.183 TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENTS OF 37 CFR 1.943(b)," filed on April 18, 2011.

The third party requester petition is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is dismissed for the reasons set forth herein.

This is also a decision on the patent owner paper entitled "PATENT OWNER'S PETITION REGARDING THIRD PARTY'S PETITION TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENT," filed on April 20, 2011, and on the third party requester paper entitled "RESPONSE TO PATENT OWNER'S PETITION REGARDING THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR 1.183 TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENT," filed on May 10, 2011.

The patent owner and third party requester papers are before the Office of Patent Legal Administration.

The patent owner and third party requester papers are refused entry into the record, without consideration on the merits, for the reasons set forth herein.

BACKGROUND

1. U.S. Patent Number 7,244,519 (the '519 patent) issued to Festeau *et al.* on July 17, 2007, with claims 1-31.
2. A request for *inter partes* reexamination of the '519 patent was deposited by a third party requester on August 6, 2010, which request was assigned Reexamination Control No. 95/001417 (the '1417 proceeding). Ingersoll Cutting Tool Company is identified as the real party in interest.
3. On August 16, 2010, the third party requester filed a corrected request for *inter partes* reexamination in the '1417 proceeding and the '1417 proceeding was assigned a filing date of August 16, 2010.
4. On October 22, 2010, an order granting *inter partes* reexamination of claims 1-31 of the '519 patent was mailed for the '1417 proceeding, and was accompanied by a non-final Office action.
6. On February 22, 2011, patent owner timely filed a response to the October 22, 2010 Office action.¹
7. On March 24, 2011, third party requester filed comments after the February 22, 2011 patent owner response and the October 22, 2010 Office action.
8. On April 1, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of defective paper) stating that third party requester's March 24, 2011 comments submission exceeds the 50-page limit permitted by 37 CFR 1.943 and setting a 15-day time period from the mailing date of the notice for requester to file a corrected comments submission.
9. On April 18, 2011, third party requester filed the instant "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR 1.183 TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENTS OF 37 CFR 1.943(b)" (the petition under 37 CFR 1.183), concurrently with "THIRD PARTY REQUESTER'S RESPONSE TO PATENT OWNER'S RESPONSE OF 22-FEB-2011" and accompanying attachments (the comments submission).
10. On April 20, 2011, patent owner filed the instant "PATENT OWNER'S PETITION REGARDING THIRD PARTY'S PETITION TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENT" (the patent owner opposition paper).
11. On May 10, 2011, third party requester filed the instant "RESPONSE TO PATENT OWNER'S PETITION REGARDING THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR 1.183 TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENT" (the requester opposition paper).

¹ See December 14, 2010 decision and January 24, 2011 decision granting patent owner requests for extension of time to file patent owner's response to the October 22, 2010 Office action.

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Third Party Requester April 18, 2011 Petition under 37 CFR 1.183

On April 18, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. On page 2 of the instant petition under 37 CFR 1.183, requester states:

A revised response, totaling 91 pages, is being concurrently submitted. Relative to the Response filed on March 24, 2011, the margins and font size have been modified, but are believed to still comply with 37 CFR 1.52. The revised Response includes 23 pages of comments, a 16-page Rule 132 Declaration of Dennis Quinto and an 8-page Rule 132 Declaration of Kenneth J.S. Brookes, totaling 47 pages for these three items of the Response. Also included with the Response is a 44 page Attachment C comprising a claim chart addressing Patent Owner's 63 newly added claims.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

In support of waiver of the rule, requester asserts that patent owner's February 22, 2011 response included "14 pages of new claims comprising 6 new independent claims and 63 new claims in all" and that "[b]ut for the 63 new claims, there would be no need for the 44-page Attachment C ... which is entirely directed to analyzing the new claims, casus[ing] Third Party Requester's

Response to exceed 50 pages.”² Requester also asserts that “[i]n light of the multiplicity of the new claims, the numerous Patent Owner’s arguments regarding the cited prior art, alleged commercial success, alleged copying, and other allegations of secondary considerations of non-obviousness, and the various points raised in the four Rule 132 Declarations, Third Party Requester was unable to fully address all 63 new claims as well as each and every one of the arguments and points raised by the Patent Owner’s Response and still comply with the 50 page limit.”³ Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages.

A. Analysis and Findings

To obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response submission or a requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response submission or a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

While requester’s April 18, 2011 comments submission, responsive to the April 1, 2011 notice of defective paper, is fewer pages than requester’s original March 24, 2011 comments submission, requester has merely modified the margins and font size to reduce the number of pages of the April 18, 2011 comments submission. In doing so, however, requester has filed a comments submission (including the remarks portion, Attachment A and B declarations under 37 CFR 1.132, and Attachment C claim chart) that does not satisfy the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) as the reduced font size does not have sufficient clarity. Accordingly, requester’s April 18, 2011 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is dismissed.

It is noted that one of requester’s options for responding to the April 1, 2011 notice of defective paper included re-submitting its March 24, 2011 comments submission with a grantable petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for the pages in excess of 50, as the

² Third party requester petition under 37 CFR 1.183 at page 3.

³ *Id.*

March 24, 2011 comments submission appears to have satisfied the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b).⁴ Requester is hereby given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines set forth herein and the content of which includes no new content relative to the April 18, 2011 comments submission;⁵ otherwise, requester's April 18, 2011 comments submission will be deemed defective as not being page-length compliant and will not be considered. In the event requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

B. Additional Discussion

It is pointed out that, in the event requester files a renewed petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.943(b), concurrently with a comments submission that complies with the formatting guidelines set forth herein, as well as the other requirements governing comments by third party requester (*e.g.*, 37 CFR 1.947),⁶ and the content of which includes no new content relative to the April 18, 2011 comments submission, such renewed petition would be grantable. In this instance, the specific facts set forth in requester's April 18, 2011 petition under 37 CFR 1.183, requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, which are in excess of 50 pages, and the individual facts and circumstances of this case, such as patent owner's addition of 63 new claims, demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b).

III. Patent Owner Opposition Paper of April 20, 2011

On April 20, 2011, patent owner filed the instant opposition paper in response to the April 18, 2011 third party requester petition under 37 CFR 1.183, requesting that the requester's page-length waiver petition be denied and also that the requester's April 18, 2011 comments submission be expunged from the record as containing improper comments under 37 CFR 1.947.

Patent owner's April 20, 2011 opposition paper is improper under 37 CFR 1.4(c), as two different forms of relief are being requested in a single paper. In this instance, patent owner's request to expunge requester's April 18, 2011 comments submission as containing improper comments under 37 CFR 1.947 is properly filed as a petition under 37 CFR 1.181, challenging

⁴ It is noted that the Appendix C claim chart, which was originally provided in landscape orientation in the March 24, 2011 comments submission, also satisfies the formatting guidelines set forth above.

⁵ It is noted that should requester decide not to pursue certain arguments that were previously presented, requester may redact such arguments from the comments submission. The requester should identify any such redactions if a renewed petition under 37 CFR 1.183 is filed.

⁶ 37 CFR 1.947 provides in-part that requester comments be limited to issues raised by the Office action or the patent owner's response. It is noted that justice would not require waiver of 37 CFR 1.943(b) to exceed the regulatory page limit for a requester comments submission that includes remarks which are beyond the scope permissible under 37 CFR 1.947. The Central Reexamination Unit determines whether the content of a requester comments submission is proper.

the action of the Central Reexamination Unit in entering an allegedly improper paper into the file of the '1417 proceeding.

Moreover, patent owner's opposition to the third party requester's petition under 37 CFR 1.183 for waiver of the page limit requirements of 37 CFR 1.943(b) is an improper paper in the '1417 proceeding, because it is not provided for in the reexamination statute, regulations or practice. 35 U.S.C. 314(a) governs the conduct of *inter partes* reexamination proceedings and provides that reexamination shall be conducted according to the procedures established for initial examination of the original patent (*i.e.*, under the provisions of 35 U.S.C. 132 and 133), which do not provide a right to contest another party's request for relief in a matter of equity and of the Office's discretion. Thus, patent owner's opposition to the Office's exercise of its discretion with respect to waiver of the regulatory page limit for third party requester's comments submission is an improper paper in the '1417 proceeding. *See* 76 Fed. Reg. 22854, 22858 (April 25, 2011), stating that an opposition to a petition under 37 CFR 1.183 to waive page length requirement or word count may not be filed.

Accordingly, patent owner's April 20, 2011 opposition paper is an improper paper, and it will not be made of record in the file of the '1417 proceeding. Because patent owner's April 20, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '1417 proceeding. *See* MPEP 2267. No copy of the April 20, 2011 opposition paper will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the '1417 proceeding.

IV. Third Party Requester May 10, 2011 Response to Patent Owner Opposition Paper

On May 10, 2011, third party requester filed the instant opposition paper in response to patent owner's April 20, 2011 opposition paper. Third party requester's May 10, 2011 opposition paper is an improper paper in the '1417 proceeding. After an opposition to a third party requester petition is filed by a patent owner (regardless of whether such opposition has an entry right or not) any further paper in opposition, rebuttal or response to the patent owner opposition paper is improper and will not be considered, as there is a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination. *See* MPEP 2667(I)(B)(4). There is no indication anywhere in the reexamination statute, or its legislative history, nor in the case law, that multiple iterations of input in petitionable matters prior to decision on the base petition was ever contemplated as an exception to the statutory mandate for special dispatch in reexamination.

In view of the above, third party requester's May 10, 2011 opposition paper is an improper paper, and it will not be made of record in the file of the '1417 proceeding. Because requester's May 10, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '1417 proceeding. *See* MPEP 2267. No copy of the May 10, 2011 opposition paper will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the '1417 proceeding.

CONCLUSION

1. Third party requester's April 18, 2011 petition under 37 CFR 1.183 for waiver of the regulatory page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission is dismissed.
2. Third party requester is given a time period of **fifteen (15) days from the mailing date of this decision** to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines set forth herein and the content of which includes no new arguments relative to the April 18, 2011 comments submission as set forth in Section II(A) of this decision; otherwise, requester's April 18, 2011 comments submission will be deemed defective as not being page-length compliant and will not be considered.
3. Patent owner's April 20, 2011 opposition paper is an improper paper in the '1417 proceeding. Because the patent owner's April 20, 2011 opposition paper was previously incorporated into the IFW of the '1417 proceeding, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1417 proceeding.
4. Third party requester's May 10, 2011 response to patent owner's opposition paper is an improper paper in the '1417 proceeding. Because the third party requester's May 10, 2011 opposition paper was previously incorporated into the IFW of the '1417 proceeding, the paper is being expunged from the record by marking it "closed" and "non-public" in the IFW of the '1417 proceeding.
5. No copies of the patent owner's April 20, 2011 paper and the third party requester's May 10, 2011 opposition papers will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the '1417 proceeding.
6. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-30-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,417	08/16/2010	7244519	I095 7000	3598
25074	7590	08/16/2011		
ALLEGHENY TECHNOLOGIES 1000 SIX PPG PLACE PITTSBURGH, PA 15222				
			EXAMINER	
			ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,417	08/16/2010	7244519	1095 7000

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EXAMINER

DIAMOND, ALAN

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EXAMINER

DIAMOND, ALAN

ART UNIT	PAPER
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AUG 16 2011

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CENTRAL REEXAMINATION UN

In re Festeau et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,417
Filed: August 16, 2010
For: U.S. Patent No. 7,244,519

:
: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on the third party requester paper entitled "THIRD PARTY REQUESTER'S RENEWED PETITION UNDER 37 CFR 1.183 TO SUSPEND THE RULES AND WAIVE PAGE LIMIT REQUIREMENT OF 37 CFR 1.943(b)" (the renewed petition under 37 CFR 1.183), filed on July 12, 2011.

The renewed petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted for the reasons set forth herein.

DECISION

On July 1, 2011, the Office mailed a decision dismissing third party requester's April 18, 2011 petition under 37 CFR 1.183. The July 1, 2011 decision states on page 5:

While requester's April 18, 2011 comments submission, responsive to the April 1, 2011 notice of defective paper, is fewer pages than requester's original March 24, 2011 comments submission, requester has merely modified the margins and font size to reduce the number of pages of the April 18, 2011 comments submission. In doing so, however, requester has filed a comments submission (including the remarks portion, Attachment A and B declarations under 37 CFR 1.132, and Attachment C claim chart) that does not satisfy the formatting guidelines set forth above for a grantable petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) as the reduced font size does not have sufficient clarity.

The July 1, 2011 decision set a time period of 15 days from the mailing date of the decision for requester to file a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) with a comments submission that complies with the formatting guidelines set forth on page 4 of the decision.¹

On July 12, 2011, requester filed the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for requester's concurrently-filed comments submission.² Requester's July 12, 2011 comments submission is identical to requester's original March 24, 2011 comments submission. Requester states that "[t]he extraordinary circumstances warranting waiver of the Rules to permit a Third Party Requester's Response that exceeds the page limit were set forth in the Original Petition of April 18, 2011 and are incorporated by reference herein."³

Third party requester's July 12, 2011 comments submission includes: the 32-pages of remarks, the 14-page "Attachment A" declaration of Kenneth J.A. Brooks (the Brooks declaration), the 26-page "Attachment B" declaration of Dennis Quinto, Ph.D. (the Quinto declaration), the 60-page "Attachment C" claim chart with analysis, and "Attachments D-M" reference materials, as originally filed on March 24, 2011. The portions of requester's July 12, 2011 comments submission that count toward the regulatory page limit satisfy the formatting guidelines set forth on page 4 of the July 1, 2011 decision and exceed the regulatory page limit by up to 82 pages.⁴

For the reasons previously set forth on page 5 of the July 1, 2011 decision, the individual facts and circumstances of this case demonstrate an extraordinary situation in which justice requires suspension of the 50-page limit of 37 CFR 1.943(b) for requester's July 12, 2011 comments submission. Accordingly, requester's July 12, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's July 12, 2011 comments submission to exceed the regulatory page limit by up to 82 pages for the reasons set forth in the decision of July 1, 2011. **This waiver makes third party requester's July 12, 2011 comments submission page-length compliant.**

CONCLUSION

1. Third party requester's July 12, 2011 renewed petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's July 12, 2011 comments submission to exceed the regulatory page limit by up to 82 pages. **This waiver makes requester's July 12, 2011 comments submission page-length compliant.**

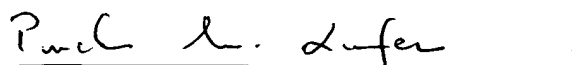
¹ July 1, 2011 decision at page 5.

² See the renewed petition under 37 CFR 1.183 at page 2.

³ Id.

⁴ As set forth in paragraph 6 of the April 1, 2011 notice of defective paper, the Central Reexamination Unit determined that the pages of requester's original March 24, 2011 comments submission that are included in the regulatory page count are the 32 pages of comments, up to 14 pages of the Brooks declaration and up to 26 pages of the Quinto declaration, and the 60 pages of the claim chart with analysis.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

08-16-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,420	08/18/2010	6163816	32268.0006	7275

93143 7590 06/16/2011
Herskovitz & Associates, LLC
2845 Duke Street
Alexandria, VA 22314

EXAMINER

NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
06/16/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.


The time period for reply, if any, is set in the attached communication.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,420

1. THIS IS A DECISION ON THE PETITION FILED June 14, 2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for filing a respondent brief be extended.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☒ Other: electronically submitted with petition.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____
 - B. ☒ Denied because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☒ Other/comment: 37 CFR 41.66(b) does not permit extensions of time to file a respondent brief.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.


[Signature]

ERIC S. KEASEL
CRU SPE-AU 3992

(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,420	08/18/2010	6163816	32268.0006	7275
93143	7590	06/30/2011	EXAMINER	
Herskovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PERKINS COIE LLP
P.O. BOX 1247
SEATTLE, WASHINGTON 98111-1247

Date: **MAILED**

JUN 30 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001420
PATENT NO. : 6163816
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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2845 Duke Street
Alexandria VA 22314

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JUN 30 2011

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

HOGAN LOVELLS US LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

In re: Anderson et alia
Reexamination Proceeding
Control No. 95/001,420
Request Deposited: August 18, 2010
For: U.S. Patent No. 6,496,776

:
: **DECISION**
: **GRANTING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the June 14, 2011 patent owner paper entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.181 TO EXPUNGE ONE OF THE THIRD PARTY REQUESTER'S TWO APPEAL BRIEFS".

A review of the record reveals that third-party requester (3PR) filed two separate appeal briefs on June 1, 2011.

37 CFR 41.67 states, in part:

Appellant(s) may once, within time limits for filing set forth in § 41.66, file a brief and serve the brief on all other parties to the proceeding in accordance with § 1.903 of this title.

Art Unit: 3992

37 CFR 1.943(c) states:

Appellant's briefs filed by the patent owner and the third party requester shall not exceed thirty pages or 14,000 words in length, excluding appendices of claims and reference materials such as prior art references. All other briefs filed by any party shall not exceed fifteen pages in length or 7,000 words. If the page limit for any brief is exceeded, a certificate is required stating the number of words contained in the brief.

The first submission of June 1, 2011 was filed via efs and included a 39-page appeal brief file (brief.pdf). It appears that 31 pages would count against the 30-page limit set forth in 37 CFR 1.943(c). Although, it should be noted, that the Office has not done a complete review for appeal brief compliance.

The second efs submission of June 1, 2011 included a 37-page appeal brief file (also titled brief.pdf) of which 29 pages appear to count against the 30-page limit set forth in 37 CFR 1.943(c). The second efs submission will remain in the file pending a complete review for compliance.

Petitioner's request to expunge one of the two appeal briefs is granted.

The first submission is being expunged from the file. Since this proceeding is not a paper file, the first paper submitted on June 1, 2011 is being "closed" from public view (while the MPEP permits for the return of inappropriate or untimely submissions, this may not be possible in an Image File Wrapper (IFW) proceeding where a paper has been entered into the record. Instead, such a paper would be marked "closed" and "not public").

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel

SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,425	08/26/2010	7409428	45906.4	7688
59081	7590	09/13/2011	EXAMINER	
KING & SPALDING, LLP 1100 LOUISIANA ST., STE. 4000 ATTN.: IP Docketing HOUSTON, TX 77002-5213			ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 9-13-11

David L. McCombs
HAYNES & BOONE, LLP, IP SECTION
2323 Victory Ave., Suite 700
Dallas, TX 75219

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001425
PATENT NO. : 7409428
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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King & Spalding, LLP
1100 Louisiana Street, Suite 4000
Attn: IP Docketing
Houston, TX 77002-5213

SEP 13 2011 (For Patent Owner)

CENTRAL REEXAMINATION UNIT

Hayes and Boone, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

(For Third Party Requester)

In re Brabec et al.

Inter partes Reexamination Proceeding

Control No: 95/001,425

Filing Date: August 26, 2010

For: U.S. Patent No.: 7,409,428

:
:
:
:
:

DECISION DISMISSING

PETITION TO

TERMINATE *INTER PARTES*

REEXAMINATION PROCEEDING

This decision addresses:

- Patent owner's August 5, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(B) and 37 CFR § 1.907(B)", which is taken as a petition under 37 CFR 1.182 to terminate the present reexamination proceeding (patent owner's August 5, 2011 petition to terminate);
- Requesters' August 19, 2011 opposition paper entitled "Petition under 37 C.F.R. § 1.183 for Consideration of Third Party Requester Response" and
- Requesters' August 19, 2011 opposition paper entitled "Petition under 37 C.F.R. § 1.182 to Oppose Patent Owner's Petition for Termination".

Patent owner's August 5, 2011 petition to terminate, requesters' August 19, 2011 opposition papers, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent Owner's August 5, 2011 petition, which is taken as a petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding, is **dismissed**.

Requesters' August 19, 2011 opposition papers are granted to the extent that they have been made of record and considered in this decision.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,425 (the ‘1425 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester(s) of the present reexamination proceeding are/were parties to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requesters/parties had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

Four third party requesters, Everbridge Inc., Federal Signal, Corp., Rave Wireless, Inc., and Twitter, Inc., who are the real parties in interest, jointly filed the request for *inter partes* reexamination in the present proceeding. The patent owner informs the Office that the patent under reexamination, U.S. Patent No. 7,409,428 (the ‘428 patent), was the subject of a civil action in district court, i.e., *Cooper Notification, Inc., v. Twitter, Inc. et al*, Civil Action No. 09-865-LPS (D. Del.) (hereinafter, “the litigation”). All four third party requesters of the present proceeding are co-defendants in the litigation. Thus, element 1 has been shown to be satisfied.

Regarding element 2, the patent owner submits a copy of a stipulated order of dismissal, entered by the district court on June 27, 2011, in which the district court stated that one of the third party requesters and real parties in interest, Rave Wireless, Inc., “consents to the validity and enforceability of U.S. Patent No. 7,409,428”, that the patent owner, Cooper Notification Inc., “and Rave stipulate that Rave’s counterclaims against Cooper are dismissed with prejudice”, and that “Cooper’s complaint against Rave is dismissed with prejudice”. While this evidence may be sufficient to show that the district court’s decision is final with respect to one of the requesters/co-defendants, Rave Wireless, this evidence does not show that the district court’s decision is final with respect to the other three requesters/co-defendants. In fact, the fact that the court specifies that the patent owner Cooper’s complaint against Rave, and that Rave’s counterclaims against the patent owner Cooper, are dismissed with prejudice, shows that the

court's decision does not apply, and has no effect, on the on-going litigation involving the remaining three requesters.¹

The patent owner argues that because the requesters/co-defendants have chosen to act jointly, that "the action of one binds the joint group". The patent owner urges that because all four requesters jointly filed the request for reexamination in the present proceeding, jointly identified themselves as the real parties in interest, and jointly certified that the estoppel provisions of 37 CFR 1.907 do not prohibit the reexamination, that a decision against only one of them is final as to the other three for the purpose of satisfying the provisions of 35 U.S.C. 317(b).

However, the fact that the third party requesters/co-defendants, as a group, did not settle the litigation, and the fact that the district court's decision does not bind the other requesters/co-defendants in the litigation, shows that the four third party requesters/co-defendants do not act jointly in the litigation, and are not "in privity", within the meaning of 35 U.S.C. 317(b). Furthermore, the patent owner is apparently continuing to pursue the above-identified litigation against the remaining three requesters/co-defendants, even after the district court's order dismissing Rave Wireless.² Thus, patent owner's decision to continue the litigation against the other three requesters/co-defendants provides evidence that the requesters/co-defendants are separate entities, and that the district court's decision, which is final with respect to only one of the requesters/co-defendants, is not "final" with respect to the other three requesters/co-defendants, and thus is not a "final" decision within the meaning of 35 U.S.C. 317(b).

Furthermore, if the Office were to grant such a petition, and terminate the reexamination proceeding based on a decision involving only one of four requesters, then any patent owner can, in the future, make a settlement agreement that is specifically favorable to only one of several requesters, to the detriment of the remaining requesters. Thus, in the interests of fundamental fairness to all parties of the proceeding, including each of the third party requesters, the district court's decision is not deemed to be "final" with respect to the remaining three third party requesters/co-defendants.³

For the reasons given above, element 2 has not been shown to be satisfied.

Because the Office has determined that the district court's decision is not final with respect to all four of the requesters/co-defendants, this decision need not address the remaining two elements, i.e., elements 3 and 4.

¹ Furthermore, requesters' August 19, 2011 opposition paper states that the remaining three requesters/co-defendants Everbridge, Federal Signal, and Twitter, remain active in the litigation.

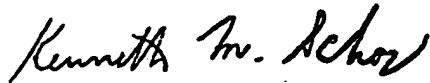
² See page 5 of requesters' August 19, 2011 opposition paper.

³ Also note that Congress, in § 317(a) of H.R. 1249, designated as the "America Invents Act", specifies that the estoppel provisions set forth for *inter partes* review do not attach to one of several joint petitioners, if the one petitioner, and the patent owner, jointly request for termination; however, the Office may only terminate the *inter partes* review itself "if no petitioner remains in the inter partes review". The fact that Congress specified that *inter partes* review would not be terminated if only one of several joint petitioners request termination, and when other joint petitioners remain active in the proceeding, provides evidence that Congress also does not believe that the action of only one of several joint requesters, *per se*, should "bind the group", and does not believe that a district court decision involving only one of three joint requesters is "final" with respect to the remaining joint requesters, within the meaning of 35 U.S.C. 317(b).

Accordingly, the August 5, 2011 patent owner petition under 37 CFR 1.182 to terminate an *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- The August 5, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

9-09-2011
Kenpet8



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,428	08/27/2010	7255344	056697/386354	9265

75035 7590 03/08/2011

Mark A> Litman and Associates, P.A.
York Business Center
3209 w. 76th Street
Suite 205
Edina, MN 55435

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 03/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ALSTON & BIRD LLP

BANK OF AMERICA PLAZA

101 SOUTH TRYON STREET, SUITE 4000

CHARLOTTE, NC 28280-4000

MAILED

MAR 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001428

PATENT NO. : 7255344

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Mark A. Litman and Associates, P.A.
York Business Center
3209 w. 76th Street
Suite 205
Edina, MN 55435

(For Patent Owner)

MAR 08 2011

CENTRAL REEXAMINATION UNIT

Alston & Bird LLP
Bank of America Plaza
101 South Tryton Street, Suite 4000
Charlotte, NC 28280-4000

(For Third Party Requester)

In re Grauzer et al.
Reexamination Proceeding
Control No.: 95/001,428
Filing Date: August 27, 2010
For: U.S. Patent No.: 7,255,344

:
: DECISION
: DISMISSING
: PETITION
:

The above reexamination proceeding is before the Director of Technology Center 1600, who oversees the Central Reexamination Unit, after receipt of a February 1, 2011 third party requester petition, entitled "Petition under 37 C.F.R. § 1.182 to Deny Entry of Patent Owner's Supplemental Response" requesting that the patent owner's papers of January 28, 2011 not be entered into the proceeding record. This petition is being treated as a petition under 37 CFR 1.181 invoking supervisory review.

The third party requester's petition is dismissed as moot.

BACKGROUND

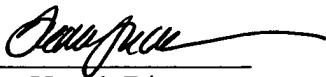
1. U.S. Patent No. 7,255,344 [hereinafter “the ‘344 patent”] was granted to *Grauzer et al.* on August 14, 2007.
2. On August 27, 2010, a request for *inter partes* reexamination of the '344 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,428 (the ' 1428 proceeding).
3. On September 28, 2010, the Office issued an order granting *inter partes* reexamination in the ' 1428 proceeding, with an accompanying Office action.
4. On November 29, 2010, patent owner filed a response to the Office action.
5. On December 28, 2010, the third party requester filed comments.
6. On January 28, 2011, patent owner filed a supplemental response.
7. On February 1, 2011, the third party requester filed the instant petition requesting that the patent owner's supplemental response of January 28, 2011 not be entered into the proceeding record.
8. On February 14, 2011, the Office mailed an action that denied entry of patent owner's supplemental response of January 28, 2011.

DECISION

As pointed out, the third party requester filed a February 1, 2011 petition, which is a petition requesting that the patent owner's papers of January 28, 2011 not be entered into the proceeding record. On February 14, 2011, the Office mailed an action that denied entry of patent owner's supplemental response of January 28, 2011 and indicated that the January 28, 2011 papers will be closed from the proceeding record. See pages 2-3 of the February 14, 2011 Office action. Therefore, the relief requested by the February 1, 2011 petition has already been given by the February 14, 2011 Office action. Thus, the third party requester's February 1, 2011 petition is moot, and hereby, dismissed.

CONCLUSION

1. The February 1, 2011 third party requester's petition is dismissed as moot.
2. Telephone inquiries related to this decision should be directed Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,429	08/27/2010	6588751	056697/386355	9333
75035	7590	07/22/2011	EXAMINER	
Mark A Litman and Associates, P.A. York Business Center 3209 w. 76th Street Suite 205 Edina, MN 55435			ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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CHARLOTTE, NC 28280-4000

Date: **MAILED**

JUL 22 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001429
PATENT NO. : 6588751
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

JUL 22 2011

CENTRAL REEXAMINATION UNIT

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

(For Requester)

In re Grauzer et al.

Reexamination Proceeding

Control No.: 95/001,429

Filed: August 27, 2010

For: U.S. Patent No.: 6,588,751

**DECISION ON PETITION
UNDER 37 CFR 1.181**

This is a decision on a petition filed by the third party requester on July 6, 2011, which is requesting reconsideration of the decision mailed August 21, 2009. The petition is entitled "PETITION UNDER 37 CFR § 1.181 TO REQUEST REVIEW OF EXAMINER'S REFUSAL TO FULLY CONSIDER A CITED REFERENCE" [hereinafter "the petition"], and is a request to the director to exercise her discretion pursuant to 37 CFR 1.181 and review the June 15, 2011 Action Closing Prosecution (ACP).

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The petition under 37 CFR 1.181 is denied, for the reasons set forth herein.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,588,751 (hereinafter, the '751 patent) issued on July 8, 2003.
2. A request for *inter partes* reexamination, assigned control No. 95/001,429, was filed by a third party requester on August 27, 2010. The request for reexamination included a statement of a substantial new question of patentability (SNQ) and a detailed explanation for how U.S. Patent No. 4,832,342 to Plevyak et al. (hereinafter "Plevyak") anticipated claims 2, 3, 8-11, and 13-15 of the '751 patent and for how Plevyak in view of U.S. Patent No. 6,039,650 to Hill (hereinafter "Hill") rendered obvious claims 1, 4-7, and 17, along with other SNQs and proposed rejections based on other references.
3. *Inter partes* reexamination was ordered for the '429 reexamination proceeding on November 10, 2010. The order determined that Plevyak raised SNQs with respect to claims 2, 3, 4, and 8-16 and Plevyak in view of Hill raised SNQs with respect to claims 1, 4-7, and 17 of the '751 patent. See pages 6-8 of the order. On the same day, a non-final Office action was mailed in the '429 reexamination proceeding. This Office action did not adopt the proposed obvious rejection for claims 1, 4-7 and 17 based on Plevyak in view of Hill and the proposed anticipation rejection for claims 14 and 15 based on Plevyak, but did adopt the proposed anticipation rejection for claims 2, 3, 8-11 and 13 based on Plevyak. See pages 3, 7-8, and 10-11 of the Office action.
4. The patent owner filed a response to the non-final Office action on January 10, 2011. The response included amendments to claims 8-10.
5. On February 2, 2011, a notice of informal amendment was sent to patent owner regarding the January 10, 2011 amendment.
6. The third party filed comments on February 4, 2011 to the patent owner's response, which included comments regarding the examiner's decision to not adopt the proposed anticipation rejection of claims 14 and 15 based on Plevyak and the proposed obviousness rejection based on Plevyak and Hill. See, e.g., pages 2-4 and 7-11 of the comments.
7. On February 24, 2011, patent owner filed a response to the notice of informal amendment.
8. On March 11, 2011, the Office mailed a second non-final Office action that was responsive to the papers filed January 10, 2011, February 4, 2011, and February 24, 2011.

The Office action maintained the non adoption of the proposed obviousness rejection for claims 1, 4-7 and 17 based on Plevyak in view of Hill, but now adopted the proposed anticipation rejection for claims 14 and 15 based on Plevyak. See pages 2, 8-9, and 29-32 of the Office action. The examiner determined that claims 1, 4, 5-7, and 17 contain patentable subject matter. See pages 33-35 of the Office action.

9. On April 11, 2011, the patent owner filed a response to the second Office action, which included proposed amendments to claims 2, 4, 8, cancelled claim 3, and proposed new claims 18-20.
10. On May 11, 2011, the third party requester filed comments on the April 11, 2011 patent owner's response, which continued to argue the decision to not adopt the proposed obviousness rejection based on Plevyak in view of Hill. See pages 6-13 of the comments. The comments also introduced, for the first time, proposed anticipation rejections based on Plevyak for claims 1, 4-7, and 17. See pages 7-8 of the comments.
11. On June 15, 2011, the Office issued an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments. The ACP maintained the anticipation rejection based on Plevyak for claim 2 and the non adoption of the proposed obvious rejection for claims 1, 4-7 and 17, as set forth in the previous two Office actions. The ACP also addressed the newly proposed anticipation rejection based on Plevyak by stating that the proposed rejection is not responsive to issues raised in the Office actions or in the patent owner's responses, and therefore, is improperly raised. See pages 36-38 of the Office action. The examiner maintained the determination that claims 1, 4, 5-7, and 17 contain patentable subject matter. See pages 38-40 of the ACP.
12. On July 6, 2011, the third party requester filed the instant petition under 37 CFR 1.181 requesting review of the examiner's decision to not consider the proposed anticipation rejection based on Plevyak for claims 1, 4-7, and 17.
13. On July 14, 2011, patent owner filed remarks in response to the ACP.

DECISION

In the July 6, 2011 petition, the third party requester (petitioner) states that the requester is seeking the director's review under 37 CFR 1.181 of the examiner's decision to not consider the "Requester's changed viewpoint on Plevyak" and the newly proposed anticipation of claims 1, 4-

7, and 17, and the examiner's continued refusal to adopt the fifth ground of rejection. See page 5 of the July 6, 2011 petition.

Legal Authority Citations:

37 CFR 1.181 states, in part:

(a) Petition may be taken to the Director:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
- (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2666.05 states, in part:

Third party requester comments are limited to issues covered by the Office action or the patent owner's response. New prior art can be submitted with the comments **only** where the prior art (A) is necessary to rebut a finding of fact by the examiner, (B) is necessary to rebut a response of the patent owner, or (C) for the first time became known or available to the third party requester after the filing of the request for *inter partes* reexamination.

As to item (A) above, 37 CFR 1.948(a)(1) permits the requester to provide new prior art rebutting the examiner's interpretation/finding of what the art of record shows. However, a statement in an Office action that a particular claimed feature is not shown by the prior art of record (which includes references that were cited by requester) does NOT permit the requester to then cite new art to replace the art originally advanced by requester. Such a substitution of a new art for the art of record is not a rebuttal of the examiner's finding that a feature in question is not taught by the art of record. Rather, such a substitution would amount to a rebuttal of a finding that a feature in question is not taught by any art in existence. A finding that the feature in question is not taught by any art in existence could not realistically be made for the reexamination proceeding, since the proceeding does not include a comprehensive validity search, and such was not envisioned by Congress as evidenced by the 35

U.S.C. 314(c) mandate that reexamination proceedings are to be conducted in the Office with special dispatch.

As to item (B) above, 37 CFR 1.948(a)(2) permits the requester to provide a new proposed rejection, where such new proposed rejection is necessitated by patent owner's amendment of the claims.

As to item (C) above, prior art submitted under 37 CFR 1.948(a)(3) must be accompanied by a statement that explains the circumstances as to when the prior art first became known or available to the third party requester, including the date and manner that the art became known or available, and why it was not available earlier. The submission must also include a discussion of the pertinency of each reference to the patentability of at least one claim.

As to items (A) - (C) above where a newly proposed rejection is based on the newly presented prior patents and printed publications (art), the third party requester must present the newly proposed rejection in compliance with the guidelines set forth in MPEP § 2617, since any such new proposed rejection stands on the same footing as a proposed rejection presented with the request for reexamination, and is treated the same way as to future Office actions and any appeal. See MPEP § 2617 as to the required discussion of the pertinency of each reference to the patentability of at least one claim presented for the newly submitted prior art. An explanation pursuant to the requirements of 35 U.S.C. 311 of how the art is applied is no less important at this stage of the prosecution, than it is when filing the request.

Where the third party requester written comments are directed to matters other than issues and points covered by the Office action or the patent owner's response, or where the prior art submitted with the comments does not satisfy at least one of (A) - (C) above, the written comments are improper.

Analysis:

Turning to the facts in this proceeding, the proposed anticipation rejection based on Plevyak for claims 1, 4-7, and 17 was not included in the request for reexamination, as explained in further detail below. Instead, this proposed anticipation rejection was not mentioned until the third party requester comments submitted after the second Office action on the merits.

In the petition, petitioner states two grounds in which the petitioner believes the examiner's decision to not consider requester's "changed viewpoint" to be in error. The first ground pertains to the Office's duty to provide a thorough and complete examination in *inter partes* reexamination. The second ground states that there is no authority to preclude consideration of a changed viewpoint regarding the teachings of a reference. Each ground will be addressed below.

Ground 1:

In the petition, the petitioner states that the Office and the examiner have a duty to provide a thorough determination of patentability, which mandates that the examiner consider the requester's new viewpoint on the Plevyak reference. See pages 7-8 of the petition. In

response, the director finds nothing in the record supporting petitioner's allegation that a thorough examination, in accordance with 37 CFR 1.104, has not been performed. The petitioner attempts to shift the burden to the Office by stating that the examiner had a duty to explicitly consider their changed viewpoint on Plevyak on the record under 37 CFR 1.104. It is noted, however, that *inter partes* reexamination laws and policies clearly require the requester to set forth all the proposed rejections by supplying the manner and pertinency of applying the references to the claims for which reexamination is requested, with limited exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve "special dispatch" required in reexamination proceedings. 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings be acted upon with "special dispatch."

The order granting reexamination found that Hill raised the SNQ (the new technical teaching) for claims 1, 4-7, and 17, which is the basis for granting reexamination for these claims. See page 6 of the order. In other words, the request did not assert nor did the examiner determine that Plevyak alone raised a SNQ for claims 1, 4-7, and 17. Therefore, the record shows that this proceeding did not involve a SNQ for claims 1, 4-7, and 17 based on the teachings of Plevyak alone. Accordingly, the proposed anticipation rejection based on Plevyak is not supported by a SNQ determined to be raised, and therefore, is outside the scope of this reexamination proceeding.

The record clearly shows that the examiner considered all the proposed rejections set forth in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination and provided an Office action which either adopted or not adopted these proposed rejections. All the Office actions articulated reasons for both the adoption and lack of adoption of the proposed rejections, which were appropriately set forth under 37 CFR 1.915, 37 CFR 1.947, or 37 CFR 1.948. See the Office actions dated November 10, 2010, March 11, 2011 and June 15, 2011. In addition, the record also shows that there is nothing that prevented the requester from presenting this new viewpoint on Plevyak and the newly proposed anticipation rejection based Plevyak in the request for reexamination. The petitioner offers no reasons why their viewpoint on Plevyak has now changed and why it could not have been earlier presented. 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) clearly require that the requester must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. In this case, the petitioner (third party requester) decided to provide the pertinency and manner of applying Plevyak to claims 1, 4-7, and 17 in a proposed obvious rejection in combination with Hill, and not to present the pertinency and manner of applying Plevyak in a proposed anticipation rejection for claims 1, 4-7, and 17 in the request for reexamination.

Furthermore, the record shows that claims 1, 4-7, and 17 have been determined to be patentable over the prior art of record. The Office actions contain explicit reasons why the claimed are deemed patentable over the art of record. See, e.g., pages 38-40 of the ACP. Neither 37 CFR 1.104 nor *inter partes* reexamination laws and procedures require that examiners must explicitly consider on the record and explain why they are making or not

making every possible rejection that is not set forth in a manner required by 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3). Reexamination laws and policies are clear that examiners are only required to consider whether the claims define a novel and nonobvious invention over the prior art of record in order to answer the issues of patentability raised by the request, and to articulate any grounds of rejection, or reasons for patentability that meets the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), so that the patent owner and the third party requester can understand the grounds and appropriately reply to the Office action. See MPEP 706 and 2660. Therefore, the record does not support petitioner's view that a thorough examination of the claims was not performed unless the examiner explicitly considered on the record requester's changed viewpoint of the Plevyak reference, which did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) in the request for reexamination.

Accordingly, for all these reasons, Ground 1 is not persuasive that the examiner erred in his refusal to consider the requester's new viewpoint on the Plevyak reference.

Ground 2:

The petitioner states that there is no impropriety in changing their viewpoint on the teachings of Plevyak. Petitioner states that the examiner did not state support for his position that the newly proposed rejection is improper. The record shows that examiner did provide support. See pages 36-37, which cited to 37 CFR 1.947 and 1.948 and MPEP 2666.05. For the reasons expressed by the examiner, 37 CFR 1.947 and 1.948 and MPEP 2666.05 authorize the examiner to not consider the new proposed anticipation rejection in the interest of "special dispatch." Furthermore, as explained above in regard to Ground 1, the request for reexamination did not raise the issue of anticipation by Plevyak of claims 1, 4-7 and 17 because the request failed to provide the detailed explanation in compliance with 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3) for the proposed anticipation rejection. In addition, as explained above in regard to Ground 1, the record does not support petitioner's view that a thorough examination of the claims was not performed because the examiner did not explicitly consider on the record the requester's new viewpoint on the teachings of Plevyak. The examiner has the discretion to not consider the proposed anticipation rejection because it did not meet the requirements of 35 U.S.C. 311(b)(2) and 37 CFR 1.915(b)(3), 1.947 and 1.948.

In the petition, the third party requester states that their changed view point is akin to examiners changing their view point during examination. The petitioner cites to Board of Patent Appeals and Interferences (BPAI) decisions from examination of applications. Isolated quotations from non-precedential BPAI decisions with no explanation as to why the facts of this proceeding align with the facts of the other proceedings are not persuasive. The examination of applications and reexamination proceedings involve different laws and policies. For example, there is no requirement to establish a SNQ in the examination in an

application. As discussed above, a SNQ must be established in order to confer jurisdiction to the Office for the reexamination proceeding and established SNQs determine the scope of the reexamination proceeding. Also, there is no statutory requirement for special dispatch in the examination of applications. While examiners may be permitted to change positions (e.g., when the examiner realizes that an error was made), such a change in position typically results in delays in the examination process. However, in this proceeding, the examiner has not stated that his determination that claims 1, 4-7, and 17 are patentable is in error. To the contrary, the examiner has maintained his determination of the patentability of claims 1, 4-7, and 17. The fact that petitioner does not agree with the examiner's determination is not grounds for vacating the ACP, which would result in delay in the reexamination proceedings. As stated above, *inter partes* reexamination laws and policies clearly require the requester to set forth all the proposed rejections by supplying the manner and pertinency of applying the references to the claims for which reexamination is requested, with limited exceptions as prescribed in 37 CFR 1.947 and 1.948, in order to achieve "special dispatch" required in reexamination proceedings.

Refusal to Adopt the Fifth Ground of Rejection – original or "modified"

Petitioner states that the examiner's continued refusal to adopt the fifth ground of rejection (the proposed obviousness rejection based on Plevyak in view of Hill), in light of the changed viewpoint, is in error.

This ground is challenging the substance of the examiner's determination to not adopt a proposed rejection, which is an issue that is appealable, and therefore will not be addressed in this petition. See MPEP 1002 and 1201. Specifically, MPEP 1202 states "[t]he line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board."

Petitioner also seems to be arguing that the proposed obviousness rejection (Ground 5 in the request) is supported by their newly proposed anticipation rejection based on Plevyak alone, or that the newly proposed anticipation rejection is just a "modified" Ground 5 of rejection. The analysis performed in determining a *prima facie* case of anticipation, however, is clearly different from the analysis performed in determining a *prima facie* case of obviousness. For evidence, see MPEP 706.02(a), 706.02(f) et seq., and 2131 to 2136 et seq. for policies regarding anticipation rejections and MPEP 706.02(l) et seq., and 2141 to 2144 et seq. for policies regarding obviousness rejections. Therefore, it cannot be said that the new proposed anticipation rejection based on Plevyak is responsive to the lack of the adoption of the proposed obviousness rejection over Plevyak in view of Hill for claims 1, 4-7 and 17. The requester's appropriate response to the lack of the adoption of the proposed obviousness rejection is to argue and present evidence why the examiner's viewpoint on the combined

teachings is incorrect. The requester presented such arguments in their comments. See, e.g., pages 7-11 in the February 4, 2011 comments and 9-13 of the April 11, 2011 comments. Accordingly, the requester was able present their comments in response to the lack of the adoption of the proposed obviousness rejection without the new proposed anticipation rejection, and nothing more is authorized by 37 CFR 1.947 and 1.948. Therefore, the new proposed anticipation rejection of claims 1, 4-7 and 17 over Plevyak is not limited to issues raised by the patent owner or the Office action. Accordingly, the new proposed anticipation rejection is not authorized by 37 CFR 1.947 and 1.948, and the examiner did not err in not considering this new proposed rejection.

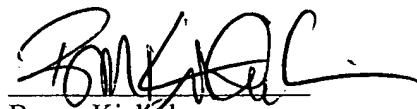
As explained in regard to Ground 1 above, the requester did not set forth a proposed anticipation rejection of claims 1, 4-7 and 17 based on Plevyak in the request for reexamination. Therefore, to allow a requester to set forth additional proposed rejections only after the examiner determines that they did not meet their burden in establishing a *prima facie* case of unpatentability for certain proposed rejections would lengthen reexamination proceedings, which is clearly against the statutory mandate of “special dispatch.” The particular citation to the Federal Register regarding altering an obviousness rejection to an anticipation rejection is not dispositive for several reasons.¹ One reason is that the petition is not requesting changing the statutory basis for the rejection, as in the Federal Register notice, but instead, is requesting application of a new rejection on claims that were indicated as allowable. By failing to include the proposed anticipation rejection in the request, the requester has no right to demand that the examiner adopt or not adopt the proposed anticipation rejection.

In conclusion, the examiner appropriately denied consideration of the new proposed anticipation rejection of claims 1, 4-7, and 17 over Plevyak in the interest of “special dispatch.” Accordingly, the examiner correctly applied Office policies and procedures in determining that the new proposed anticipation rejection is not appropriately raised. For the reasons set forth above, it is deemed that the examiner properly determined that the new proposed rejections did not have a right of entry and did not abuse his discretion in deciding to not consider the new proposed anticipation rejection. For all the reasons discussed above, the petition is **denied**.

¹ The cited Federal Register notice pertains to what is and is not a new ground of rejection in an examiner’s answer under the BPAI appeal practice. The notice provides different factual scenarios as a guide for determining when a ground of rejection is new. Page 69838-39, subsection 2, discloses another situation that may be equally applicable to the facts in this proceeding. This subsection states that changing the statutory basis of rejection from § 103 to § 102, based on a different teaching (e.g., a changed viewpoint) is a new ground of rejection.

CONCLUSION

1. The petition under 37 CFR 1.181 for review of the examiner's refusal to consider the new proposed anticipation rejection of claims 1, 4-7 and 17 over Plevyak is **denied**.
2. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361.



Bruce Kisluk,

Assistant Deputy Commissioner for Patent Operations and Acting Director,
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,430	09/08/2010	6778979	19473-0036RX1	1480
11580	7590	07/28/2011	EXAMINER	
Schwegman Lundberg & Woessner/Xerox P.O. Box 2938 Minneapolis, MN 55402			ART UNIT	PAPER NUMBER

DATE MAILED: 07/28/2011

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Date:

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JUL 28 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001430
PATENT NO. : 6778979
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED
JUL 28 2011
CENTRAL REEXAMINATION UNIT

FISH & RICHARDSON P.C.
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MINNEAPOLIS, MN 55440-1022

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,430
Filed: September 8, 2010
For: U.S. Patent No. 6,778,979

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION**
:

This is a decision on the May 27, 2011 patent owner petition paper entitled "PETITION PURSUANT TO 37 C.F.R. §§ 1.183 AND 1.943(b) FOR INCREASE OF PAGE LIMIT FOR PATENT OWNER'S RESPONSE." Subsequently, patent owner timely filed its response under 37 CFR 1.945 on June 7, 2011.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in the response by the patent owner is granted to the extent that the page limit for the response by the patent owner is extended to not exceed 65 pages in length.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's

designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Patent Owner Petition Under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner response to the March 7, 2011 non-final Office action, and requests that the page limit be extended to 95 pages.¹ Patent owner timely filed a response to the non-final Office action on June 7, 2011.²

In support of its request for waiver of the rule, patent owner argues that additional pages are needed to address "...the voluminous nature of the pending Office Action and the numerous and complex issues raised therein."³ Specifically patent owner contends that "the present Office Action...presents 14 separate grounds of rejection based on 10 prior art references...and in doing so, expressly incorporates by reference into the rejections at least 112 pages of the Request...plus an additional 155 pages of claim charts."⁴

¹ Petition at page 1.

² The April 14, 2011 Office decision granted patent owner a one-month extension of time to file a response to the March 7, 2011 non-final Office action, extending the due date of the patent owner response to June 7, 2011.

³ Petition at page 1.

⁴ *Id.* at page 2.

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's June 7, 2011 response includes 65 pages of remarks, which are subject to the 50 page limit.

The patent owner response is also accompanied by a declaration of Dr. V.S. Subrahmanian under 37 CFR 1.132.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, i.e., arguments of counsel such as, e.g., arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the document is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 11-page declaration of Dr. V.S. Subrahmanian and the accompanying 53-page *curriculum vitae* are free of legal argument.

Accordingly, the June 7, 2011 patent owner response *in toto* is 65 pages in length.

37 CFR 1.183 permits waiver of the page limitation requirement of the regulations in an extraordinary situation when justice requires. Under the facts and circumstances currently of record in the present reexamination proceeding, the instant patent owner petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting patent owner's response to run 65 pages in length is appropriate in the interest of justice.

Accordingly, the patent owner's petition under 37 CFR 1.183 is **granted** to the extent that the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the patent owner's response to the March 7, 2011 non-final Office action to exceed the page limit by 15 pages. This waiver makes the patent owner's June 7, 2011 response page-length compliant.

CONCLUSION

1. The patent owner's petition under 37 CFR 1.183 is granted-in-part, and the page limit of 37 CFR 1.943(b) is waived to the extent that the patent owner's response filed on June 7, 2011 may exceed the page limit by 15 pages. This waiver makes the June 7, 2011 patent owner response page-length compliant.
2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

7/27/11
Kenpet8/IP/length



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,430	09/08/2010	6778979	19473-0036RX1	1480
11580	7590	12/15/2011	EXAMINER	
Schwegman Lundberg & Woessner/Xerox P.O. Box 2938 Minneapolis, MN 55402			ART UNIT	PAPER NUMBER

DATE MAILED: 12/15/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

P.O. BOX 1247

SEATTLE, WA 98111-1247

Date:

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DEC 15 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001430

PATENT NO. : 6778979

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001430
<p>1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed <u>9/2/11</u> is granted.</p> <p>2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.</p> <p>A. X Since the petition does not specify otherwise, the documents have been:</p> <p> i. X Destroyed.</p> <p> ii. <input type="checkbox"/> Expunged.</p> <p>B. X Other/Comment: <u>Examiner has determined that submitted materials are not deemed material to patentability. See ACP Page 12, Mailed 11/7/11. Initialed IDS will accompany the next office action.</u></p> <p>3. CONCLUSION</p> <p>Telephone inquiries with regard to this decision should be directed to Alexander Kosowski at 571-272-3744. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit</p> <p>/Andres Kashnikow/ For</p> <p><u>Irem Yucel</u> <u>Director, Central Reexamination Unit</u></p>	



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,430	09/08/2010	6778979	19473-0036RX1	1480
11580	7590	02/22/2012	EXAMINER	
Schwegman Lundberg & Woessner/Xerox P.O. Box 2938 Minneapolis, MN 55402			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
QUINN EMANUEL URQUHART & SULLIVAN, LLP
50 CALIFORNIA ST., 22ND FLOOR
SAN FRANCISCO, CA 94111

Date: **MAILED**

FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001430
PATENT NO. : 6778979
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision Granting 37 CFR 1.59 Petition in Reexamination	Control No.: 95/001430
<p>1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed <u>01/10/12</u> is granted.</p> <p>2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.</p> <p>A. X Since the petition does not specify otherwise, the documents have been:</p> <p> i. X Destroyed.</p> <p> ii. <input type="checkbox"/> Expunged.</p> <p>B. X Other/Comment: <u>Examiner has determined that submitted materials are not deemed material to patentability. Initialed IDS will accompany the next office action.</u></p> <p>3. CONCLUSION</p> <p>Telephone inquiries with regard to this decision should be directed to Alexander Kosowski at 571-272-3744. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit</p> <p>/Alexander J. Kosowski/ For</p> <p><u>Irem Yucel</u> <u>Director, Central Reexamination Unit</u></p>	



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,431	11/26/2010	6,134,606	32268.0006	1501
74548	7590	02/23/2011	EXAMINER	
FlashPoint Technology and Withrow & Terranova 100 Regency Forest Drive Suite 160 Cary, NC 27518			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2011

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PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

Date:

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FEB 23 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001431
PATENT NO. : 6134606
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,431

1. THIS IS A DECISION ON THE PETITION FILED 17 February 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 20 December 2010 which sets a two (2) months period for filing a response thereto, be extended by two (2) months

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☒ Granted or ☐ Granted-in-part for two (2) months because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☒ Other/comment: two (2) months granted because of improper mailing of non-final.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611 .In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/

[Signature]

SPE, AU 3992 Central Reexamination Unit

(Title)



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(For Patent Owner) MAR 31 2011

CENTRAL REEXAMINATION UNIT

FlashPoint Technology and Withrow & Terranova
100 Regency Forest Drive
Suite 160
Cary NC 27518

(For Requester)

PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

In re: Anderson et alia
Reexamination Proceeding
Control No. 95/001,431
Request Deposited: November 26, 2010
For: U.S. Patent No. 6,134,606

:
:
: **DECISION**
:
:

This is a decision on the February 18, 2011 patent owner paper entitled "PETITION UNDER 37 CFR 1.181(a)(3) FOR REMAILING OFFICE ACTION."

In view of the alternate relief in the decision mailed February 23, 2011 granting an extension of time to respond to the office action, the request to remail the office action is **dismissed as moot**.

CONCLUSION

1. Petitioner's request to remail the office action is **dismissed as moot**.
2. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

Application/Control Number: 95/001,431

Page 2

Art Unit: 3992

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

A handwritten signature in cursive script, appearing to read "Eric Keasel", written over a horizontal line.

Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,433	08/30/2010	6,262,769	32268.0006	1952
74548	7590	02/02/2011	EXAMINER	
FlashPoint Technology and Withrow & Terranova 100 Regency Forest Drive Suite 160 Cary, NC 27518			ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2011

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Date:

HOGAN LOVELLS US LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

MAILED

FEB 02 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001433

PATENT NO. : 6262769

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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& TERRANOVA
100 REGENCY FOREST DRIVE
SUITE 160
CARY, NC 27518

(For Patent Owner)

MAILED

FEB 02 2011

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,433
Filed: August 30, 2010
For: U.S. Patent No. 6,262,769

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The patent owner's petition paper entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.183 TO WAIVE THE PAGE LIMIT PROVISIONS OF 37 CFR 1.943(b)," filed on December 17, 2010, is dismissed for failing to include the requisite petition fee under 37 CFR 1.17(f) for the petition under 37 CFR 1.183.

MPEP 509.01, part I provides in-part (emphasis added):

It is extremely important that the authorization be clear and unambiguous. If applicants file authorizations which are ambiguous and deviate from the usual forms of authorizations, the Office may not interpret the authorizations in the manner applicants intend and may return the fees. As a result, applicants could be subject to further expenses, petitions, etc. in order to have a particular fee charged to a deposit account (which was not charged as intended) or to resubmit a fee(s) due to an ambiguous authorization.

In this instance, the authorization statement is clearly ambiguous and deviates from the usual forms of authorizations.¹ Specifically, petitioner has authorized payment of the petition fee only if the Office determines that the instant petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) is necessary for entry of patent owner's concurrently-filed response submission. However, in order to assess the merits of the instant petition, the Office must evaluate the response submission with respect to the page limit provision of 37 CFR 1.943(b), and, if the page count is determined to exceed the regulatory page limit, the Office must evaluate the response

¹ See petition under 37 CFR 1.183 at page 3 (stating, "Payment of the \$400 petition fee is not enclosed. However, Patent Owner authorizes the Office to charge such fee if the Office determines that the response and proposed amendment exceeds the 50 page limit.")

submission for economizing, extraneous material, and arrangement, without repetition of information already of record. Therefore, because a complete evaluation of the response submission, in its entirety, is required for a decision on the merits of the instant petition even as to whether the petition is needed, the requirement for an unequivocal authorization to charge the petition fee is both equitable and reasonable. The payment of the petition fee can not be made conditional on the outcome of the Office of Patent Legal Administration review of the response submission.

Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-271-8150 or Nicole Dretar Haines, Legal Advisor, at 571-272-7717.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet8/
2-1-11



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,433	08/30/2010	6,262,769	32268.0006	1952
93143	7590	04/19/2011	EXAMINER	
Herskovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2011

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SUITE 1400
LOS ANGELES, CA 90067

Date:

MAILED

APR 19 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001433
PATENT NO. : 6262769
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HERSKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

MAILED

APR 19 2011

HOGAN LOVELLS US LLP
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,433
Filed: August 30, 2010
For: U.S. Patent No. 6,262,769

: **NOTICE OF**
: **DEFECTIVE PAPER**
: **AND DECISION**
: **DISMISSING PETITIONS**
: **AS MOOT**

This is a decision finding patent owner's December 17, 2010 response submission improper based on a defective certificate of service.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR § 1.183 TO WAIVE THE PAGE LIMIT PROVISIONS OF CFR § 1.943(B)" (the petition under 37 CFR 1.183), filed on January 14, 2011.

This is also a decision on patent owner's March 4, 2011 petition paper entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.59 TO EXPUNGE THE THIRD PARTY COMMENTS FILED FEBRUARY 17, 2011" (the patent owner petition to expunge) and on third party requester's April 4, 2011 petition paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION FILED MARCH 4, 2011 AND REQUEST TO REFUSE CONSIDERATION OF PATENT OWNER'S RESPONSE TO NON-FINAL OFFICE ACTION" (the requester opposition petition).

Patent owner's petition to expunge, requester's opposition petition, and requester's petition under 37 CFR 1.183 are before the Office of Patent Legal Administration.

SUMMARY

Patent owner's December 17, 2010 response submission is not being considered, because the certificate of service accompanying that submission is deemed defective, for reasons to be stated below. Patent owner is given a period of 15 days from the mailing date of this decision (giving notice of the defective certificate of service) to serve a copy of the December 17, 2010 patent owner response submission on third party requester and submit a certificate of service that clearly indicates the date of service and manner of service in compliance with 37 CFR 1.248(b).

The March 4, 2011 patent owner petition to expunge, the April 4, 2011 requester opposition petition, and the January 14, 2011 requester petition under 37 CFR 1.183 are dismissed as moot for the reasons set forth herein.

DECISION

On October 29, 2010, an Office action was issued for the present proceeding, and on December 17, 2010, patent owner responded to that Office action by filing a paper entitled "RESPONSE UNDER 37 CFR 1.111 AND PROPOSED AMENDMENT UNDER 37 CFR 1.530" with accompanying exhibits (the patent owner response submission). A certificate of service of the patent owner's response was filed for the patent owner response (as page 62 of the response submission) having the following information (the 2 lines are added to separate the text from the rest of the decision):

CERTIFICATE OF SERVICE

It is hereby certified that the attached Response under 37 CFR 1.111 and Proposed Amendments under 37 CFR 1.530 in Reexamination Proceeding No. 95/001,433 are being served by first class mail on the third party requester at the third party Requestor's address:

Hogan Lovells US LLP
1999 Avenue of the Stars, Suite 1400
Los Angeles, California 90067

____/Abe HersHKovitz/
Abraham HersHKovitz

DECEMBER 20, 2010
Date

On January 14, 2011, third party requester filed the instant petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b), which limits requester's comments to 50 pages in length. Third party requester's comments submission was subsequently filed on February 17, 2011. On March 4, 2011 patent owner filed the instant petition to expunge, requesting that requester's February 17, 2011 comments submission be expunged as untimely. On April 4, 2011 requester filed the instant opposition petition asserting that requester's comments submission was timely filed.

A. Patent Owner's December 17, 2010 Response Submission

37 CFR 1.903 provides (emphasis added) in-part:

After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

37 CFR 1.248(b) provides (emphasis added):

Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

- (1) An acknowledgement of service by or on behalf of the person served
- or
- (2) A statement signed by the attorney or agent containing the information required by this section.

As pointed out above, the patent owner's certificate of service accompanying the December 17, 2010 response submission states:

It is hereby certified that the attached Response under 37 CFR 1.111 and Proposed Amendments under 37 CFR 1.530 in Reexamination Proceeding No. 95/001,433 are being served by first class mail on the third party requester at the third party Requestor's address: Hogan Lovells US LLP, 1999 Avenue of the Stars, Suite 1400, Los Angeles, California 90067.

The certificate explicitly states the manner of service, but it clearly does not state the date of service on the third party requester; thus, the certificate fails to comply with the 37 CFR 1.248(b) requirement to state the date of service, and fails to comply with the 37 CFR 1.903 requirement that service must be made "in the manner provided in § 1.248."

In addition, as shown above, the date of December 20, 2010 appears adjacent to the electronic signature, showing that to be the date the attorney signed the certificate of service. However, the paper was received in the Office three days earlier, on December 17, 2010. Thus, the certificate of service is further defective, since it could not have been signed on December 20, 2010, three days after the paper was received in the Office.

The certificate of service is especially critical in *inter partes* reexamination, since the third party requester must, by statute, file its written comments within 30 days of the date of service of the patent owner's response, in order to be timely. Since patent owner's certificate of service is deemed defective, the Office will not consider patent owner's December 17, 2010 response submission until patent owner submits a proper certificate of service, at which time the response will be deemed complete, and requester's comment right will be triggered.

The previously submitted third party requester comments submission after the December 17, 2010 patent owner response submission will also not be considered, because, given that December 17, 2010 patent owner response submission has been refused, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily has no comment right under 35 USC 314(b)(2). Given that requester statutorily has no comment right to file a comments submission, requester's February 17, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

Patent owner is given a period of 15 days from the mailing date of this decision giving notice of the defective certificate of service to serve a copy of the December 17, 2010 patent owner response submission on third party requester and submit a certificate of service that clearly indicates the date of service and manner of service pursuant to 37 CFR 1.248(b). If no response to this decision giving notice is received, the December 17, 2010 patent owner response submission will not be considered, and because it was necessary to respond to an outstanding Office action, the prosecution of the reexamination proceeding be treated pursuant to 37 CFR 1.957. If a response to this decision giving notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's December 17, 2010 response submission, within 30 days from the date the patent owner serves a copy of the December 17, 2010 response submission on third party requester; a proper certificate of such service must be timely submitted to the Office.

B. Third Party Requester's February 17, 2011 Petition under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. The merits of the instant petition under 37 CFR 1.183 are not being addressed because requester has not shown that requester's comments submission of February 17, 2011 was timely filed (see "Additional Discussion" section herein). Requester has not provided any information in the instant petition under 37 CFR 1.183 showing why requester's February 17, 2011 comments submission is timely. Thus, it has not been shown that extraordinary circumstances exist justifying entry of requester's February 17, 2011 comments submission in excess of the page limit. Also, even if 37 CFR 1.943(b) were to be waived to permit extra pages for requester's February 17, 2011 comments submission, requester's comments submission would still not be considered, because it has not been shown to have been timely filed.

In summary, in view of the specific facts and circumstances in this instance, requester has not demonstrated that justice requires waiver of 37 CFR 1.943(b) for requester's February 17, 2011 comments submission. Further, because the February 17, 2011 requester comments submission is not being considered as moot for the reasons set forth herein, requester's January 14, 2011 petition under 37 CFR 1.183 is **dismissed as moot**.

C. Patent Owner's March 4, 2011 Petition to Expunge and Requester's April 4, 2011 Opposition Petition

On March 4, 2011 patent owner filed the instant petition to expunge, requesting that requester's February 17, 2011 comments submission be expunged as untimely. On April 4, 2011 requester filed the instant opposition petition asserting that requester's comments submission was timely filed. Because the February 17, 2011 requester comments submission is not being considered as moot for the reasons set forth herein, patent owner's March 4, 2011 petition to expunge and requester's April 4, 2011 opposition petition are **dismissed as moot**.

ADDITIONAL DISCUSSION

A. Timeliness of Third Party Requester's February 17, 2011 Comments Submission

35 U.S.C. § 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 CFR 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

Requester has failed to show that the February 17, 2011 comments submission was timely made, had the December 17, 2010 response submission been granted consideration. By filing the instant petition on January 14, 2011, requester demonstrated **that it was aware of the patent owner response by at least January 14th, yet requester did not file requester's comments**

submission until February 17, 2011, more than (the statutory) 30 days after January 14th. That is, even if the Office were to accept that requester became aware of patent owner's response submission as of January 14th and deem patent owner's response as having been served on requester as of that date, requester still failed to file its comments submission in time. As an additional point to consider, while the instant petition under 37 CFR 1.183 is silent as to the exact date when requester became aware of the patent owner response, it appears from requester's April 4, 2011 opposition paper that it received a copy of patent owner's response via email on December 27, 2010,¹ at which time requester was on notice to check the public Patent Application Information Retrieval (PAIR) system. Again, even if the Office were to accept that requester became aware of patent owner's response submission as of December 27th and deem patent owner's response as having been served on requester as of that date, requester still failed to file its comments submission in time as the February 17, 2011 comments submission was filed more than 30 days later.

Moreover, to the extent third party requester deemed it appropriate to wait until the Office rendered a decision on patent owner's December 17, 2010 petition requesting waiver of the regulatory page limit for patent owner's December 17, 2010 response submission, it is noted that the guidance set forth in MPEP 2666.05(I) only applies in the unique circumstance when patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). That is, if patent owner files a petition for waiver of the regulatory page limit in conjunction with a response to an Office action that does not actually exceed the page length, the time period for requester's comments submission would be 30 days from the date of the service of the page-length compliant patent owner response.

B. Ineffective Third Party Requester Power of Attorney Submission

37 CFR 1.5 provides in-part:

- (a) No correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office....

- (d) A letter relating to a reexamination proceeding should identify it as such by the number of the patent undergoing reexamination, the reexamination request control number assigned to such proceeding, and, if known, the group art unit and name of the examiner to which it been assigned.

¹ See "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION FILED MARCH 4, 2011 AND REQUEST TO REFUSE CONSIDERATION OF PATENT OWNER'S RESPONSE TO NON-FINAL OFFICE ACTION," filed April 4, 2011, at page 5.

Third party requester's November 18, 2010 power of attorney submission is ineffective, because it does not comply with 37 CFR 1.5(a) and (d) for failing to identify in a conspicuous location, at the top of the page (or in a cover letter as the "top of the page"), the control number assigned to the proceeding in which the paper was being filed. The November 18, 2010 power of attorney submission provides a listing of seven reexamination proceeding control numbers to which the paper is intended to apply, but the control number of the proceeding in which the paper is to be entered is not identified on the top of the page nor was it identified in a cover letter accompanying the submission. Thus, the November 18, 2010 power of attorney submission is ineffective to change the power of attorney in the instant proceeding for third party requester.

CONCLUSION

1. Patent owner's December 17, 2010 response submission is not being considered, because the certificate of service accompanying the submission is deemed defective for the reasons pointed out above. Patent owner is given **a period of 15 days** from the mailing date of this decision giving notice of the defective certificate of service to serve a copy of the December 17, 2010 patent owner response submission on third party requester and submit a certificate of service that clearly indicates the date of service and manner of service in compliance with 37 CFR 1.248(b). If patent owner timely does so, the response will be deemed complete at the time the certificate of service is filed with the Office, and requester's comment right will be triggered under the guidelines set forth in Item 3 below.
2. Third party requester's February 17, 2011 comments submission will also not be considered. Given that requester statutorily has no comment right to file a comments submission (for the reasons stated above), the comments submission is being expunged from the record. Because these papers have been scanned into the Office's electronic Image File Wrapper (IFW) system, they are being expunged from the record by marking the papers "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.
3. If a response to this decision giving notice is received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's December 17, 2010 response submission, **within 30 days from the date the patent owner serves** a copy of the December 17, 2010 response submission on third party requester; a proper certificate of such service must be timely submitted by patent owner to the Office.
4. Third party requester's January 14, 2011 petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR § 1.183 TO WAIVE THE PAGE LIMIT PROVISIONS OF CFR § 1.943(B)" is **dismissed as moot**.
5. Patent owner's March 4, 2011 petition paper entitled "PATENT OWNER'S PETITION UNDER 37 CFR 1.59 TO EXPUNGE THE THIRD PARTY COMMENTS FILED FEBRUARY 17, 2011" is **dismissed as moot**.

6. Third party requester's April 4, 2011 petition paper entitled "THIRD PARTY REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION FILED MARCH 4, 2011 AND REQUEST TO REFUSE CONSIDERATION OF PATENT OWNER'S RESPONSE TO NON-FINAL OFFICE ACTION" is **dismissed as moot**.
7. The November 18, 2010 power of attorney submission is ineffective to change the power of attorney in the instant proceeding for third party requester, and all action and mailings will be conducted accordingly, until a proper power of attorney is filed.
8. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at 571-272-7717 or Maria Nuzzolillo, Legal Advisor, at 571-272-8150.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

04-14-2011
Kenpet8/IP/lenght



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,433	08/30/2010	6,262,769	RI1321365-769	1952
93143	7590	08/31/2011	EXAMINER	
Herskovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

P.O. BOX 1247

SEATTLE, WA 98111-1247

Date:

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001433

PATENT NO. : 6262769

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,433
--	-------------------------

1. THIS IS A DECISION ON THE PETITION FILED 24 August 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 01 August 2011 which sets a one (1) month period for filing a response to the Office action, be extended by two (2) months.

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☒ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

B. ☒ Other/comment: see attached

C. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: see attachment.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
[Signature]

SPE, AU 3992 Central Reexamination Unit
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of not receiving the Office action it is noted that the mailing address in the IFW is, in fact, correct. That said, it is possible the package was misdelivered. This is noted. The Patent Owner further seeks to introduce ITC findings into the record. On balance there is sufficient cause to grant an extension of time for one (1) month

Pursuant to MPEP § 2665 (in-part) "Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations."

The petition for extension of time is hereby granted in part for one (1) month.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,433	08/30/2010	6,262,769	RI1321365-769	1952
93143	7590	02/14/2012	EXAMINER	
Herskovitz & Associates, LLC 2845 Duke Street Alexandria, VA 22314			ART UNIT	PAPER NUMBER

DATE MAILED: 02/14/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

P.O. BOX 1247

SEATTLE, WA 98111-1247

Date:

MAILED

FEB 14 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001433

PATENT NO. : 6262769

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HERSKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

(For Patent Owner)

PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

(For Third Party Requester)

MAILED

FEB 14 2012

Inter Partes Reexamination Proceeding
Control No. 95/001,433
Filed: August 30, 2010
For: U.S. Patent No. 6,262,769

:
: **DECISION** **CENTRAL REEXAMINATION UNIT**
: **DISMISSING**
: **PETITION**
:

This is a decision on patent owner's May 4, 2011 petition paper entitled "Patent Owner's Petition Under 37 CFR 1.181 to Confirm Proper Service" (petition under 37 CFR 1.181).

The petition under 37 CFR 1.181 is before the Director of the Office of Patent Legal Administration.

Patent owner's May 4, 2011 petition is dismissed for the reasons set forth below.

BACKGROUND

1. On July 17, 2001, U.S. Patent No. 6,262,769 (the '769 patent) issued to Anderson et al.
2. On August 30, 2010, a request for *inter partes* reexamination of the '769 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,433 (the '1433 proceeding).
3. On October 29, 2010, the Office ordered reexamination of the '769 patent in the '1433 proceeding and concurrently issued a non-final Office action.
4. On December 17, 2010, patent owner filed a response to the non-final Office action, which included a certificate of service with a date of December 20, 2010.
5. On February 17, 2011, third party requester filed comments responsive to patent owner's December 17, 2010 response submission and the October 29, 2010 non-final Office action.

6. On March 4, 2011, patent owner filed a petition paper entitled "Patent Owner's Petition Under 37 CFR 1.59 to Expunge the Third Party Comments filed February 17, 2011" (the petition to expunge).
7. On April 19, 2011, the Office issued a decision dismissing the petition to expunge and finding patent owner's December 17, 2010 response submission to be defective due to a defective certificate of service.
8. On May 4, 2011, patent owner filed the instant petition under 37 CFR 1.181 seeking supervisory review of the April 19, 2011 petition decision, concurrently with a replacement response submission and certificate of service.
9. On June 6, 2011, third party requester timely filed a comments submission responsive to patent owner's May 4, 2011 replacement response submission and the October 29, 2010 non-final Office action.
10. Prosecution in the '1433 proceeding has progressed to the point where, on February 6, 2012, the Office issued a Right of Appeal Notice.

DECISION

I. Relevant Authority

37 CFR 1.903 provides in-part (emphasis added):

After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration.

37 CFR 1.248(a) provides:

Service of papers must be on the attorney or agent of the party if there be such or on the party if there is no attorney or agent, and may be made in any of the following ways:

- (1) By delivering a copy of the paper to the person served;
- (2) By leaving a copy at the usual place of business of the person served with someone in his employment;
- (3) When the person served has no usual place of business, by leaving a copy at the person's residence, with some person of suitable age and discretion who resides there;
- (4) Transmission by first class mail. When service is by mail the date of mailing will be regarded as the date of service;

(5) Whenever it shall be satisfactorily shown to the Director that none of the above modes of obtaining or serving the paper is practicable, service may be by notice published in the Official Gazette.

37 CFR 1.248(b) provides (emphasis added):

Papers filed in the Patent and Trademark Office which are required to be served shall contain proof of service. Proof of service may appear on or be affixed to papers filed. Proof of service shall include the date and manner of service. In the case of personal service, proof of service shall also include the name of any person served, certified by the person who made service. Proof of service may be made by:

- (1) An acknowledgement of service by or on behalf of the person served or
- (2) A statement signed by the attorney or agent containing the information required by this section.

II. The Certificate of Service Accompanying Patent Owner's Response

On December 17, 2010, patent owner filed a certificate of service that accompanied patent owner's response (as page 62 of the response submission) having the following information (the two lines are added to separate the text from the rest of the decision):

CERTIFICATE OF SERVICE

It is hereby certified that the attached Response under 37 CFR 1.111 and Proposed Amendments under 37 CFR 1.530 in Reexamination Proceeding No. 95/001,433 are being served by first class mail on the third party requester at the third party Requestor's address:

Hogan Lovells US LLP
1999 Avenue of the Stars, Suite 1400
Los Angeles, California 90067

____/Abe HersHKovitz/
Abraham HersHKovitz

DECEMBER 20, 2010
Date

III. The April 19, 2011 Decision

Regarding the certificate of service that accompanied patent owner's response filed on December 17, 2010, the April 19, 2011 decision states, on pages 3-4 of the decision:

The certificate explicitly states the manner of service, but it clearly does not state the date of service on the third party requester; thus, the certificate fails to comply with the 37 CFR 1.248(b) requirement to state the date of service, and fails to

comply with the 37 CFR 1.903 requirement that service must be made “in the manner provided in § 1.248.”

In addition, as shown above, the date of December 20, 2010 appears adjacent to the electronic signature, showing that to be the date the attorney signed the certificate of service. However, the paper was received in the Office three days earlier, on December 17, 2010. Thus, the certificate of service is further defective, since it could not have been signed on December 20, 2010, three days after the paper was received in the Office.

The certificate of service is especially critical in *inter partes* reexamination, since the third party requester must, by statute, file its written comments within 30 days of the date of service of the patent owner's response, in order to be timely. Since patent owner's certificate of service is deemed defective, the Office will not consider patent owner's December 17, 2010 response submission until patent owner submits a proper certificate of service, at which time the response will be deemed complete, and requester's comment right will be triggered.

IV. Patent owner's petition under 37 CFR 1.181

In the instant petition under 37 CFR 1.181, patent owner “requests that the service of Response filed December 17, 2010 be confirmed as proper.”¹ Patent owner states that “[s]ince the Response was filed on Friday, December 17, 2010 at 11:25PM, the Patent Owner's representative (Abe HersHKovitz) intended to have the staff serve the Response on Monday, December 20, and the certificate displays this intent,” and that “[s]ervice was in fact effectuated on December 20, 2010.”² In support of its request, patent owner contends that the April 19, 2011 decision is erroneous: (i) in stating that the certificate of service fails to comply with 37 CFR 1.248(b) because it does not state the date of service on the third party requester, and (ii) in stating that the date of December 20, 2010 appearing adjacent to the electronic signature shows the date the attorney signed the certificate of service and renders the certificate of service further defective as it could not have been signed three days after the paper was received at the Office.³

In particular, patent owner asserts that because there is no requirement in 37 CFR 1.248(b) that any signature by the attorney or agent be accompanied by a date of signature, “[t]he only logical conclusion is that the date placed on a page labeled ‘Certificate of Service’ is the date of service.”⁴ Patent owner also asserts that when interpreting a certificate of service, “it is more logical to interpret a ‘Date’ as meaning a ‘Date of Service’ (which is required by 37 CFR

¹ Petition under 37 CFR 1.181 at page 1. On pages 8-9 of the petition, patent owner also requests that “[a]fter confirming ‘DECEMBER 20, 2010’ as the date of service ... third party requester's Comments filed on February 17, 2011, which have been expunged, remain expunged under 37 CFR 1.59 for failure to file within the 30 day period of 37 CFR 1.947” and “requests examination by the Central Reexamination Unit of the Response filed concurrently with this Petition (without consideration of for [sic] the expunged Comments).” Because December 20, 2010 cannot be confirmed as a date of service for the reasons set forth herein, patent owner's additional requests, predicated on confirming December 20, 2010 as the date of service, have not been considered.

² Id. at page 4.

³ See id. at page 3.

⁴ Id. at page 5.

1.248(b)) than it is to interpret the 'Date' as meaning a 'Date of Signature' (which is not required by 37 CFR 1.248(b))."⁵ Thus, patent owner contends that because the certificate dated December 20, 2010 was filed with the Office on December 17, 2010, "[t]he record is clear that patent owner's representative was trying to be fair to third party requester by giving third party requester an extra three days for any submission that third party requester intended to file, in recognition of the fact that a copy of Patent Owner's response was not likely mailed, i.e. served, until the next business day on Monday, December 20, 2010."⁶

Moreover, patent owner contends on page 5 of the instant petition that the Office exceeded its authority in refusing to accept the certificate of service as proper and states:

It is respectfully submitted that the Certificate of Service as used in this case is in full compliance with the letter and spirit of the regulations dealing with service. The USPTO Deciding Official has exceeded his authority in refusing to accept the Certificate of Service as being proper. At most, the Deciding Official could have taken the position that it is not clear if service took place on December 17, 2010 or on December 20, 2010, and as a result, could have ruled that the 30 day period for any third party requester submission shall be deemed to run from the later date of December 20, 2010. To refuse to accept either date based on a technicality created by the USPTO, requiring Patent Owner to provide within 15 days evidence of service, which evidence the USPTO itself admits is already abundantly clear in the record, and then give third party requester a brand new 30 day period to file any submission they wish to file, constitutes a gross miscarriage of justice.

Additionally, patent owner submitted with the instant petition under 37 CFR 1.181 "a US certified mail return receipt postcard" which "shows a signature acknowledging delivery ... and a Date of Delivery of '12/28/10.'" ⁷ Patent owner asserts that the December 28, 2010 date of delivery is consistent with a certificate of service date of December 20, 2010. ⁸ Further, patent owner asserts that "December 20, 2010 is the date of service" because the postcard evidences December 20, 2010 as the date of mailing and 37 CFR 1.248(a)(4) provides that "[w]hen service is by mail the date of mailing will be regarded as the date of service."⁹ Patent owner further contends that "37 CFR 1.248(b) provides two ways to prove service": (i) a statement signed by the attorney or agent pursuant to 37 CFR 1.248(b)(2) or (ii) an acknowledgement of service by or on behalf of the person served pursuant to 37 CFR 1.248(b)(1).¹⁰ Patent owner asserts that "this postcard is an acknowledgement of first class mail service (certified with return receipt) on third party requester, with service acknowledged by or on behalf of the person served, with a service date of 12/28/10" and "states the 'date and manner of service' required by 37 CFR 1.248(b)."¹¹

⁵ Id.

⁶ Id.

⁷ Id. at page 6.

⁸ See id.

⁹ Id.

¹⁰ Id.

¹¹ Id. at page 6.

V. Analysis and Findings

Patent owner's petition under 37 CFR 1.181 has been fully considered. The April 19, 2011 petition decision finding that the certificate of service that accompanied patent owner's response submission on December 17, 2010 is defective under 37 CFR 1.248(b) is affirmed for the reasons set forth herein. The certificate of service is ambiguous as to when patent owner's December 17, 2010 response submission was actually served on the third party requester because it does not clearly identify the "December 20, 2010" date that appears on the certificate as the date of service and the "December 20, 2010" date is three days after the date on which the certificate of service was filed with the Office. Thus, the December 17, 2010 patent owner's response submission contained a certificate of service that, at most, indicated patent owner's intent to serve the response submission on the third party requester at a future date but did not provide the requisite proof that, at the time the response submission was filed with the Office, service on the third party requester had already occurred in accordance with 37 CFR 1.248(b).

A. Proof of Service Requirement in *Inter Partes* Reexamination

Patent owner argues that the April 19, 2011 petition decision was erroneous when it determined that the "December 20, 2010" date that appears on the certificate of service does not satisfy the requirement of 37 CFR 1.248(b) that "[p]roof of service shall include the date and manner of service." 37 CFR 1.903 requires that documents filed by either the patent owner or the third party requester in an *inter partes* reexamination proceeding be served on every other party in the reexamination proceeding in the manner provided in 37 CFR 1.248. 37 CFR 1.248(a) provides different ways service may be made on the other parties, such as by first class mail, in which case the date of mailing is regarded as the date of service, not the date of intended future mailing. Under 37 CFR 1.248(b), papers which are required to be served must contain proof of service when such papers are filed with the Office (i.e., the proof of service cannot be filed at a later date). The proof of service may either appear on or be affixed to the papers filed and must include the date and manner of service. Proof of service may be in the form of an acknowledgement of service by or on behalf of the person served or a statement signed by the attorney or agent containing the required information.

The requisite proof of service cannot be provided where the required act of service has not yet occurred. That is, 37 CFR 1.248 does not provide that proof of service may be made in the form of a statement expressing an intent to serve the papers on the other party at some future date. Rather, the rule requires that proof of service may be made in the form of either an acknowledgement of service by the party served, where such acknowledgement is affixed to the paper when it is filed with the Office, or a statement that the paper has already been served (or is being served contemporaneous with the filing of the paper at the Office). Thus, in this instance, even if the unspecified "Date" of "December 20, 2010" that appears on the certificate of service is taken to be the date of service of the response submission on the third party requester, the certificate of service does not comply with 37 CFR 1.248 because it does not provide proof that the response submission was actually served on the third party requester at the time the paper was filed but only patent owner's intent that service take place on December 20, 2010. Therefore, the Office did not exceed its authority in issuing the April 19, 2011 decision finding that the certificate of service failed to identify the date of service in accordance with 37 CFR 1.248(b). Furthermore, contrary to patent owner's assertion, the Office's April 19, 2011 decision

did not result in “a gross miscarriage of justice.” Rather, the April 19, 2011 decision provided patent owner with another opportunity to file a response submission to the non-final Office action and, therefore, did not categorically deprive the patent owner of its statutory rights to present amendments, evidence, and arguments in the ‘1433 proceeding.

B. The “December 20, 2010” Date

Patent owner also argues that it was unreasonable for the Office to interpret a date appearing on a certificate of service to be anything other than the date of service because 37 CFR 1.248 only requires a date of service and not a date of signature. The fact that 37 CFR 1.248 does not explicitly require a date of signature, however, does not cure the defective certificate of service in this instance. Even if the “December 20, 2010” date is interpreted to be the date of service, the certificate of service merely reflects patent owner’s intent to serve the response submission on the third party requester three days in the future given that the response submission and certificate of service were filed with the Office on December 17, 2010. Thus, even though the certificate of service may reflect an intent to serve the papers by December 20, 2010, it does not establish a date of service that is prior to, or on the date the response was filed with the Office, which is necessary to fulfill the requirements of 37 CFR 1.248(b).

Moreover, while patent owner argues that one interpretation of the “December 20, 2010” date appearing on the certificate of service is the date of service, there are other plausible interpretations of the “December 20, 2010” date. As set forth in the April 19, 2011 decision, another plausible interpretation is that the “December 20, 2010” date shows the date the paper was signed because it appears adjacent the signature line. The certificate of service merely identifies the “December 20, 2010” date as “Date,” and such identification appears in the signature block. It is common practice to interpret a date in the signature block as the date of signature. For example, many Office forms, such as PTO/SB/05, PTO/SB/30, and PTO/SB/50, provide for a date of signature adjacent the signature line in the signature block, and parties frequently submit papers that include a date of signature adjacent the signature line (see, e.g., third party requester’s certificate of service, dated February 17, 2011, which clearly states the date of service in the body of the certificate and also includes a “Date” in the signature block). In this instance, the certificate of service was forward-dated three days from the date the paper was actually signed/filed. While the intent in forward-dating the certificate of service may have been to effect service on the third party requester in three days, the forward-dated certificate does not guarantee or provide proof that service ever took place as of December 20, 2010.

C. Later-Filed Return Receipt Postcard Evidence

Finally, the return receipt postcard evidence submitted by patent owner with the instant petition under 37 CFR 1.181 does not cure the defective certificate of service because, as set forth above, proof of service is required to be submitted at the time the paper that is required to be served is filed with the Office, not at some later date. 37 CFR 1.248(b) provides that papers required to be served “shall contain proof of service” and that such proof of service “may appear on or be affixed to the papers filed.” While patent owner is correct that proof of service may be made by “[a]n acknowledgement of service by or on behalf of the person served,” pursuant to 37 CFR 1.248(b)(1), such acknowledgement must be submitted with the paper when it is filed, not at some later date, in order to provide proof of service in compliance with 37 CFR 1.248(b). Thus,

patent owner's return receipt postcard evidence submitted with the instant petition under 37 CFR 1.181 does not satisfy the requirements of 37 CFR 1.248(b) because such return receipt postcard evidence was not filed contemporaneous with the December 17, 2010 response submission. Additionally, while 37 CFR 1.248(a)(4) provides that the date of mailing will be regarded as the date of service when service is by mail, such regulation cannot be read alone. Rather, 37 CFR 1.248(a) must be read in conjunction with 37 CFR 1.248(b), which requires proof that the paper has been served pursuant to one of the ways set forth in 37 CFR 1.248(a) and that such proof of service be provided contemporaneous with the filing of the paper that requires service.

Accordingly, for at least the foregoing reasons, the April 19, 2011 petition decision was not improper in finding that the certificate of service was defective for failing to comply with 37 CFR 1.248(b). Thus, the instant petition under 37 CFR 1.181 is dismissed. The December 17, 2010 response submission will be expunged from the image file wrapper (IFW) record for the '1433 proceeding by marking the papers "closed" and "not public." See MPEP 2667. Further, for the reasons set forth in the April 19, 2011 decision, the February 17, 2011 third party requester comments submission will remain expunged. Patent owner's May 4, 2011 replacement response submission and third party requester's June 6, 2011 comments submission have been entered into the record of the '1433 proceeding.

CONCLUSION

1. Patent owner's May 4, 2011 petition entitled "Patent Owner's Petition Under 37 CFR 1.181 to Confirm Proper Service" is dismissed for reasons set forth above.
2. The December 17, 2010 response submission will be expunged from the record by marking the papers "closed" and "not public" in the IFW for the '1433 proceeding.
3. Patent owner's May 4, 2011 replacement response submission and third party requester's June 6, 2011 comments submission have been entered into the record of the '1433 proceeding.
4. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.



Brian E. Hanlon

Director

Office of Patent Legal Administration

Office of the Associate Commissioner

for Patent Examination Policy



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,436	08/31/2010	7072665	SMTR-001/05US 195688-2022	5005
22903	7590	06/30/2011	EXAMINER	
COOLEY LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Kirupa Pushparaj
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Seattle, WA 98111-1247

Date:

MAILED

JUN 30 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001436
PATENT NO. : 7072665
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WASHINGTON DC 20001

(For Patent Owner) **MAILED**

JUN 30 2011

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

(For Requester)

In re: Blumberg et alia
Reexamination Proceeding
Control No. 95/001,436
Request Deposited: August 31, 2010
For: U.S. Patent No. 7,072,665

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the April 20, 2011 patent owner paper entitled "PATENT OWNER PETITION UNDER 37 CFR § 1.181 TO EXPUNGE OR NOT CONSIDER THE THIRD PARTY REQUESTERS' COMMENTS UNDER 37 CFR §§1.915, 1.947 AND 1.948".

A review of the record reveals that third-party requester (3PR) filed comments and an Information Disclosure Statement (IDS) on March 24, 2011 via the Electronic Filing System – Web (EFS-Web).

The "LEGAL FRAMEWORK FOR EFS-WEB" reads, in part:

When the USPTO successfully receives documents filed in accordance with the EFS-Web requirements, the USPTO will convert the PDF files submitted by users into Tagged Image File Format (TIFF) image files and then store the TIFF image files in the Image File Wrapper (IFW) as part of the official record...Accordingly, the official record for the patent application and reexamination proceeding comprises...TIFF images of all other original documents as stored in IFW as well as the Electronic Acknowledgement Receipt...

Therefore, the March 24, 2011 papers submitted by 3PR are part of the official record by virtue of the successful reception of the documents via EFS-Web. It is noted that the Office has not yet

Art Unit: 3992

issued an Office Action considering or not considering the comments of March 24, 2011. Nor has the Office expunged the papers.

37 CFR 1.181 stated, in part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

As the Office has not yet issued an Office Action considering, not considering, or expunging the comments of March 24, 2011, there is no action or requirement of any examiner to petition. Therefore, the request is **dismissed as premature** under 37 CFR 1.181.

It should be noted that this decision does not address the substance of the March 24, 2011 papers as to compliance issues. Also, this decision does not address the merits of the papers with respect to prosecution.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,436	08/31/2010	7072665	SMTR-001/05US 195688-2022	5005
22903	7590	04/04/2012	EXAMINER	
COOLEY LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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PERKINS COIE LLP, PATENT-SEA
P.O. BOX 1247
Seattle, WA 98111-1247

Date:

MAY 14 2009

ART 34 2009

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001436
PATENT NO. : 7072665
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

MAILED

APR 04 2012

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
PATENT-SEA
P.O. Box 1247
Seattle, WA 98111

(For Third Party Requester)

In re Blumberg *et alia*
Control No. 95/001,436
Filed: August 31, 2010
For: U.S. Patent No. 7,072,665

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's renewed petition, filed on August 18, 2011, under 37 CFR 1.181, entitled "Petition for Reconsideration of Patent Owner's Petition Under 37 CFR § 1.181 to Expunge or Not Consider the Third Party Requester's Comments Under 37 CFR §§ 1.947 and 1.948".

The petition is before the Director of the Central Reexamination Unit for decision.

The Patent Owner's petition, filed on August 18, 2011, is dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. On July 4, 2006, U.S. Patent No. 7,072,665 (the '665 patent) issued to Blumberg *et al.*
2. On August 31, 2010, a Third Party Requester filed a completed request for reexamination of the '665 patent. The request was assigned control No. 95/001,436 (the '436 proceeding).
3. On November 19, 2010, the Office ordered that the patent be reexamined.
4. On December 21, 2010, the Office mailed a first Office action in the '436 proceeding.
5. On February 22, 2011, the Patent Owner filed a response to the Office action.
6. On March 24, 2011, the Third Party Requester filed comments.
7. On April 20, 2011, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the March 24, 2011 comments be expunged or not considered due to an alleged improper new rejection.
8. On June 30, 2011, the Office dismissed the April 20, 2011 petition as premature.
9. On August 18, 2011, the Patent Owner filed the instant petition renewing the request that the comments filed on March 24, 2011 be expunged or not considered.
10. On March 26, 2012, the Office issued a Notification of Defective Paper in a Reexamination regarding the Third Party Requester's comments filed on March 24, 2011.

DECISION

As pointed out, the Patent Owner filed a renewed petition on August 18, 2011 requesting expungement of any Requester's comments filed on March 24, 2011. Patent Owner alleges that the March 24, 2011 comments were not in compliance with the requirements of 37 CFR 1.947 because they introduced new references to propose a new grounds of rejection for original claims. Petition, pp. 3-4. For this reason, Patent Owner asserts that Requester's comments filed on March 24, 2011 should be expunged from the proceeding record.

On March 26, 2012, as discussed above, the Office mailed a Notification of Defective Papers in a Reexamination that determined that the March 24, 2011 comments are improper papers and expunged the comments from the record. As the March 24, 2011 comments have been entered into the electronic Image File Wrapper (IFW) record, the comments are expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the March 26, 2012 Notice, the remedy of expungement of the March 24, 2011 comments is already given. In other words, the ultimate relief requested by the August 18, 2011 petition was given by the March 26, 2012 Office decision.

For these reasons, the Patent Owner's August 18, 2011 petition is moot, and hereby, dismissed.

CONCLUSION

1. The August 18, 2011 Patent Owner's petition is dismissed as moot.
2. Any response should be addressed as follows:

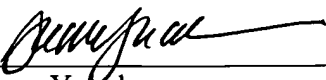
By Mail to: Mail Stop *Inter Partes* Reexam
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By Fax to: (571) 273-9900
Central Reexamination Unit

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By EFS: Registered users of EFS-Web may submit such correspondence via EFS-Web, at **<https://efs.uspto.gov/efile/myportal/efs-registered>**. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

3. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,437	09/01/2010	6496776	SMTR-001/06US 195688-2023	6496
22903	7590	02/23/2011	EXAMINER	
COOLEY LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 02/23/2011

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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001437

PATENT NO. : 6496776

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,437	MAILED
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FEB 23 2011
 CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 17 February 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 21 December 2010 which sets a two (2) months period for filing a response thereto, be extended by one (1) month

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____.

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☐ Granted-in-part for _____ because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

☐ Other/comment: _____.

B. ☒ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☒ The petition is moot.

vi. ☒ Other/comment: Dismissed as moot in view of the response dated 22 February 2011.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
 [Signature]

SPE, AU 3992 Central Reexamination Unit
 (Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,437	09/01/2010	6496776	SMTR-001/06US 195688-2023	6496
22903	7590	05/09/2011	EXAMINER	
COOLEY LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 05/09/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

PERKINS COIE LLP

PATENT-SEA

P O BOX 1247

SEATTLE, WA 98111-1247

MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001437

PATENT NO. : 6496776

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE, WA 98111-1247

In re: Blumberg et alia
Reexamination Proceeding
Control No. 95/001,437
Request Deposited: September 1, 2010
For: U.S. Patent No. 6,496,776

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The *inter partes* reexamination is before the Central Reexamination Unit to address the April 20, 2011 patent owner paper entitled "PATENT OWNER PETITION UNDER 37 CFR § 1.181 TO EXPUNGE OR NOT CONSIDER THE THIRD PARTY REQUESTERS' COMMENTS UNDER 37 CFR §§1.915, 1.947 AND 1.948".

A review of the record reveals that third-party requester (3PR) filed comments and an Information Disclosure Statement (IDS) on March 24, 2011 via the Electronic Filing System – Web (EFS-Web).

The "LEGAL FRAMEWORK FOR EFS-WEB" reads, in part:

When the USPTO successfully receives documents filed in accordance with the EFS-Web requirements, the USPTO will convert the PDF files submitted by users into Tagged Image File Format (TIFF) image files and then store the TIFF image files in the Image File Wrapper (IFW) as part of the official record...Accordingly, the official record for the patent application and reexamination proceeding comprises...TIFF images of all other original documents as stored in IFW as well as the Electronic Acknowledgement Receipt...

Therefore, the March 24, 2011 papers submitted by 3PR are part of the official record by virtue of the successful reception of the documents via EFS-Web. It is noted that the Office has not yet

Art Unit: 3992

issued an Office Action considering or not considering the comments of March 24, 2011. Nor has the Office expunged the papers.

37 CFR 1.181 stated, in part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

As the Office has not yet issued an Office Action considering, not considering, or expunging the comments of March 24, 2011, there is no action or requirement of any examiner to petition. Therefore, the request is **dismissed as premature** under 37 CFR 1.181.

It should be noted that this decision does not address the substance of the March 24, 2011 papers as to compliance issues. Also, this decision does not address the merits of the papers with respect to prosecution.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,437	09/01/2010	6496776	SMTR-001/06US 195688-2023	6496
22903	7590	04/04/2012	EXAMINER	
COOLEY LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

PERKINS COIE LLP

PATENT-SEA

P O BOX 1247

SEATTLE, WA 98111-1247

Date:

10/11/07

10/11/07

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001437

PATENT NO. : 6496776

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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COOLEY LLP
ATTN: PATENT GROUP
SUITE 1100
777 6TH STREET, NW
WASHINGTON, D.C. 20001

(For Patent Owner)

MAILED

APR 04 2012

CENTRAL REEXAMINATION UNIT

PERKINS COIE LLP
PATENT-SEA
P.O. Box 1247
Seattle, WA 98111

(For Third Party Requester)

In re Blumberg *et alia*
Control No. 95/001,437
Filed: September 1, 2010
For: U.S. Patent No. 6,496,776

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's renewed petition, filed on August 18, 2011, under 37 CFR 1.181, entitled "Petition for Reconsideration of Patent Owner's Petition Under 37 CFR § 1.181 to Expunge or Not Consider the Third Party Requester's Comments Under 37 CFR §§ 1.915, 1.947 and 1.948" [hereinafter "the petition to expunge"].

The petition is before the Director of the Central Reexamination Unit for decision.

The Patent Owner's petition, filed on August 18, 2011, is dismissed as untimely and moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. On December 17, 2002, U.S. Patent No. 6,496,776 (the '776 patent) issued to Blumberg *et al.*
2. On September 1, 2010, a Third Party Requester filed a completed request for reexamination of the '776 patent. The request was assigned control No. 95/001,437 (the '437 proceeding).
3. On November 19, 2010, the Office ordered that the patent be reexamined.
4. On December 21, 2010, the Office mailed a first Office action in the '437 proceeding.
5. On February 22, 2011, the Patent Owner filed a response to the Office action.
6. On March 24, 2011, the Third Party Requester filed comments.
7. On April 20, 2011, the Patent Owner filed a petition under 37 CFR 1.181 requesting that the March 24, 2011 comments be expunged or not considered due to an alleged improper rejection of claims 27 and 28 under 35 USC 112, first paragraph.
8. On May 9, 2011, the Office dismissed the April 20, 2011 petition as premature.
9. On August 18, 2011, the Patent Owner filed the instant petition renewing the request that the comments filed on March 24, 2011 be expunged or not considered.
10. On November 18, 2011, the Office issued an Action Closing Prosecution (ACP) in which the examiner did not address the alleged improper rejection of claims 27 and 28 under 35 USC 112, first paragraph.

DECISION

The Patent Owner filed this renewed petition on August 8, 2011 under 37 CFR 1.181 to expunge the Third Party Requester's March 24, 2011 comments. This was in response to the Petition Decision mailed on May 9, 2011. Under 37 CFR 1.181(f), any petition under section 1.181 not filed within two months of the mailing date of the action from which relief is requested may be dismissed as untimely. Here, the filing of the renewed petition decision on August 8, 2011 was more than two months from the mailing date of the May 9, 2011 Petition Decision.

As such, this petition is dismissed as untimely.

In addition, this petition requests either expungement or no consideration be taken of Third Party Requester's comments filed on March 24, 2011. In particular, Patent Owner alleges that Third Party Requester's proposed new ground of rejection of original claims 27 and 28 under 35 USC 112, first paragraph, is improper as not being permitted under 35 USC 312 and 313. Petition, pp. 3-4.

On November 18, 2011, as discussed above, the Office mailed an Action Closing Prosecution (ACP) that did not consider the March 24, 2011 comments to the extent these comments were directed to the rejection of original claims 27 and 28 under 35 USC 112, first paragraph. Specifically, page 39 of the ACP clearly identified the proposed rejection of original claims 27 and 28 as an issue outside the scope of reexamination in accordance with Office policy set forth in MPEP 2658, subsection III.H. As a result of the ACP, the remedy of non-consideration of the improperly raised issue regarding claims 27 and 28 in the March 24, 2011 comments is already given.

For these reasons, the Patent Owner's August 8, 2011 petition is hereby dismissed as moot.

CONCLUSION

1. The May 17, 2011 Patent Owner's petition is dismissed as untimely and moot.
2. Any response should be addressed as follows:

By Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

By Fax to: (571) 273-9900
Central Reexamination Unit

By Hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may submit such correspondence via EFS-Web, at **<https://efs.uspto.gov/efile/myportal/efs-registered>**. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the

opportunity to review the content of their submissions after the "soft scanning" process is complete.

3. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152.



Irem Yucel
Director, Central Reexamination Unit



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,439	10/05/2010	7726029	133657/00002	2074
43025	7590	12/29/2010	EXAMINER	
LAUSON & TARVER LLP 880 APOLLO STREET SUITE 301 EL SEGUNDO, CA 90245			ART UNIT	PAPER NUMBER

DATE MAILED: 12/29/2010

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
JOHN H. ENGELMAN
MILLER, CANFIELD, PADDOCK AND STONE, P.L.C.
277 SOUTH ROSE STREET, SUITE 5000
KALAMAZOO, MI 49007

Date:

MAILED

DEC 29 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001439
PATENT NO. : 7726029
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.


All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,439

1. THIS IS A DECISION ON THE PETITION FILED December 22, 2010.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the non-final office action mailed on November 18, 2010, be extended by one month.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
 - B. ☒ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☒ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action.
 - v. ☐ The petition is moot.
 - vi. ☒ Other/comment: Patent owner contends that a lack of sufficient resources to handle the proceeding is sufficient cause to warrant an extension of time. The office disagrees.
5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.



[Signature]

ERIC S. KEASEL
CRU SPE-AU 3992

(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,440	09/08/2010	7130821	T00025	3871
33438	7590	08/16/2011	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			ART UNIT	PAPER NUMBER

DATE MAILED: 08/16/2011

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HAMILTON & TERRILE, LLP
P.O. BOX 203518
AUSTIN TX 78720

(For Patent Owner)

MAILED

AUG 16 2011

CENTRAL REEXAMINATION UNIT

(For Third Party Requester)

WINSTEAD PC
P.O. BOX 50784
DALLAS, TX 75201

In re Connors et alia
Reexamination Proceeding
Control No. 95/001,440
Request Deposited: September 8, 2010
For: U.S. Patent No. 7,130,821

:
: DECISION DENYING
: PETITION
:
:

This decision addresses the following papers:

1. The patent owner (PO) paper filed January 3, 2011 entitled, "PETITION UNDER 37 C.F.R. § 1.181 FOR DECLARING THAT THE *AUTOQUOTE MANUAL* IS NOT A 'PRINTED PUBLICATION' AND IS, THEREFORE, NOT 35 U.S.C. § 102 PRIOR ART WITH REGARD TO U.S. PATENT NO. 7,130,821 AND IN THE ALTERNATIVE PETITION FOR SAME UNDER 37 C.F.R. § 1.182 AND/OR 37 C.F.R. § 1.183".
2. The third party requester (3PR) paper filed February 16, 2011 entitled, "OPPOSITION PETITION UNDER 37 C.F.R. 1.182 FILED IN RESPONSE TO PATENT OWNER'S PETITION UNDER 37 C.F.R. 1.181".

The papers are before the Director of the Central Reexamination Unit for consideration.

The request to declare that a reference is not prior art is denied for the reasons set forth below.

PO correctly states that reexamination is only conducted on the basis of patents and printed publications.

However, MPEP 2646(II) also states, in part:

Where the examiner determines that a date of a reference is early enough such that the reference constitutes prior art, that determination is not petitionable (with respect to vacating the examiner's finding of a substantial new question). Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also not petitionable.

Therefore, the Office has not acted *ultra vires* in granting the request for reexamination and the petition of January 3, 2011 is **denied**.

CONCLUSION

1. The January 3, 2011 petition is **denied**.
2. All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

3. Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

Art Unit: 3992

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

4. For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4) and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.



Irem Yucel
Director, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,440	09/08/2010	7130821	T00025	3871
33438	7590	02/14/2012	EXAMINER	
HAMILTON & TERRILE, LLP P.O. BOX 203518 AUSTIN, TX 78720			ART UNIT	PAPER NUMBER

DATE MAILED: 02/14/2012

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WINSTEAD PC
P.O.BOX 50784
DALLAS, TX 75201

Date: **MAILED**

FEB 14 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001440
PATENT NO. : 7130821
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Hamilton & Terrile, LLP
P.O. Box 203518
Austin, TX 78720

:
:
: (For Patent Owner)
:

MAILED

FEB 14 2012

Winstead PC
P.O. Box 50784
Dallas, TX 75201

:
:
: (For Requester)
:

CENTRAL REEXAMINATION UNIT

In re Connors et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,440
Filed: September 8, 2010
For: U.S. Patent No.: 7,130,821 B2

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the November 21, 2011 patent owner petition entitled "Petition Under 37 C.F.R. § 1.183 To Enter the Declaration of Sandra Brerton and Accompanying Exhibit."

The patent owner petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

PERTINENT BACKGROUND¹

1. On September 8, 2010, a request for *inter partes* reexamination of all of the claims (claims 1-38) of U.S. Patent Number 7,130,821 to Connors *et al.* was filed by a third party requester. The real party in interest was identified as Internet Brands, Inc.; AutoData Solutions Co.; and AutoData Solutions, Inc. This request was assigned Control No. 95/001,140 ("the '1140 proceeding").
2. On November 1, 2010, the Office issued an order granting the '1140 request for *inter partes* reexamination on claims 1-38, and issued an Office action rejecting claims 1-38 over the Biffar reference, the AutoQuote reference (for some claims, in combination with the "CarsDirect" reference).

¹ See the reexamination file for the full history.

3. Prosecution continued, until on August 18, 2011, the Office issued a right of appeal notice ("RAN") rejecting claims 1-64, with claims 1-38 being rejected under the same grounds as in the November 1, 2010 Office action.
4. On September 19, 2011, patent owner filed a notice of appeal.
5. On November 21, 2011, patent owner filed an appellant's brief and the instant petition entitled "Petition Under 37 C.F.R. § 1.183 To Enter the Declaration of Sandra Brerton and Accompanying Exhibit."
6. On November 25, 2011, the Office issued a decision finding the November 21, 2011 brief to be defective.
7. On December 24, 2011, patent owner filed a new appellant's brief.
8. On July 28, 2011, the third party requester filed an appellant's brief.

APPLICABLE RULE(S)

37 C.F.R. § 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.116(f) provides:

Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77 (b)(1) of this title.

37 C.F.R. § 41.63(c) provides:

Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

DECISION

Patent owner petitions for waiver of the provision of rule 41.63(c) which states that “[a]ffidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution [pursuant to a new ground of rejection by the Board].”

In the instant proceeding, a right of appeal notice (“RAN”) was issued on August 18, 2011. Upon mailing of the RAN, 37 C.F.R. § 1.116(f) operates to prevent entry of evidence in the proceeding. Patent owner then filed an appellant’s brief on November 21, 2011, and an evidence submission (“Declaration of Sandra Brereton”) therewith. Pursuant to 37 C.F.R. § 41.63(c), such affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1). The submission is barred under § 41.63(c), and patent owner petitions for waiver of the relevant provisions of that rule.

Patent owner’s petition is submitted under § 1.183, which permits waiver of a rule, which is not a requirement of the statutes, in an “extraordinary situation, when justice requires” the requested relief. Relief may be granted, therefore, if the existence of an extraordinary situation such that justice requires relief can be found in the current instance.

Patent owner sets forth the following rationale for entry of the evidence submission: (1) the affidavit could not have been filed prior to November 8, 2011 because the court deposition on which the affidavit is based occurred on that date, and (2) the deposition testimony discussed in the affidavit is directed to one of the references applied in some of the rejections of the claims.

With respect to these rationales, it is instructive to first explore the Office’s balance between entering additional evidence after a RAN and ensuring a timely reexamination. This balance can be seen in the provisions of 37 C.F.R. § 1.116, which set forth the requirements for entry of amendments and evidence after close of prosecution in applications and reexaminations. Where an *inter partes* reexamination has proceeded to a post-ACP stage, entry of an evidence submission requires good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. Where an *inter partes* reexamination has proceeded to a post-RAN stage, and especially where it has proceeded to the briefing stage of appeal, the Office permits no entry of an evidence submission, regardless whether the evidence is necessary and/or whether there are good and sufficient reasons why the evidence was not earlier presented.

Regardless of whether applicant could not have submitted the evidence at an earlier time, the requirements of § 1.183 require the existence of an extraordinary situation such that justice requires waiver. In this instance, petitioner has failed to establish such a situation because petitioner has provided no reasoning as to why the failure to enter the Brereton affidavit would cause an extraordinary situation.

Applicant states that the substance of the affidavit is “likely to be relevant and of interest to the Board of Patent Appeals and Interferences in interpreting the November 10, 1998 AutoQuote Pro software documentation on appeal.”³ Petitioner has not explained how the information in the document would affect the facts underlying those claim rejections based upon the AutoQuote Pro reference. Nor has petitioner explained how failure to enter the document would cause such a situation that “justice requires” extraordinary relief. Petitioner merely states that the affidavit is “likely” to be relevant. However, “likely to be relevant” is an insufficient ground for waiver of the rules under § 1.183.

Having weighed all of the facts and circumstances pertinent to the petition, patent owner has failed to establish the existence of an extraordinary circumstance such that justice requires entry of the evidence submission filed with the petition. For that reason, relief may not be provided under § 1.183, and patent owner’s November 21, 2011 petition under § 1.183 is **dismissed**.

CONCLUSION

- The petition is **dismissed**.
- Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit for further handling and examination not inconsistent with this decision.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Michael Cygan/

Michael Cygan
Legal Advisor
Office of Patent Legal Administration

February 10, 2012

³ Petition at 4.



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Lauson & Tarver LLP
880 Apollo Street
Suite 301
El Segundo, CA 90245

For Patent Owner

MAILED

APR 29 2011

Miller, Canfield, Paddock and Stone
277 South Rose Street
Suite 5000
Kalamazoo, MI 49007

3^d Party Requester

CENTRAL REEXAMINATION UNIT

Ex Parte Reexamination Proceeding
Control No. 95/001,441
Filed: October 7, 2010
For: U.S. Patent No. 6,718,640

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed April 12, 2011 and supplemented April 21, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The petition is **DISMISSED**.

Petitioner requests that "highly confidential" material that is subject to a protective order in the United States Court, Central District of California – Southern Division, Case No. SACV 09-0951 DOC(ANx), submitted in a sealed envelop on April 12, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

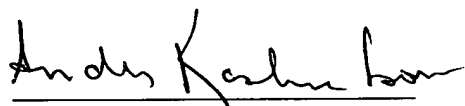
Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Ex Parte* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

It is noted however, that the petitions are deficient because they lack items (A), (C), and (D) listed above. As to item (B), the petition does not indicate that the material in question has not been otherwise made public.

If patent owner still wishes to have the material in question expunged, a renewed petition should be promptly filed or, shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process) the mailing of the NIRC. If a renewed petition is not filed or filed in time to be addressed, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

It is also noted that the information in question was not served on third party requester. As noted in the petition under 37 CFR 1.182 filed April 21, 2011, patent owner is aware of this fact and has taken steps to remedy the situation. A copy of the information in question was attached to a decision on the 37 CFR 1.182 petition mailed April 26, 2011, to effect service on third party requester.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

A handwritten signature in black ink, appearing to read "Andres Kashnikow", written over a horizontal line.

Andres Kashnikow, SPE
Central Reexamination Unit 3993



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,441	10/07/2010	6,718,640	10-28743	4354
43025	7590	04/26/2011	EXAMINER	
LAUSON & TARVER LLP 880 APOLLO STREET SUITE 301 EL SEGUNDO, CA 90245			ART UNIT	PAPER NUMBER

DATE MAILED: 04/26/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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Lauson & Tarver LLP
880 Apollo Street
Suite 301
El Segundo, CA 90245

(For Patent Owner)

Miller, Canfield, Paddock and Stone, P.L.C.
277 South Rose Street
Suite 5000
Kalamazoo, MI 49007

(For Requester)

MAILED

APR 26 2011

In re John
Inter Partes Reexamination Proceeding
Control No. 95/001,441
Filed: October 7, 2010
For: U.S. Patent No. 6,718,640

:
: **DECISION** **CENTRAL REEXAMINATION UNIT**
: **GRANTING**
: **REQUEST FOR COPIES**
:

This decision is in response to the April 21, 2011 patent owner paper entitled "Petition Under 37 CFR 1.182", taken as a request for a copy of the documents purported to be filed under seal by the patent owner, received by the Office on April 12, 2011, to be sent to the patent owner.

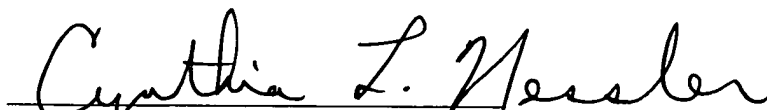
The April 21, 2010 request, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The \$25 document supply fee pursuant to 37 CFR 1.19(b) has been charged to deposit account nol. 50-3116, as authorized on page one of the present patent owner paper.

Petitioner states that counsel for the patent owner inadvertently filed its only copy of exhibits to the confidential declaration filed on April 12, 2011 pursuant to 37 CFR 1.59, and requests that a copy of these documents be sent to the patent owner. Accordingly, the April 21, 2010 request is **granted**. Pursuant to the rules and procedures of *inter partes* reexamination, a copy of the documents is also being sent by the Office to the requester, with a copy of this decision.

CONCLUSION

- The April 21, 2010 patent owner request is **granted**.
- Any inquiry concerning this decision should be directed to Senior Legal Advisor Cynthia L. Nessler, at (571) 272-7724.


Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,441	10/07/2010	6,718,640	10-28743	4354
43025	7590	07/22/2011	EXAMINER	
LAUSON & TARVER LLP 880 APOLLO STREET SUITE 301 EL SEGUNDO, CA 90245			ART UNIT	PAPER NUMBER

DATE MAILED: 07/22/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MILLER, CANFIELD, PADDOCK AND STONE, P.L.C.
277 SOUTH ROSE STREET
SUITE 5000
KALAMAZOO, MI 49007

Date:

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001441
PATENT NO. : 6718640
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal. -



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In re Patent No. 6,718,640
Reexam Control No.: 95/001,441
Filed: October 07, 2010
For: Cutting Tool

**RESPONSE TO PETITION
UNDER 37 CFR 1.59**

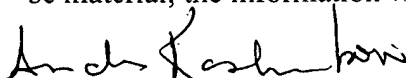
This is a response to the petition under 37 CFR 1.59(b), filed May 5, 2011, to expunge information from the above identified application.

The decision on the petition will be held in abeyance until the mailing of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC), at which time the petition will be decided.

Petitioner requests that documents included in a sealed enveloped submitted April 12, 2011, which documents include a confidential declaration by Earl Volotalo and accompanying exhibits be expunged from the record. Petitioner states that the documents are subject to a protective order in the United States District Court, Central District of California – Southern Division, Case No. SACV 09-0951 DOC(ANx). The petition also indicates that the information contained in the documents has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(g) has been paid.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is “material,” with “materiality” being defined as any information which the examiner considers as being important to a determination of patentability/confirmation of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified document is considered to be “material.” If the information is not considered by the examiner to be material, the information will be removed from the official file.


Andres Kashnikov,
SPE, CRU 3993
(571) 272-4361



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,441	10/07/2010	6,718,640	10-28743	4354
43025	7590	10/06/2011	EXAMINER	
LAUSON & TARVER LLP 880 APOLLO STREET SUITE 301 EL SEGUNDO, CA 90245			ART UNIT	PAPER NUMBER

DATE MAILED: 10/06/2011

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277 SOUTH ROSE STREET
SUITE 5000
KALAMAZOO, MI 49007

Date:

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001441
PATENT NO. : 6718640
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

**Decision Granting 37 CFR 1.59
Petition in Reexamination**

Control No.: **95/001,441**

1. The petition under 37 CFR 1.59 to expunge proprietary, protective order and/or trade secret documents under 37 CFR 1.59 filed **May 5, 2011** is granted.
2. The Patent owner's representative requests expungement of document(s) that have been filed under MPEP 724.02. The examiner has determined that the information in such document(s) presented under seal are not material to patentability in the instant reexamination proceeding. Further, the petitioner has complied with all of the requirements of MPEP 724.05.

A. ☒ Since the petition does not specify otherwise, the documents have been:

- i. ☒ Destroyed.
- ii. ☐ Expunged.

B. ☐ Other/Comment:

3. CONCLUSION

Telephone inquiries with regard to this decision should be directed to **Andres Kashnikow** at **571-272-4361**. In his/her absence, calls may be directed to _____ in the Central Reexamination Unit

Andres Kashnikow
[Signature]

SPE, CRU 3993
(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,449	09/23/2010	6450587		4668

25883 7590 07/22/2011
HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 07/22/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

MAILED
Date: **JUL 22 2011**
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001449
PATENT NO. : 6450587
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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HOWISON & ARNOTT, L.L.P.
P.O. BOX 741715
DALLAS, TX 75374-1715

(For Patent Owner)

MAILED

JUL 22 2011

CENTRAL REEXAMINATION UNIT

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,449
Filed: September 23, 2010
For: U.S. Patent No. 6,450,587

:
: **DECISION**
: **DISMISSING**
: **PETITION**

This decision is in response to third party requester's petition, filed on June 9, 2011, which requests that the director order the examiner to remove patent owner's response to the non-final Office action from the record. The petition state that the patent owner's response of May 10, 2011 is noncompliant with Office rules because the response exceeds the page limits set in 37 CFR 1.943. The petition is being treated as a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the patent owner's response.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit.

The third party requester's petition is **DISMISSED as premature** for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,450,587 (the '587 patent) issued on September 17, 2002.
2. A request for reexamination of the '587 patent was filed on September 23, 2010. The request was assigned control No. 95/001,449 (the '449 reexamination proceeding).
3. On December 10, 2010, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 7-11, 13-17, 26, 27, 29, 33, 34, 40, and 41 of '587 patent. On the same day, the Office mailed a non-final Office action.
4. On May 10, 2011, the patent owner's response was timely¹ filed.
5. On June 9, 2011, the third party requester filed comments.
6. On June 9, 2011, the third party requester filed the instant petition, which is being treated as a petition under 37 CFR 1.181, requesting that the director order the examiner to not enter the patent owner's response and to issue a notice of noncompliance regarding patent owner's response to the non-final Office action.
7. The examiner has not acted on the May 10, 2011 response and the June 9, 2011 comments to date.

DECISION

The third party requester (petitioner) states that they are seeking the director to order the examiner to remove patent owner's May 10, 2011 response from the record and to issue a notice of noncompliance regarding patent owner's response to the non-final Office Action. The petition states that the patent owner's response is noncompliant with Office rules because the response exceeds the page limits set in 37 CFR 1.943(b). The petition requests, that in the event the patent owner's response is removed from the record, the requester's June 9, 2011 comments be expunged from the record and that the requester be given 30 days from the date of service of any corrected patent owner response to file comments.

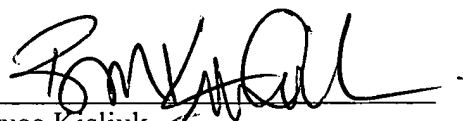
As stated above, there has been no decision by the examiner if the patent owner's response of May 10, 2011 is in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry of the May 10, 2011 comments because the examiner has not made his decision. Thus, the requester's June 9, 2011 petition is premature,

¹ A two-month extension of time was granted on February 4, 2011. An additional one-month extension of time was granted on April 11, 2011.

and accordingly, is dismissed.

CONCLUSION

1. The third party requester's petition, filed June 9, 2011, is DISMISSED as premature for the reasons discussed above.
2. Telephone inquiries related to this decision should be directed to Supervisory Patent Examiner Andy Kashnikow, at (571) 272-4361.



Bruce Kisliuk,

Assistant Deputy Commissioner for Patent Operations and Acting Director, Central
Reexamination Unit



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Howison & Arnott, LLP
P.O. Box 741715
Dallas, TX 75374-1715

:
: FOR PATENT OWNER
:

MAILED

JAN 10 2012

Kenyon & Kenyon LLP
One Broadway
New York, NY 10004

:
: FOR THIRD PARTY
: REQUESTER
:

CENTRAL REEXAMINATION UNIT

In re MacGregor et al.
Reexamination Proceeding
Control No. : 95/001,449
Filed: September 23, 2010
Patent No. 6,450,857

: **DECISION**
: **ON**
: **REQUESTER'S**
: **PETITION**
: **UNDER 37 CFR 1.181**

This is a decision addressing patent owner's petition, filed October 28, 2011 under 37 CFR 1.182, to strike requester Volkswagen Group of America, Inc.'s comments filed September 30, 2011. This petition is being treated as a petition filed under 37 CFR 1.181.

The petition is before the Group Director of the Central Reexamination Unit for decision.

SUMMARY

Patent owner's petition is DISMISSED as premature for the reasons set forth below, without consideration of the merits.

Brief Statement of Relevant Facts

1. Patent No. 6,450,857 (the '857 patent) issued on September 17, 2002.
2. A request for reexamination, assigned Control No. 95/001,449 (the '449 proceeding), was filed by a third party Requester on September 23, 2010.

3. Reexamination was ordered in the '449 reexamination proceeding on December 10, 2010. On even date, a non-final Office action was also mailed.
4. On May 10, 2011, patent owner filed a response to the non-final Office action¹.
5. On June 9, 2011, third party requester filed a response.
6. A notice of a defective paper in an inter partes reexamination, regarding patent owner's May 10, 2011 response, was mailed on August 19, 2011.
7. On September 2, 2011, patent owner filed a corrected response.
8. On September 30, 2011, third party requester filed an additional response.
9. On October 28, 2011, the instant petition was filed by patent owner.

Discussion

The patent owner requests the Office to strike third party requester's comments in the response of September 30, 2011. Patent owner argues that it did not submit any new arguments with its corrected response of September 2, 2011, but instead removed quotation of arguments from the examiner and those incorporated by the examiner from the third party requester and replaced the removed quotations with citations. Patent owner also states that he added a section discussing the relevant rules and recent court decisions. Patent owner then argues that since no new arguments were submitted with the corrected September 2, 2011 response and since comments submitted by third party requester on June 9, 2011 constitute a sufficient response to patent owner's arguments, the comments submitted by the third party requester on September 30, 2011 should be stricken from the record.

The request to strike third party requester's comments in the response of September 30, 2011 is
Dismissed as premature.

Statement of Relevant Authority

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within **two months** of the mailing date of the action or notice

¹ A two-month extension of time was granted on February 4, 2011. An additional one-month extension of time was granted on April 11, 2011.


from which relief is requested may be dismissed as untimely, except as otherwise provided. **This two-month period is not extendable.** (Emphasis added.)
...

Decision

The patent owner brings before the Office a petition under 37 CFR § 1.181 to strike third party requester's comments in the response of September 30, 2011. The patent owner filed the petition on October 28, 2011. However, there has been no decision by the examiner to either enter or not enter the third party requester's response of September 30, 2011. Accordingly, it is premature to invoke supervisory authority regarding striking of third party requester's September 30, 2011 response because the examiner has not made his or her decision. Thus, the present petition is premature, and it is dismissed.

Conclusion

1. The petition dated October 28, 2011 is dismissed as premature.
2. Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.



Irem Yucel, Director
Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,450	10/07/2010	7535658	100252-0006-US	5913
24341	7590	04/04/2011	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. (PA) 2 PALO ALTO SQUARE 3000 EL CAMINO REAL, SUITE 700 PALO ALTO, CA 94306			ART UNIT	PAPER NUMBER

DATE MAILED: 04/04/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PERKINS COIE LLP
P.O. BOX 1247
SEATTLE, WA 98111-1247

MAILED
Date: **APR 04 2011**

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001450
PATENT NO. : 7535658
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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3000 EL CAMINO REAL, SUITE 700
PALO ALTO CA 94306

(For Patent Owner)

MAILED

APR 04 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

PERKINS COIE LLP
PO BOX 1247
SEATTLE, WA 98111-1247

In re: Taniyama
Reexamination Proceeding
Control No. 95/001,450
Request Deposited: September 23, 2010
For: U.S. Patent No. 7,535,658

:
:
: **DECISION**
:
:

This decision addresses the February 8, 2011 Patent Owner (PO) paper entitled "REQUEST FOR CERTIFICATE OF CORRECTION OF INVENTORSHIP UNDER 37 C.F.R. §1.530 AND 37 C.F.R. §1.324" and the March 9, 2011 Third-Party Requester (3PR) paper entitled "THIRD PARTY REQUESTER'S COMMENTS IN OPPOSITION TO PATENT OWNER'S FILING OF CERTIFICATE OF CORRECTION UNDER 37 CFR §1.947".

The PO petition is **granted** with respect to the request to correct inventorship under 37 CFR 1.324.

However, the request for a certificate of correction is **dismissed**.

MPEP 2250.02 states, in part:

If the petition under 37 CFR 1.324 is granted, a certificate of correction indicating the change of inventorship will not be issued, because the reexamination certificate that will ultimately issue will contain the appropriate change of inventorship information.

Art Unit: 3992

Therefore, the patented file is not being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors because the reexamination certificate that will ultimately issue will contain the appropriate change of inventorship information.

Regarding the 3PR paper filed March 9, 2011 entitled "THIRD PARTY REQUESTER'S COMMENTS IN OPPOSITION TO PATENT OWNER'S FILING OF CERTIFICATE OF CORRECTION UNDER 37 CFR §1.947", the present opposition petition is non-statutory, and is being expunged as will now be explained.

Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within a period of 30 days from the date of service of a patent owner's response to an Office action on the merits pursuant to 37 CFR 1.945.

With respect to the March 9, 2011 requester paper opposing patent owner's petition under 37 CFR 1.324, neither 35 U.S.C. § 314(b)(2) nor the regulations provide any right for the third party requester to file an opposition to, or comment on, the patent owner's petition to correct inventorship. Such a petition is not a response to an "Office action on the merits." Rather, it goes to an issue that goes to formal requirements and is a matter within the discretion of the Office. Stated differently, as pointed out above, the requester is not responding to comment on a patent owner response to an Office action, but is instead commenting on the issue of whether the Office should grant a petition to correct inventorship. The latter is clearly a matter within the discretion of the USPTO Director, for which requesters were not granted a comment right by statute.

While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition to correct inventorship. No mechanism has been provided for the third party requester to file a paper, such as the March 9, 2011 paper, that is in response to an event other than a patent owner response to an Office action. Such rights were not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

A third party requester's opposition to a patent owner's petition to correct inventorship is a paper that is not permitted by the statute governing *inter partes* reexamination proceedings, and accordingly it was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. The paper is not a submission of written comments to a patent owner's response to an Office action; such third party written comments are the subject of a separate paper. Third party requester's opposition to patent owner's petition is therefore not enterable into the record.

Art Unit: 3992

It is to be noted that, while the requester may oppose a patent owner challenge to jurisdiction over a proceeding by the Office, the consideration of a request to correct inventorship is clearly within the Office's jurisdiction, and the Office may exercise its discretion in appropriate instances to grant such a petition. Note the discussion in MPEP § 2646 regarding an opposition to a petition to vacate an order granting a request for reexamination on the grounds that the order granting reexamination was an *ultra vires* act (such a jurisdictional issue is deemed to go to the merits, since it can result in the vacating or terminating a reexamination proceeding) and compare to the discussion in MPEP § 2667 regarding improper opposition petitions to challenge procedural issues (such as extensions of time, revival of terminated prosecution, withdrawal of finality, and the like). Therefore, the requester's opposition to patent owner's request to correct inventorship is not enterable into the record as a paper addressing the jurisdiction of the Office to act on the patent owner's request.

In view of the above, the opposition will be refused entry as an improper paper.

Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, the requester's March 9, 2011 opposition to the patent owner's February 8, 2011 petition requesting to correct inventorship does not have a right of entry into the record of the present reexamination proceeding, and, as such, is not an authorized paper. Because the opposition paper was incorporated into the electronic Image File Wrapper (IFW) for the proceeding before discovery of the impropriety of the paper, the original opposition paper cannot be physically returned to the third party requester. Rather, the requester's is being expunged from the record by closing the paper in the IFW and marking it "non-public." A copy of the present decision will be made of record in the IFW.

CONCLUSION

1. PO petition to correct inventorship is **granted**. However, the request to issue a certificate of correction is **dismissed**.
2. 3PR Petitioner's paper of March 9, 2011 is **expunged**.
3. Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.
4. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.



Eric Keasel

SPE, AU 3992, Central Reexamination Unit



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,450	10/07/2010	7535658	100252-0006-US	5913
24341	7590	09/12/2011	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. (PA) 2 PALO ALTO SQUARE 3000 EL CAMINO REAL, SUITE 700 PALO ALTO, CA 94306			ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2011

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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001450

PATENT NO. : 7535658

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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MORGAN, LEWIS & BOCKIUS, LLP (PA)
2 PALO ALTO SQUARE
3000 EL CAMINO REAL, SUITE 700
PALO ALTO CA 94306

(For Patent Owner)

PERKINS COIE LLP
P.O. BOX 1247
SEATTLE, WA 98111-1247

(For Third Party Requester)

In re Taniyama
Inter Partes Reexamination Proceeding
Control No. 95/001,450
Filed: October 7, 2010
For U.S. Patent Number 7,535,658

:
:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on third party requester's July 5, 2011 petition entitled, "PETITION TO ACCEPT NEW EVIDENCE AS NECESSARY TO REBUT OFFICE'S FINDINGS OF FACT UNDER 37 CFR §§ 1.183 AND 1.948(a)(1)," which is being taken as a petition requesting waiver of 37 CFR 41.63(c) to enter evidence on appeal.

The third party requestor's petition is before the Office of Patent Legal Administration.

The petition is dismissed.

REVIEW OF THE RELEVANT FACTS

1. On May 19, 2009, U.S. Patent No. 7,535,658 B2 ('the '658 patent) issued to Taniyama.
2. On September 23, 2010, a request for *inter partes* reexamination of claims 1-17 for the '658 patent was submitted by a third party requester, Largan Precision Co. Ltd., which was assigned control number 95/001,450 ("the '1450 proceeding"). After receipt of a corrected request, the '1450 proceeding was granted a filing date of October 7, 2010. An Order was issued for the *inter partes* reexamination on November 5, 2010, and a first Office action on the merits concurrently issued, confirming claims 1-8, 11 and 14-16, and rejecting claims 9-10, 12-13 and 17.
3. On January 13, 2011, the Office issued an Action Closing Prosecution (ACP) confirming claims 1-8, 11 and 14-16. Claims 9-10, 12-13 and 17 were withdrawn from consideration, because the patent owner did not timely file a response to the November 5, 2010 Office action.

4. On February 8, 2011, patent owner filed a petition entitled, "REQUEST FOR CERTIFICATE OF CORRECTION OF INVENTORSHIP UNDER 37 C.F.R. § 1.530 AND 37 C.F.R. § 1.324," requesting that an unnamed inventor be added to the patent and that a certificate of correction issue reflecting the addition of the unnamed inventor.
5. On April 1, 2011, the Office issued a Right of Appeal Notice (RAN) confirming claims 1-8, 11 and 14-16, and noting that claims 9-10, 12-13 and 17 were withdrawn from consideration.
6. On April 4, 2011, the Office issued a decision grant patent owner's petition to correct inventorship and add an unnamed inventor and dismissed the request to issue a certificate of correction pointing out that the reexamination certificate, when issued, will include the addition of the unnamed inventor.
7. On May 2, 2011, third party requester filed a notice of appeal.
8. On July 5, 2011, third party requester filed an appellant's brief and concurrently filed the present petition entitled PETITION TO ACCEPT NEW EVIDENCE AS NECESSARY TO REBUT OFFICE'S FINDINGS OF ACT UNDER 37 CFR §§ 1.183 AND 1.948(a)(1)," which is being taken as a petition requesting waiver of 37 CFR 41.63(c) to enter evidence on appeal; specifically, the references contained in appellant's brief exhibits G-K.
9. On August 5, 2011, patent owner filed a respondent's brief.
10. On August 17, 2011, the Office issued a notice of non-compliant patent owner respondent's brief.

RELEVANT AUTHORITY

37 CFR 1.183 states:

In an extraordinary situation, when justice re-quires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.947 states:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8. [Emphasis added]

37 CFR 1.948 states:

(a) After the inter partes reexamination order, the third party requester may only cite additional prior art as defined under § 1.501 if it is filed as part of a comments submission under § 1.947 or § 1.951(b) and is limited to prior art:

(1) which is necessary to rebut a finding of fact by the examiner;

(2) which is necessary to rebut a response of the patent owner; or

(3) which for the first time became known or available to the third party requester after the filing of the request for inter partes reexamination proceeding. Prior art submitted under paragraph (a)(3) of this section must be accompanied by a statement as to when the prior art first became known or available to the third party requester and must include a discussion of the pertinency of each reference to the patentability of at least one claim.

37 CFR 41.63(c) states:

Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

MPEP 2673.01 I states (in pertinent part):

As opposed to the examiner making a new ground of rejection, if a new finding of patentability is made (i.e., a ground of rejection is withdrawn or an additional claim is indicated as patentable), prosecution need not be reopened. The third party requester has no right to comment on and address a finding of patentability made during the reexamination proceeding until the appeal stage, unless the patent owner responds (after which the third party requester may file comments). Thus, the third party requester may address any new finding of patentability at the appeal stage in the same manner that it would address a finding of patentability made during the reexamination proceeding where the patent owner does not respond (e.g., all claims are allowed on the first Office action and the patent owner sees no reason to respond). [Emphasis added]

DECISION

On July 5, 2011, third party requester filed a petition under 37 CFR 1.183 requesting waiver of 37 CFR 41.63(c) to permit entry of evidence on appeal to rebut a finding of fact by the examiner in accordance with 37 CFR 1.948(a)(1). Specifically, a request for entry of the documents contained in Exhibits G thru K, which are attached to the concurrently-filed appellant's brief.¹

¹ Exhibit G is a newly cited non-patent literature reference; Exhibits H and J are two Japanese patents; and Exhibits I and K are machine translated English language translations of the two Japanese patents in exhibits H and J, respectively.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

Requester's asserted equitable basis for entry of evidence on appeal is that requester has never had an opportunity to respond to any Office action during the prosecution of the proceeding, due to the fact that the patent owner did not exercise its option of filing a response to any Office action that issued prior to appeal. Further, requester asserts that at least exhibits H, I, J and K should be entered because they constitute admitted prior art, since they were cited in the background of the '658 patent.

Pursuant to 37 CFR 1.947, requester's comments are limited to issues raised by the previous Office action and by patent owner's response. In the present instance, however, the patent owner did not file a response to any Office action that was issued prior to appeal. For this reason, the requester may, on petition, request the entry of evidence which, for example, rebuts a finding of fact by the examiner in any of the Office actions that issued prior to appeal, pursuant to 37 CFR 1.948(a).² In this instance, however, the requester has not truly identified any fact(s) in any of the previous Office actions to which the presently proffered rebuttal evidence is directed.

The only asserted finding of fact that requester has identified as being rebutted by the proffered evidence is, "the finding of fact by the examiner that contends that it is not obvious to replace a glass lens with one made of a resin material."³ The examiner's statement, however, is not a "finding of fact"; rather, it is a conclusion of law - specifically, a conclusion of non-obviousness.⁴ Thus, no finding of fact has been identified by the requester. In addition, requester does not cite to any teaching in any of the documents as the basis of the factual rebuttal. Nor does the requester explain how any of the newly submitted documents rebuts an examiner's finding of fact.

Therefore, the requester has not provided sufficient evidence that the present submission of exhibits G-K is necessary to rebut a finding of fact by the examiner pursuant to 37 CFR 1.948(a).

The discussion in the background section of the '658 patent, of Japanese patent publications JP-A-2005-4027 and JP-A-2005-4028, which are attached to requester's concurrently-filed appellant's brief as exhibits H and J, respectively, does not remedy requester's failure to properly establish an evidentiary rebuttal of a finding of fact. These Japanese patent publications have not been made of record in the reexamination proceeding, and for this reason, have the same status as any other document that has not been made of record in the reexamination proceeding. Thus, entry of the documents contained in Exhibits H and J of requester's appellant brief, is not permissible under the rules.

The fact that requester did not have an opportunity to file comments until the appeal stage, alone, does not permit requester to submit evidence on appeal that fails to comply with at least the

² Documents properly submitted under 37 CFR 1.948(a) may be cited in a list of citations, and may be made of record in the reexamination proceeding. However, note, in contrast, that any *proposed rejection* based on documents properly submitted under 37 CFR 1.948(a) must also be necessitated by patent owner's amendment.

³ Petition at page 1.

⁴ See MPEP 2142

provisions of 37 CFR 1.948. Accordingly, the requester has simply not provided a sufficient showing of extraordinary circumstances, such that justice requires waiver of the provisions of 37 CFR 41.63(c).

CONCLUSION

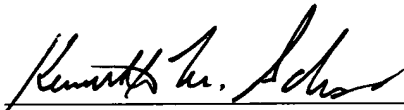
1. The petition is **dismissed**.
2. Any further correspondence with respect to this matter should be addressed as follows:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail: Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By Hand: Customer Service Window
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759, or, in his absence, to Cynthia L. Nessler, Senior Legal Advisor, at 571-272-7724.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

9/12/2011
kenAppeal/Decisions/Entry Issues/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,453	09/28/2010	7,601,662	04119.000100.36	2755
48226	7590	05/25/2011	EXAMINER	
BASF CATALYSTS LLC 100 CAMPUS DRIVE FLORHAM PARK, NJ 07932			ART UNIT	PAPER NUMBER

DATE MAILED: 05/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FITZPATRICK, CELLA, HARPER & SCINTO
1290 AVENUE OF THE AMERICAS
NEW YORK, NY 10104-3800

Date:

MAILED

MAY 25 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001453
PATENT NO. : 7601662
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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BASF CATALYSTS LLC
100 CAMPUS DRIVE
FLORHAM PARK, NJ 07932

(For Patent Owner)

FITZPATRICK, CELLA, HARPER & SCINTO
1290 AVENUE OF THE AMERICAS
NEW YORK, NY 10104-3800

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,453
Filed: September 28, 2010
For: U.S. Patent No. 7,601,662

: **DECISION DISMISSING**
: **PETITION, EXPUNGING**
: **IMPROPER PAPER, AND**
: ***SUA SPONTE* WAIVING**
: **PATENT OWNER**
: **PAGE LIMIT**

This is a decision on the February 15, 2011 patent owner petition entitled "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943 PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 65 pages. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.¹

The petition is before the Office of Patent Legal Administration for consideration.

The petition is dismissed for the reasons set forth below.

The present decision also *sua sponte* waives the requirement of 37 CFR 1.943(b) to the extent that any resubmitted response by patent owner to the November 16, 2010 Office action, filed in response to this decision, is identical to the February 15, 2011 submission as a corrected submission, with the exception that the line spacing of the single-spaced declarations accompanying the present response is increased to one and a half or double spaced. **This waiver**

¹ It is acknowledged that in addition to the patent owner response and petition under 37 CFR 1.183 that were filed electronically by EFS-Web on February 15, 2011, patent owner also filed a separate paper entitled "PATENT OWNER'S SUPPLEMENTAL AMENDMENT AND RESPONSE UNDER 37 C.F.R. § 1.941" by Express Mail on February 15, 2011 to include annotated drawings in red in order to comply with 37 CFR 1.530(d). The drawings in the "supplemental amendment" are identical to those electronically submitted.

is conditional on the submission of the patent owner being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.

For the reasons set forth below, the February 15, 2011 patent owner's response is an improper paper and is being expunged without consideration by the examiner. Since the February 15, 2011 patent owner response has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) of the present reexamination proceeding, the February 15, 2011 patent owner response is being expunged from the record by closing it and marking it "not public."

Patent owner has **fifteen (15) days (not-extendable)** from the mailing date of this decision to re-submit a corrected response to the November 16, 2010 non-final Office action, as discussed below.

If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the Office action or the patent owner's response to this decision, **within 30 days from the date of service of the patent owner's response to this decision.**

DECISION

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on February 15, 2011 to address the November 16, 2010 non-final Office action, and requests that the page limit be extended to 65 pages.² In support of its request for waiver of the rule, patent owner contends that the request for the present reexamination proceeding is seventy-seven pages in length and contains anticipation or obviousness arguments of patent owner's patent using ten references.³ Furthermore, patent owner asserts that the Office action rejects all original thirty-eight claims of the patent and that several declarations would be required to support patent owner's argument.⁴

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of the resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response submission: (1) for justification that more pages are needed to complete the response submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response submission.

² Petition at 1.

³ Petition at 2.

⁴ *Id.*

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's February 15, 2011 response includes 30 pages of remarks and one page of claim support, which are subject to the 50 page limit.

The patent owner's response is also accompanied by six declarations under 37 CFR 1.132. The six declarations are those of Dr. Gary L. Haller, Dr. David H. Olson, Dr. Ahmad Moini, Pramod Ravindran, Dr. Stanely Roth, and Dr. Stacey I. Zones.

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The 10-page declaration of Haller is replete with legal arguments. For this reason, the entirety of the Haller declaration is counted toward the page limit. Examples of legal arguments in the Haller declaration, which are not exhaustive, that count toward the page limit are:

On page 4, in paragraph 12, declarant Haller states: "The Office Action focuses on Example 3 (of 16 examples) of Yuen to combine with information in Ritscher...[t]he selection of Example 3 appears to be random and no reasoning or information is provided as to why this example would provide a catalyst for the reduction of oxides of nitrogen oxides that is best among the 16 examples."

On page 4, in paragraph 15, declarant Haller states: "A person of skill in the art would not use the information in Ritscher in combination with Yuen..."

On page 5, in paragraph 17, declarant Haller states: "This hardly provides a reason to a person of ordinary skill in the art to use the Example in Ritscher and to use a similar amount of copper in Yuen...[i]f anything, the skilled artisan would avoid using the information in Ritscher..."

On page 7, in paragraph 24, declarant Haller states: "Thus, even if the person of skill in the art ignored the differences between the materials...that would provide little reason for a person of ordinary skill in the art to utilize the information in Ishiraha et al. to modify the zeolite in Zones."

The 10-page declaration of Olson is replete with legal arguments. For this reason, the entirety of the Olson declaration is counted toward the page limit. Examples of legal arguments in the Olson declaration, which are not exhaustive, that count toward the page limit are:

On page 3, in paragraph 10, declarant Olson states: "The Office Action selects Example 3 from Yuen to combine with information in Ritscher, but there is no explanation provided as to why Example 3 would be selected from the other fifteen examples in Yuen..."

On page 3, in paragraph 12, declarant Olson states: "A person skilled in the art reading Yuen and Ritscher would not have a reason to select copper...in Yuen to the exclusion of any of the other metals."

On page 6, in paragraph 24, declarant Olson states: "Accordingly, the two references would not lead a person of ordinary skill in the art to make the invention claimed in claims 1-11 of the '662 patent."

On page 7, in paragraph 25, declarant Olson states: "With regard to the rejection of Dedecek in view of Chung, it is first noted that Dedecek does not teach..."

On page 9, in paragraph 34, declarant Olson states: "Accordingly, one of ordinary skill in the art would not modify the zeolites ...in Dedecek...to provide the invention in claims 1-11..."

Statements such as those quoted above do not provide the Office with factual evidence.

The declarations of Moini, Ravindran, Roth, and Zones are determined to be free of legal argument

Accordingly, the February 15, 2011 patent owner response includes 51 pages which are counted toward the page limit.

The patent owner's February 15, 2011 response is 51-pages, which exceeds the 37 CFR 1.943(b) 50-page limit. Therefore, the entire patent owner response submission filed on February 15, 2011, is subject to return to the patent owner. See MPEP 2667, Part I.A.2. The copy of the February 15, 2011 response submission was, however, scanned into the Office's electronic Image File Wrapper (IFW) of the proceeding, before the discovery of the impropriety. Thus, the copy cannot be physically returned to the patent owner. Rather, the IFW copy of the paper is being expunged, by closing it in the IFW file of the present proceeding and marking it "not public." It will not constitute part of the record of the present reexamination proceeding.

In a balancing of the equities, the Office *sua sponte* waives the requirement of 37 CFR 1.943(b) to the extent for any resubmitted response by patent owner to the November 16, 2010 Office action, filed in response to this decision, that is identical to the February 15, 2011 response submission as a corrected response submission, with the sole exception that the line spacing of the single-spaced declarations accompanying the present response submission is increased to one and a half or

double spaced. **This waiver is conditional on the submission of the patent owner being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**

The March 15, 2011 third party requester comments filed in response to the improper February 15, 2011 patent owner response will not be considered.

PATENT OWNER OPTIONS

For the reasons given above, the February 15, 2011 patent owner response exceeds the 50-page limit established by 37 CFR 1.943(b). It is apparent, however, from the record that patent owner's response is a *bona fide* attempt to respond and to advance the prosecution.

Accordingly, patent owner may, **within 15 days from the date of this decision** to resubmit a corrected response submission pursuant to the guidelines set forth in this decision. This 15-day period for reply is **not extendable**.

In order to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes and electronic capture by digital imaging and optical character recognition pursuant to 37 CFR 1.52(a)(1)(v).

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52.


The entire submission must be one and a half or double spaced, with the exception of reference materials, claim charts, tables of contents, and curriculum vitae. It is noted that each of the declarations accompanying the present patent owner response submission, with the exception of the Roth and Ravindran declarations, are single-spaced.

REQUESTER OPTIONS

If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the **third party requester** may once file written comments, limited to issues raised by the Office action or the patent owner's response to this decision, **within 30 days from the date of service of the patent owner's response to this decision**.

CONCLUSION

1. Patent owner's February 15, 2011 petition is **dismissed**. The patent owner's response submission filed on February 15, 2011 is an improper paper, and therefore will **NOT be made a part of the record** of the present reexamination proceeding.
2. Since patent owner's February 15, 2011 response and accompanying declarations and exhibits were scanned into the electronic Image File Wrapper (IFW) of the present reexamination proceeding, these papers are **expunged** by closing them in the present reexamination proceeding's IFW file and marking them as "non-public."
3. The March 15, 2011 third party requester comments filed in response to the improper February 15, 2011 patent owner response will not be considered.
4. This decision *sua sponte* waives the provisions of 37 CFR 1.943(b) to the extent that any resubmitted response by patent owner to the November 16, 2010 Office action, filed in response to this decision, is identical to the February 15, 2011 submission as a corrected submission, with the sole exception that the line spacing of the single-spaced declarations accompanying the present response is increased to one and a half or double spaced. **This waiver is conditional on the submission of the patent owner being in at least 12 point font and one-and-a-half or double spaced, with appropriate margins.**
5. Patent owner is **given** a **15-day non-extendable** time period to resubmit a response pursuant to the guidelines set forth in this decision. If no response is timely received from the patent owner, the February 15, 2011 patent owner response will remain expunged, and the proceeding will be terminated or limited pursuant to 37 CFR 1.957.
6. If a resubmitted patent owner response pursuant to this decision is timely received, then under 37 CFR 1.947, the third party requester may once file written comments, limited to issues raised by the November 16, 2010 Office action or by patent owner's response to this Office action, **within 30 days from the date of service of the resubmitted patent owner response, filed pursuant to this decision.**
7. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,453	09/28/2010	7,601,662	04119.000100.36	2755
48226	7590	09/01/2011	EXAMINER	
BASF CORPORATION 100 CAMPUS DRIVE FLORHAM PARK, NJ 07932			ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

FITZPATRICK, CELLA, HARPER & SCINTO

1290 AVENUE OF THE AMERICAS

NEW YORK, NY 10104-3800

Date:

MAILED

SEP 01 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001453

PATENT NO. : 7601662

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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SEP 01 2011

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NEW YORK, NY 10104-3800

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

In re Bull et al
Inter Partes Reexamination Proceeding
Control No. 95/001,453
Filed: September 28, 2010
For: U.S. Patent No. 7,601,662

:
: **DECISION**
: **ON**
: **PETITION**
:

This decision addresses:

- The June 29, 2011 patent owner petition entitled "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)", which is taken as a petition to revive an unintentionally terminated reexamination proceeding (patent owner's June 29, 2011 petition under 37 CFR 1.137(b));
- The June 29, 2011 patent owner petition entitled "Petition under 37 CFR 1.183", which requests various forms of relief (patent owner's June 29, 2011 petition under 37 CFR 1.183); and
- The July 27, 2011 requester petition entitled "Petition Under 37 CFR 1.182 to Require Patent Owner to Resubmit Exhibits to Declarations and Refuse Patent Owner's Supplementary Disclosure Statements" (requester's July 27, 2011 petition under 37 CFR 1.182).

Patent owner's June 29, 2011 petition to revive, patent owner's petition under 37 CFR 1.183, requester's July 27, 2011 petition under 37 CFR 1.182, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The June 29, 2011 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

The June 29, 2011 patent owner petition under 37 CFR 1.183, with respect to its request for waiver of the \$1620 petition fee for reviving the present proceeding, and patent owner's alternative request for a refund of the petition fee for reviving the present proceeding, are **dismissed**.

The aspect of patent owner's alternative petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.957(d), to withdraw the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and to reopen prosecution, is **dismissed as moot**.

The July 27, 2011 requester petition under 37 CFR 1.182 is **dismissed as moot**.

The May 25, 2011 decision is **vacated only to the extent that** the drawings filed on February 15 and 16, 2011, the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran, and the exhibits which accompanied the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, and Stanley Roth, Ph.D., respectively, **are not being expunged, and will remain of record**.

DECISION

Patent Owner's Petition under 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted, with the present petition, a petition fee under 37 CFR 1.17(m), and a proper statement under 37 CFR 1.137(b)(3), which satisfy items (2), and (3), respectively.

Regarding item (1), the patent owner has submitted, with the present petition, a corrected response submission which responds to the November 16, 2010 nonfinal Office action, and which is in accordance with the guidelines set forth in the Office's decision of May 25, 2011. Specifically, the patent owner has submitted a statement that the corrected response submission filed on June 29, 2011 is identical to the response submission submitted on February 15, 2011, with the exception of the line spacing and of the table of contents, which has been updated to reflect changes in page numbering due to the changes in the line spacing. Furthermore, pursuant to the telephone conversation of June 28, 2011 between Ms. Cynthia L. Nessler, Senior Legal Advisor, Office of Patent Legal Administration, and Mr. Scott S. Servilla, attorney of record for the patent owner (the June 28, 2011 telephone conversation), the May 25, 2011 decision is **vacated only to the extent that** the drawings filed on February 15 and 16, 2011, the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran, and the exhibits which accompanied the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, and Stanley Roth, Ph.D., respectively, **are not being expunged, and will remain of record**. The February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran will remain of record due to their resubmission, on June 29, 2011, with corrected line spacing in

accordance with the May 25, 2011 decision, pursuant to the June 28, 2011 telephone conversation.¹

In view of the above, the June 29, 2011 corrected response submission is considered to include:

- the amendments and remarks submitted on June 29, 2011,
- the drawings submitted on February 15 and 16, 2011,
- the declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran, filed on February 15, 2011 and on June 29, 2011, which, taken together, are deemed to be the declarations of record that are included with the June 29, 2011 corrected response submission; and
- the exhibits, filed on February 15, 2011, which accompanied the declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, and Stanley Roth, Ph.D., respectively.

For the reasons given above, the June 29, 2011 corrected response submission, including all of the elements set forth above, satisfies item (1).²

Accordingly, the June 29, 2011 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding³ is **granted**.

Patent Owner's Petition under 37 CFR 1.183

The patent owner requests the following:

- Waiver of the \$1620 fee for the petition to revive the present proceeding, or alternatively, a refund of the petition fee under “37.C.F.R.2.209(a)” [sic]; or
- Alternatively, a) suspension/waiver of 37 CFR 1.957(d), b) a “waiver”, which is taken as a request to withdraw, the 15-day non-extendable time period set in the Office’s decision mailed May 25, 2011 to resubmit a response submission in compliance with the guidelines set forth in the decision, and c) reopening of prosecution to enter and consider patent owner’s concurrently-filed response.

¹ The Office notes that the dates of execution of the declarations filed on June 29, 2011 are identical to the dates of execution of the declarations filed on February 15, 2011. The declarations filed on February 15, 2011 and June 29, 2011, taken together, are deemed to constitute the declarations under 37 CFR 1.132 of record, which are included in patent owner’s June 29, 2011 response submission.

² See MPEP 2668 IV and MPEP 711.03(c) II A 2 (a). Note that the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.

³ Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was “terminated” for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the nonfinal Office action.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on the patent owner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule.

The patent owner, in the present petition, requests waiver of the fee for filing a petition under 37 CFR 1.137(b) to revive a terminated reexamination proceeding. Alternatively, the patent owner requests a refund of the petition fee in accordance with 37 CFR 2.209(a), which is a trademark regulation that does not govern patent cases.⁴ However, the fee for filing a petition to revive a reexamination prosecution which was terminated due to the filing of an unintentionally delayed response by the patent owner is a statutory fee, and it cannot be waived. See 35 U.S.C. 41(a)(7), which provides, in pertinent part:

REVIVAL FEES. — On filing each petition . . . for an unintentionally delayed response by the patent owner in any reexamination proceeding . . .

For this reason, patent owner's petition under 37 CFR 1.183 to waive the \$1620 petition fee for reviving the present proceeding, and patent owner's alternative request for a refund of the petition fee to revive the present proceeding, are dismissed.

Patent owner's alternative petition under 37 CFR 1.183 requests that the Office a) waive the provisions of 37 CFR 1.957(d), b) "waive", i.e., withdraw, the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and c) reopen prosecution. As an initial matter, however, the Office is not authorized to treat patent owner's alternative petition *in lieu of* a grantable petition to revive, because the Office is not authorized to continue prosecution in a terminated proceeding. The proceeding must first be revived before prosecution may continue. Patent owner's concurrently-filed petition under 37 CFR 1.137(b) is granted, and the present proceeding is revived, pursuant to this decision.

The patent owner alternatively requests waiver of 37 CFR 1.957(d), which provides, in pertinent part:

- When action by the patent owner is a *bona fide* attempt to respond and to advance the prosecution and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, an opportunity to explain and supply the omission may be given.

37 CFR 1.957(d), however, does not impose a requirement on the patent owner, and merely provides the patent owner with an opportunity to resubmit a response submission. In other words, there is no requirement in 37 CFR 1.957(d) for the Office to waive, and for this reason, patent owner's alternative petition to waive 37 CFR 1.957(d) is dismissed as moot. In any event, the Office's May 25, 2011 decision, which held that patent owner's February 15, 2011 response was a *bona fide* attempt to respond and to advance the prosecution, and which provided patent owner with an opportunity to submit a corrected response submission within 15 days from

⁴ 37 CFR 1.26 governs requests for refunds in patent cases.

the mail date of the decision, was in full accordance with the rule. The patent owner, however, failed to respond within the time period set by the decision, causing the present reexamination prosecution to be terminated. See 37 CFR 1.957(b)-(c).

The patent owner appears to be alternatively requesting the Office to “waive” the 15-day non-extendable time period set by the May 25, 2011 decision, i.e., to withdraw the May 25, 2011 decision to the extent that the 15-day non-extendable time period to resubmit a response submission would be extended, and also appears to be requesting a reopening of prosecution. Patent owner’s alternative petition under 37 CFR 1.183 requesting the Office to withdraw the 15-day non-extendable time period to resubmit comments and to reopen prosecution, however, is moot in view of the present decision, which grants patent owner’s petition under 37 CFR 1.137(b) to revive the present proceeding. The patent owner has already resubmitted a response submission with its concurrently-filed petition to revive, rendering moot the need to resubmit a response submission. Also, when a petition to revive is granted in a reexamination proceeding, as is the case here, then by definition, prosecution is reopened. Thus, any request to withdraw the 15-day time period to resubmit a response submission and to reopen of prosecution is moot in view of patent owner’s concurrently-filed, grantable petition to revive. It is further to be noted that when relief is available under an existing rule, an extraordinary situation, where justice requires waiver is not presented. In this instance, relief is available under 37 CFR 1.137.

If the patent owner had desired to request a review of the May 25, 2011 decision, a petition under 37 CFR 1.181 must have been filed by the patent owner by July 25, 2011, pursuant to 37 CFR 1.181(f).⁵ The patent owner has not done so.⁶

For the reasons given above, the circumstances in the present case are not deemed to be extraordinary, such that justice requires waiver of the rule.

Accordingly, patent owner’s alternative petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.957(d), to withdraw the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and to reopen prosecution, is dismissed.

Additional Comments

The patent owner argues that “there is no rule requiring declarations submitted in *Inter Partes* Reexamination proceedings to have a line spacing of one-and-a-half”. The patent owner further argues that 37 CFR 1.52 fails to state that declarations “should or must have lines that are 1 ½ or double spaced”. However, the patent owner in this instance requested a *waiver* of the rules. On February 15, 2011, the patent owner filed a petition under 37 CFR 1.183 to waive the page-

⁵ 37 CFR 1.181(f) provides, in pertinent part:

Any petition [under 37 CFR 1.181] not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely . . . This two-month period is not extendable.

⁶ The patent owner is also reminded that any subsequently-filed petition under 37 CFR 1.181 to review the May 25, 2011 decision may be dismissed as untimely.

length provisions of 37 CFR 1.943(b) for its concurrently-filed response. The patent owner, however, failed to comply with the conditions under which such a waiver would be granted. The May 25, 2011 decision, which treated patent owner's February 15, 2011 petition under 37 CFR 1.183, set forth the formatting requirements, including line spacing of one-and-a-half, which are *conditions under which a waiver of the rules*, i.e., of the page limit requirements of 37 CFR 1.943(b) *would be granted*.⁷

The July 27, 2011 Requester Petition under 37 CFR 1.182

The requester requests the Office to require the patent owner to resubmit the exhibits to the declarations originally filed on February 15, 2011. However, these exhibits are now of record, pursuant to this decision. The requester also requests the Office "to require the Patent Owner to serve" [the requester] with the supplementary disclosure statements filed by the patent owner on May 6, 2011 and July 15, 2011. However, the certificate of service filed by the patent owner on August 1, 2011 (after the filing of the requester petition) states that requester has been served with both the May 6, 2011 and the July 15, 2011 supplementary disclosure statements.

Accordingly, for the reasons given above, the July 27, 2011 requester petition under 37 CFR 1.182 is **dismissed as moot**.

THIRD PARTY REQUESTER OPTIONS

Requester's July 27, 2011 comments submission **will not be considered**, because the reexamination proceeding was terminated at the time of filing the comments submission.

Patent owner's June 29, 2011 response submission did not become effective until the mail date of this decision. For this reason, **requester is given thirty (30) days from the mail date of this decision to either (a) ratify its July 27, 2011 comments submission or (b) file a new comments submission**. This 30-day time period is statutory and cannot be waived or extended.

CONCLUSION

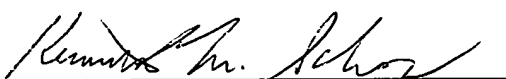
- The June 29, 2011 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.
- The June 29, 2011 patent owner petition under 37 CFR 1.183 to waive the \$1620 petition fee for reviving the present proceeding, and patent owner's alternative request for a refund of the petition fee for reviving the present proceeding, are **dismissed**.

⁷ See page 5 of the May 25, 2011 decision, which stated, in pertinent part (emphasis in bold in original):

In order to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a submission that:

- 1) is one-and-a-half or double-spaced . . .

- Patent owner's alternative petition under 37 CFR 1.183, also filed on June 29, 2011, to waive the provisions of 37 CFR 1.957(d), to withdraw the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and to reopen prosecution, is **dismissed as moot**.
- The July 27, 2011 requester petition under 37 CFR 1.182 is **dismissed as moot**.
- Requester's July 27, 2011 comments submission **will not be considered**, because the reexamination proceeding was terminated at the time of filing the comments submission.
- The third party requester is given **thirty (30) days** from the mail date of this decision to either ratify its July 27, 2011 comments submission or to file a new comments submission. This time period is statutory and cannot be waived or extended.
- Any inquiry concerning this decision should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

8/31/2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,453	09/28/2010	7,601,662	04119.000100.36	2755
48226	7590	09/08/2011	EXAMINER	
BASF CORPORATION 100 CAMPUS DRIVE FLORHAM PARK, NJ 07932			ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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NEW YORK, NY 10104-3800

Date:

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SEP 08 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001453
PATENT NO. : 7601662
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)



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(For Patent Owner)

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(For Third Party Requester)

In re Bull et al
Inter Partes Reexamination Proceeding
Control No. 95/001,453
Filed: September 28, 2010
For: U.S. Patent No. 7,601,662

: SUPPLEMENTAL
: DECISION
: ON
: PETITION
:

This decision is **supplemental** to the decision mailed September 1, 2011, which granted patent owner's June 29, 2011 petition under 37 CFR 1.137(b) to revive the present reexamination proceeding. This decision **vacates** the September 1, 2011 decision **only to the extent that** the September 1, 2011 decision granted patent owner's June 29, 2011 petition under 37 CFR 1.137(b) to revive, and vacated the May 25, 2011 decision.

The portions of the Office's September 1, 2011 decision that 1) dismissed the June 29, 2011 patent owner petition under 37 CFR 1.183 to waive the \$1620 petition fee for reviving the present proceeding, and patent owner's alternative request for a refund of the petition fee for reviving the present proceeding, 2) dismissed as moot the aspect of patent owner's alternative petition under 37 CFR 1.183, also filed on June 29, 2011, to waive the provisions of 37 CFR 1.957(d), to withdraw the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and to reopen prosecution, and 3) dismissed as moot requester's July 27, 2011 petition under 37 CFR 1.182, **are not vacated, and are being maintained**.

However, due to an apparent oversight, the exhibits accompanying the February 15, 2011 declaration of Pramod Ravindran were not included in the list of exhibits that were not being expunged, and were to remain of record, in the September 1, 2011 decision. The exhibits accompanying the February 15, 2011 declaration of Pramod Ravindran were inadvertently excluded from the determination in the September 1, 2011 decision of the contents of the June 29, 2011 corrected response submission by the patent owner, which was held to satisfy the requirement, under 37 CFR 1.137(b), that the petition to revive be accompanied by a response to the outstanding Office action. For this reason, the September 1, 2011 decision **is vacated only to the extent that** the September 1, 2011 decision granted patent owner's June 29, 2011 petition under 37 CFR 1.137(b) to revive, and vacated the May 25, 2011 decision.

Patent Owner's Petition under 37 CFR 1.137(b)

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a response to the outstanding Office action, (2) the petition fee set forth in 37 CFR 1.17(m), and (3) a proper

statement under 37 CFR 1.137(b)(3) that the entire delay in filing the required response from the due date of the response to the filing of a grantable petition was unintentional. The patent owner has submitted, with its June 29, 2011 petition, a petition fee under 37 CFR 1.17(m), and a proper statement under 37 CFR 1.137(b)(3), which satisfy items (2), and (3), respectively.

Regarding item (1), the patent owner has submitted, with its June 29, 2011 petition, a corrected response submission which responds to the November 16, 2010 nonfinal Office action, and which is in accordance with the guidelines set forth in the Office's decision of May 25, 2011. Specifically, the patent owner has submitted a statement that the corrected response submission filed on June 29, 2011 is identical to the response submission submitted on February 15, 2011, with the exception of the line spacing and of the table of contents, which has been updated to reflect changes in page numbering due to the changes in the line spacing. Furthermore, pursuant to the telephone conversation of June 28, 2011 between Ms. Cynthia L. Nessler, Senior Legal Advisor, Office of Patent Legal Administration, and Mr. Scott S. Servilla, attorney of record for the patent owner (the June 28, 2011 telephone conversation), the May 25, 2011 decision is **newly vacated only to the extent that** the drawings filed on February 15 and 16, 2011, the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran, and the exhibits which accompanied the February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., **and Pramod Ravindran, respectively, are not being expunged, and will remain of record.** The February 15, 2011 declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran will remain of record due to their resubmission, on June 29, 2011, with corrected line spacing in accordance with the May 25, 2011 decision, pursuant to the June 28, 2011 telephone conversation.¹

Thus, the June 29, 2011 corrected response submission is now considered to include:

- the amendments and remarks submitted on June 29, 2011,
- the drawings submitted on February 15 and 16, 2011,
- the declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., Stacey I. Zones, Ahmad Moini, Ph.D., and Pramod Ravindran, filed on February 15, 2011 and on June 29, 2011, which, taken together, are deemed to be the declarations of record that are included with the June 29, 2011 corrected response submission; and
- the exhibits, filed on February 15, 2011, which accompanied the declarations under 37 CFR 1.132 of Gary L. Haller, David H. Olson, Stanley Roth, Ph.D., and **Pramod Ravindran**, respectively.

¹ The Office notes that the dates of execution of the declarations filed on June 29, 2011 are identical to the dates of execution of the declarations filed on February 15, 2011. The declarations filed on February 15, 2011 and June 29, 2011, taken together, are deemed to constitute the declarations under 37 CFR 1.132 of record, which are included in patent owner's June 29, 2011 response submission.

For the reasons given above, the June 29, 2011 corrected response submission, including all of the elements set forth above, satisfies item (1).²

Accordingly, the June 29, 2011 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding³ is **granted**.

THIRD PARTY REQUESTER OPTIONS

Requester's July 27, 2011 comments submission is **currently not of record, and will not be considered**, because the reexamination proceeding was terminated at the time of filing the comments submission.

Patent owner's June 29, 2011 response submission did not become effective until the mail date of this supplemental decision. For this reason, **requester is given thirty (30) days from the mail date of this supplemental decision to either ratify its July 27, 2011 comments submission or file a new comments submission**. This time period is statutory and cannot be waived or extended.

CONCLUSION

- The September 1, 2011 decision **is vacated only to the extent that** the September 1, 2011 decision granted patent owner's June 29, 2011 petition under 37 CFR 1.137(b) to revive, and vacated the May 25, 2011 decision.
- The portions of the Office's September 1, 2011 decision that 1) dismissed the June 29, 2011 patent owner petition under 37 CFR 1.183 to waive the \$1620 petition fee for reviving the present proceeding, and patent owner's alternative request for a refund of the petition fee for reviving the present proceeding, 2) dismissed as moot patent owner's alternative petition under 37 CFR 1.183, also filed on June 29, 2011, to waive the provisions of 37 CFR 1.957(d), to withdraw the 15-day non-extendable time period to resubmit a response submission set by the May 25, 2011 decision, and to reopen prosecution, and 3) dismissed as moot requester's July 27, 2011 petition under 37 CFR 1.182, **are not vacated, and are being maintained**.
- The June 29, 2011 patent owner petition under 37 CFR 1.137(b) to revive an unintentionally terminated reexamination proceeding is **granted**.

² See MPEP 2668 IV and MPEP 711.03(c) II A 2 (a). Note that the grant of a petition under 37 CFR 1.137 is not a determination that any response is complete. Where the proposed response is to a non-final Office action, the petition may be granted if the response appears to be *bona fide*. After revival of the application, the patent examiner may, upon more detailed review, determine that the reply is lacking in some respect.

³ Although a Notice of Intent to Issue Ex Parte Reexamination Certificate (NIRC) has not been mailed to set forth the termination of the prosecution in this instance, the prosecution was "terminated" for failure of the patent owner to timely file a proper response, within the meaning of 37 CFR 1.111, to the nonfinal Office action.

- Requester's July 27, 2011 comments submission is **currently not of record, and will not be considered**, because the reexamination proceeding was terminated at the time of filing the comments submission.
- The third party requester is given **thirty (30) days** from the mail date of this supplemental decision to either ratify its July 27, 2011 comments submission or file a new comments submission. This time period is statutory and cannot be waived or extended.
- Any inquiry concerning this decision should be directed to the undersigned at (571) 272-7724.



Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

9/8/2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,453	09/28/2010	7,601,662	04119.000100.36	2755
13872	7590	04/05/2012	EXAMINER	
Diehl Servilla LLC (CGG/COG) 33 Wood Avenue South Second Floor, Suite 210 Iselin, NJ 08830			ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

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Date:

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CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001453
PATENT NO. : 7601662
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

Fitzpatrick, Cella, Harper & Scinto
1290 Avenue of Americas
New York, NY 10104-3800

(For Third Party Requester)

In re Bull et al.

Inter Partes Reexamination Proceeding

Control No. 95/001,453

Filed: September 28, 2010

For: U.S. Patent No. 7,601,662

: **DECISION**
: **DISMISSING**
: **PETITION UNDER**
: **37 CFR § 1.183**

This is a decision on the patent owner paper entitled "PETITION TO SUSPEND RULE 37 CFR § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 CFR § 1.183," filed on December 19, 2011.

The patent owner petition paper is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **dismissed as unnecessary**, for the reasons set forth herein.

REVIEW OF THE RELEVANT FACTS

1. On October 13, 2009, United States Patent No. 7,601,662 (the '662 patent) issued.
2. On September 28, 2010, a request for *inter partes* reexamination of the '662 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,453 (the '1453 proceeding).
3. On November 16, 2010, the Office issued an order granting *inter partes* reexamination in the '1453 proceeding.
4. The '1453 proceeding progressed to the point where, on November 18, 2011, the Office issued an action closing prosecution (ACP).

5. On December 19, 2011, patent owner filed the instant "PETITION TO SUSPEND RULE 37 C.F.R. § 1.943(b) PURSUANT TO THE PROVISIONS OF 37 C.F.R. § 1.183" (the petition under 37 CFR 1.183), concurrently with a patent owner submission under 37 CFR 1.951(a).
6. On January 18, 2012, third party requester filed responsive comments under 37 CFR 1.951(b).

DECISION

Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

Patent owner's petition under 37 CFR 1.183

In the instant petition under 37 CFR 1.183, patent owner requests waiver of 37 CFR 1.943(b), which limits patent owner responses to 50 pages in length, to permit patent owner to file a response totaling 65 pages in length, if needed, to the November 18, 2011 Action Closing Prosecution.¹ Patent owner asserts that "[i]t is believed that the Patent Owner's Amendment and response is 50 pages or less."² In particular, patent owner asserts that "[t]he remarks in the Patent Owner's Amendment and response to the Action Closing Prosecution is 32 (pages 17-49) pages."³ Along with the remarks, patent owner submitted several declarations.⁴ Patent owner asserts that "the Declarations of Ravindran, Roth and Moini present factual information or interpretation of the prior art, and should not count towards the page limit."⁵ Patent owner

¹ Petition under 1.183 at pages 1-2.

² Pet. at 1

³ *Id.*

⁴ Six declarations are included with patent owner's submission: "Second Declaration of Ahmad Moini, Ph.D., Under 37 C.F.R. § 1.132" (the Moini declaration); "Second Declaration of Pramod Ravindran Under 37 C.F.R. § 1.132" (the Ravindran declaration); "Second Declaration Stanley Roth, Ph.D., Under 37 C.F.R. § 1.132" (the Roth declaration); "Second Declaration of Gary L. Haller, Ph.D., Under 37 C.F.R. § 1.132" (the Haller declaration); "Second Declaration of David H. Olson, Ph.D., Under 37 C.F.R. § 1.132" (the Olson declaration); and "Second Declaration of Stacey I. Zones, Ph.D., Under 37 C.F.R. § 1.132" (the Zones declaration).

⁵ *Id.*

further states that “[t]he second Haller Declaration is 18 pages” and that “at most, there is 3 pages of argument in the Haller Declaration.”⁶ Lastly, patent owner asserts that the “Second Olson Declaration contains 6 pages of introduction and a discussion of the prior art” and that “at most, there is 2 pages of argument in the Olson declaration.”⁷ Thus, patent owner asserts that the December 19, 2011 patent owner submission constitutes 40 pages that count toward the regulatory page limit.⁸

Nonetheless, patent owner asserts that “in the event the Office disagrees and determines that the Patent Owner’s amendment and Response exceeds 50 pages, Patent Owner requests an allowance of an additional fifteen (15) pages, for a total of sixty-five (65) pages of argument.”⁹ In support of its request for waiver of the regulatory page limit, patent owner asserts that it “has made a good faith effort to comply with the page limit of 37 C.F.R. 1.943(b) in preparing the response.”¹⁰ Furthermore, patent owner states that all original claims 1-38 and new claims 39-55 stand rejected, and that the ACP “contains eighty-nine (89) pages of rejections and argument,” “has adopted many of the assertions of the Requester, which requires rebuttal,” and raises for the first time several new arguments and issues.¹¹ Thus, patent owner asserts that “a detailed analysis and additional declarations are needed to fully and properly address these arguments.”¹²

Discussion and Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed

⁶ *Id.*

⁷ Pet. at 1-2.

⁸ Pet. at 2.

⁹ *Id.* (stating, “Patent Owner requests these additional fifteen pages in the event the Office determines that any of the accompanying declarations contain arguments.”)

¹⁰ *Id.*

¹¹ *Id.*

¹² *Id.*

rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

The remarks section that spans from pages 17-49 of patent owner's December 19, 2011 submission under 37 CFR 1.951(a) is being counted toward the regulatory page limit for a total of 33 pages.¹³ Patent owner's submission also includes multiple declarations. The Moini, Roth, Ravindran and Zones declarations provide evidence of technological facts and/or comparative test results and a scientific, or technological, analysis of the results (*e.g.*, MPEP 716.02), and/or evidence of secondary considerations (*e.g.*, MPEP 716.03-716.06) and are not being counted toward the regulatory page limit. However, because at least portions of pages 11-18 of the Haller declaration are deemed to be an extension of the arguments of counsel, 8 pages of the Haller declaration are being counted toward the regulatory page limit.¹⁴ Additionally, at least portions of the 8-page Olson declaration are deemed to be an extension of the arguments of counsel, such that at most 8 pages of the Olson declaration count toward the regulatory page limit.¹⁵ Thus, in this instance, the maximum number of pages of patent owner's December 19, 2011 submission under 37 CFR 1.951(a) that count toward the regulatory page limit does not exceed 50 pages.¹⁶ Accordingly, patent owner's December 19, 2011 petition under 37 CFR 1.183 is **dismissed as unnecessary**.

CONCLUSION

1. Patent owner's December 19, 2011 petition under 37 CFR 1.183 is **dismissed as unnecessary** because patent owner's December 19, 2011 submission under 37 CFR 1.951(a) is page-length compliant.

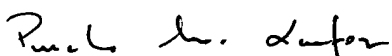
¹³ Pursuant to MPEP 2667(I)(A)(2), only those pages of patent owner's response upon which arguments as to how an outstanding rejection is overcome appear are included against the page limit count. Thus, the cover page of the December 19, 2011 response submission, as well as the table of contents is excluded from the page count, as no arguments appear on these pages. Additionally, because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count the 7-page claim listing is not being counted toward the regulatory page limit. Pages 15 and 16 directed to the required showing under 37 CFR 1.116 for entry of amendments and evidence after ACP are also not being counted toward the regulatory page limit.

¹⁴ See, *e.g.*, paragraph 23 of the Haller declaration.

¹⁵ See, *e.g.*, paragraphs 19-20 of the Olson declaration.

¹⁶ That is, even if all 8 pages of the Olson declaration were subject to the regulatory page limit count, the entire patent owner submission would not exceed 50 pages.

2. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at 571-272-8150 or Nicole D. Haines, Legal Advisor, at 571-272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

04-04-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,454	09/28/2010	7,113,474	OPME D860R1	3067
1688	7590	08/05/2011	EXAMINER	
Polster, Lieder, Woodruff & Lucchesi, L.C. 12412 Powerscourt Dr. Suite 200 St. Louis, MO 63131-3615			ART UNIT	PAPER NUMBER

DATE MAILED: 08/05/2011

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AUG 05 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001454
PATENT NO. : 7113474
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

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AUG 05 2011

Polster, Lieder, Woodruff & Lucchesi, L.C.
12412 Powerscourt Dr. Suite 200
St. Louis, MO 63131-3615

(For Patent Owner)

CENTRAL REEXAMINATION UNIT

Fish & Richardson, P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

(For Third Party Requester)

In re Ovshinsky et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,454
Filing Date: September 28, 2010
For: U.S. Patent No. 7,113,474

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This is a decision on the June 16, 2011 patent owner petition entitled "Petition to Suspend Action (37 C.F.R. §§ 1.103 and 1.937)."

The present petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the present petition is dismissed.

PERTINENT BACKGROUND

1. On September 26, 2006, U.S. Patent No. 7,113,474 ("the '474 patent") was issued to Ovshinsky *et al.*, with claims 1-35.
2. On September 28, 2010, a request for *inter partes* reexamination was filed by a third party requester, the real party in interest being MicroStrategy Incorporated, and the resulting reexamination proceeding was assigned control number 95/001,454 ("the '454 proceeding"). As shown on the certificate of service accompanying the request for reexamination, a copy of the request was served via first class mail to David Schumaker at the address of 2956 Waterview, Rochester Hills, MI 48309.
3. On November 24, 2010, reexamination was ordered for claims 1-35 of '474 patent. On the same date, an Office action was mailed, rejecting claims 1-35. Both the order and the Office action were mailed to Energy Conversion Devices, Inc. at the address of 2956 Waterview, Rochester Hills, MI 48309.
4. On January 24, 2011, patent owner filed a response to the November 24, 2010 Office action, including amendments to claim 21 and cancellation of claims 34 and 35. The

response clearly states that the arguments and amendments are made by the patentee on at least pages 9, 10, 14, and 25.

5. On February 23, 2011, third party requester filed its comments pursuant to 37 CFR 1.947 after the January 24, 2011 patent owner response.
6. On May 27, 2011, patent owner Optical Memory Storage (hereinafter OMS) filed a revocation of power of attorney with a new power of attorney.
7. On June 16, 2011, patent owner filed the instant petition entitled "Petition to Suspend Action (37 C.F. R. §§ 1.103 and 1.937)," requesting that action in the present reexamination proceeding be suspended for a period of sixty (60) days. The patent owner petition is accompanied by the declaration of David White, Senior Vice President for OMS.
8. On July 14, 2011, the Office mailed an Action Closing Prosecution (ACP), rejecting claims 1-12, confirming unamended claims 13-20, and 22-32, and indicating patentability of amended claim 21.

DECISION

The June 16, 2011 patent owner petition has been filed under 37 CFR 1.103 and 1.937. The patent owner has paid the \$200.00 fee pursuant to 37 CFR 1.17(g) for a petition under 37 CFR 1.103(a). However, 37 CFR 1.103(a) is not available to *inter partes* reexamination proceedings. As set forth in 37 CFR 1.937(b), an *inter partes* reexamination proceeding is to be conducted in accordance with 37 CFR §§ 1.104 through 1.116.¹ The provisions of 37 CFR 1.103 do not apply to *inter partes* reexamination proceedings; they are rather drafted for applications. While 35 U.S.C. § 314 and 37 CFR 1.937 provide that an *inter partes* reexamination will be conducted with special dispatch unless the USPTO director provides otherwise, for good cause, the regulations do not specifically provide for the filing of a patent owner petition requesting suspension of an *inter partes* reexamination proceeding. Accordingly, the June 16, 2011 patent owner petition filed under 37 CFR 1.103 and 1.937 is dismissed.

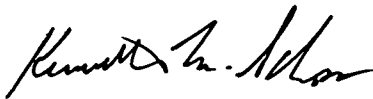
Inasmuch as there is no provision in the regulations for the filing of a petition to suspend an *inter partes* reexamination proceeding, the patent owner petition would need to be considered pursuant to 37 CFR 1.182. 37 CFR 1.182 requires the payment of the petition fee set forth in 37 CFR 1.17(f), which is \$400.00. However, the record does not show that the required petition fee has been directly paid, nor that there is any authorization in the present petition to charge counsel's deposit account for the petition fee of \$400.00 pursuant to 37 CFR 1.17(f). Therefore, failure to pay the required \$400.00 petition fee pursuant to 37 CFR 1.17(f) precludes treating the present patent owner petition on the merits as a petition under 37 CFR 1.182.

¹ Specifically, 37 CFR 1.937(b) provides:

The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

CONCLUSION

1. The June 16, 2011 patent owner petition is dismissed.
2. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Senior Legal Advisor, at (571) 272-7726, or in his absence, to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

8-2-11
Kenpet8/



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455	09/30/2010	7528782	9749.003.782.IP	7741
25883	7590	12/28/2010	EXAMINER	
HOWISON & ARNOTT, L.L.P P.O. BOX 741715 DALLAS, TX 75374-1715			ART UNIT	PAPER NUMBER

DATE MAILED: 12/28/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Tracy W. Druce

NOVAK DRUCE & QUIGG, LLP

1000 Louisiana St., 53rd Floor

Houston, TX 77002

Date:

MAILED

DEC 28 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455

PATENT NO. : 7528782

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,455
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1. THIS IS A DECISION ON THE PETITION FILED 22 December 2010.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 19 November 2010 which sets a two (2) months period for filing a response thereto, be extended by one (1) month

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☒ Granted or ☐ Granted-in-part for one (1) month because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

☐ Other/comment: _____

B. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[Signature]	(Title)



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455 + 95/001,499 + 95/000,595	09/30/2010	7528782	3008.003REX0	7741
26111	7590	05/24/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/24/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 5-24-11

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana St., 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455 + 95/001449 ~ 95/000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAY 24 2011

Sterne, Kessler, Goldstein & Fox P.L.L.C. (For Patent Owner)
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Washington, DC 20005

Morrison & Foerster LLP (For 95/000,595 Requester)
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Baker Botts, LLP (For 95/001,499 Requester)
Patent Department
98 San Jacinto Blvd.
Suite 1500
Austin, TX 78701-4039

Tracy W. Druce (For 95/001,455 Requester)
Novak Druce & Quigg, LLP
1000 Louisiana Street
53rd Floor
Houston, TX 77002

In re Carles Puente Baliarda et al.
Inter Partes Reexamination Proceeding
Control No.: 95/000,595
Filed: December 14, 2010
For: U.S. Patent No. 7,528,782

In re Carles Puente Baliarda et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,499
Filed: December 3, 2010
For: U.S. Patent No. 7,528,782

In re Carles Puente Baliarda et al.
Inter Partes Reexamination Proceeding
Control No.: 95/001,455
Filed: September 30, 2010
For: US. Patent No. 7,528,782

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: **DECISION, *SUA SPONTE*,**
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**
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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,528,782 (“the ‘782 patent”) issued to Carles Puente Baliarda et al. on May 5, 2009, with 29 claims.
2. A request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the ‘782 patent was filed on September 30, 2010, by a third party requester, and was assigned control number 95/001,455 (“the ‘1455 *inter partes* proceeding”). The real party in interest is Samsung Electronics Co. Ltd.
3. On November 19, 2010, *inter partes* reexamination was ordered for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the ‘782 patent in the ‘1455 *inter partes* proceeding based on the examiner’s determination that the September 30, 2010 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection Office action.
4. A second request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the ‘782 patent was filed on December 3, 2010, by a third party requester, and was assigned control number 95/001,499 (“the ‘1499 *inter partes* proceeding”). The real party in interest is HTC Corporation and HTC America, Inc.
5. A third request for *inter partes* reexamination of claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the ‘782 patent was filed on December 14, 2010, by a third party requester, and was assigned control number 95/000,595 (“the ‘595 *inter partes* proceeding”). The real party in interest is Kyocera Communications, Inc.
6. On January 13, 2011, *inter partes* reexamination was ordered for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the ‘782 patent in the ‘1499 *inter partes* proceeding based on the examiner’s determination that the December 3, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the ‘1499 proceeding.
7. On January 21, 2011, *inter partes* reexamination was ordered for claims 1-2, 5-6, 11-12, 15-16, and 22-28 of the ‘782 patent in the ‘595 *inter partes* proceeding based on the examiner’s determination that the December 14, 2010 request raised a substantial new question of patentability affecting these claims.¹ No Office action on the merits has been issued in the ‘595 proceeding.
8. On April 12, 2011, patent owner submitted a response to the November 19, 2010 non-final rejection action in the ‘1455 *inter partes* proceeding.² The April 12, 2011 patent owner response did not include any amendment to the specification or claims.

¹ The January 21, 2011 order stated that the December 14, 2010 request did not raise a substantial new question of patentability as to claims 7-8 and 18.

² Patent owner’s April 12, 2011 response in the ‘1455 *inter partes* proceeding was a corrected response filed in response to a March 28, 2011 Notice Re Defective Paper In *Inter Partes* Reexamination. The March 28, 2011 Notice stated that patent owner’s original February 22, 2011 response to the November 19, 2010 non-final rejection action was defective.

9. On April 28, 2011, the '1455 requester filed comments to patent owner's April 12, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

(a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,455, 95/001,499 and 95/000,595 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent in the '1455 and '1499 proceedings, and for claims 1-2, 5-6, 11-12, 15-16, and 22-28 of the '782 patent in the '595 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-2, 5-8, 11-12, 15-16, 18, and 22-28 of the '782 patent.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
 Central Reexamination Unit
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
 Central Reexamination Unit

by Hand to: Customer Service Window
 Attn: Central Reexamination Unit
 Randolph Building, Lobby Level
 401 Dulany Street
 Alexandria, VA 22314

by EFS: Registered users may submit papers via the
 electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

C. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for

reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

E. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,455, *inter partes* Reexamination No. 95/001,499 and *inter partes* Reexamination Control No. 95/000,595 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. The examiner will issue an Office action for the merged proceeding in due course.

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

May 20, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455 + 95/000595	09/30/2010	7528782	3008.003REX0	7741
26111	7590	06/22/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 6-22-11

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana St., 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455 + 95/001499 ~ 95/000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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WASHINGTON, DC 20005

(For Patent Owner)

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(For 95/000,595 Third Party Requester)

**BAKER BOTTS LLP
PATENT DEPARTMENT
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AUSTIN, TX 78701-4039**

(For 95/001,499 Third Party Requester)

TRACY W. DRUCE
NOVAK, DRUCE & QUIGG, LLP
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53RD FLOOR
HOUSTON, TX 77002

(For 95/001,455 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No. 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,499
Filed: December 3, 2010
For: U.S. Patent No. 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

DECISION
ON PETITIONS
UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 12, 2011 in reexamination proceeding control no. 95/001,455.

This is also a decision on the third party requester petition paper entitled “THIRD PARTY REQUESTER’S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A),” filed on April 28, 2011, in reexamination proceeding control no. 95/001,455.

The petitions under 37 CFR 1.183 are before the Office of Patent Legal Administration.

The petitions under 37 CFR 1.183 are **granted** to the extent set forth below.

BACKGROUND

1. On May 5, 2009, U.S. patent number 7,528,782 (the ‘782 patent) issued to Baliarda *et al.*
2. On September 30, 2010, a third party requester filed a request for *inter partes* reexamination of the ‘782 patent, which request was assigned Reexamination Control No. 95/001,455 (the ‘1455 proceeding).
3. On November 19, 2010, the Office issued an order granting *inter partes* reexamination in the ‘1455 proceeding. Concurrently with the order, the Office issued a non-final Office action.
4. On February 22, 2011, patent owner filed a response to the November 19, 2010 Office action.¹
5. On March 24, 2011, third party requester filed comments after the November 19, 2010 Office action and patent owner’s February 22, 2011 response.
6. On March 28, 2011, the Office mailed a “NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION” (the notice of defective paper), finding patent owner’s February 22, 2011 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.
7. On April 12, 2011, patent owner filed the instant “PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION” (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the November 19, 2010 Office action (patent owner corrected response submission).
8. On April 28, 2011, third party requester filed the instant “THIRD PARTY REQUESTER’S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)” (requester petition under 37 CFR 1.183), concurrently with requester’s comments after the November 19, 2010 Office action and patent owner’s April 12, 2011 corrected response submission (requester comments submission).

¹ On December 28, 2010, the Office mailed a decision granting patent owner’s December 22, 2010 petition for a one-month extension of time.

9. On May 24, 2011, the Office issued a “DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS,” merging the ‘1455 proceeding with *inter partes* reexamination proceeding control no. 95/000,595 (the ‘595 proceeding) and with *inter partes* reexamination proceeding control no. 95/001,499 (the ‘1499 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner’s response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner’s response.

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director’s designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner’s response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set

forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 12, 2011

On April 12, 2011, patent owner filed, in the '1455 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 12, 2011 corrected response submission is 68 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the corrected response submission.² Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."³ Nonetheless, patent owner also requests waiver of the 50-page limit "for any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts."⁴

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 12, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.⁵ Additionally, patent owner asserts that "the full length of the Corrected Response is needed to fully and adequately respond to the Office Action,"

² Patent owner petition under 37 CFR 1.183 at page 2.

³ *Id.* at page 4 (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (41 pages)," are filed herewith.)

⁴ *Id.* at page 6.

⁵ *Id.* at pages 4-6.

and that although the Office action “constitutes only 9 pages, it incorporates by reference over 450 pages of arguments and detailed claim charts set forth by the third party requester in its request for reexamination.”⁶ Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 28, 2011 notice of defective paper, by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁷ As evidence of the reformatting and further editing made to reduce page length, patent owner submitted as “Exhibit 1” a redlined document comparing patent owner’s February 22, 2011 original response submission to patent owner’s April 12, 2011 corrected response submission. The “Exhibit 1” redlined document has been expunged from the record of the ‘1455 proceeding by marking the paper “closed” and “not public” in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 28, 2011 notice of defective paper.

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),⁸ and the individual facts and circumstances of this case (such as the length of the November 19, 2010 Office action), it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

The total number of pages of patent owner’s April 12, 2011 corrected response submission is much less than the total number of pages of the substantive portion of the November 19, 2010 Office action, which has been determined to span approximately 388 pages.⁹ Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner’s corrected response to the October 8, 2010 Office action exceeds 50 pages. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s April 12, 2011 corrected response submission. This waiver makes patent owner’s April 12, 2011 corrected response submission page-length compliant.

IV. Third party requester petition of April 28, 2011

On April 28, 2011, the ‘1455 requester filed, in the ‘1455 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The ‘1455 requester asserts that the April 28, 2011 comments submission includes “56 pages of double spaced 12 pt font arguments and a 14 page declaration from Dr.

⁶ Id. at page 2.

⁷ Id. at page 3.

⁸ 67 pages of the remarks portion of patent owner’s April 12, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 7-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the total number of pages of the patent owner’s April 12, 2011 corrected response submission exceeds the 50-page limit.

⁹ On its face, the substantive portion of the November 19, 2010 Office action spans only approximately 7 pages, but it incorporates by reference approximately 147 pages, in addition to approximately 234 pages of claim charts, from the ‘1455 request for *inter partes* reexamination.

Balanis under 37 C.F.R. § 1.132.”¹⁰ The ‘1455 requester asserts, however, that “[i]f the Office agrees with [patent owner’s] interpretation of MPEP § 2667(I)(A)(2), then Samsung’s Comments are only 56 pages as Dr. Balanis’s declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue.”¹¹

In support of its request for waiver of the rule, the ‘1455 requester asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 135 page response.”¹² The ‘1455 requester asserts that it “has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit” and “is asking for significantly fewer total pages than [sic] the Patent Owner has submitted,” *i.e.*, requester “is only asking for a total of 70 pages.”¹³ The ‘1455 requester also asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner.”¹⁴

Based on the specific facts set forth in the ‘1455 requester’s petition under 37 CFR 1.183, the ‘1455 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),¹⁵ and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the ‘1455 requester’s April 28, 2011 comments submission exceeds 50 pages. Accordingly, the ‘1455 requester’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the ‘1455 requester’s April 28, 2011 comments submission. This waiver makes the ‘1455 requester’s April 28, 2011 comments submission page-length compliant.

¹⁰ Third party requester petition under 37 CFR 1.183 at page 1.

¹¹ *Id.* at page 4. The ‘1455 requester is cautioned that statements submitted in opposition to patent owner’s petition under 37 CFR 1.183 are improper and may result in the requester’s petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the ‘1455 requester presents arguments against patent owner’s position set forth in patent owner’s petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner’s response to an Office action on the merits. Patent owner’s petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner’s corrected response submission, however, is not a “response” to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner’s petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper “closed” and “not public” in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

¹² *Id.* at page 2.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ 56 pages of the remarks portion of the ‘1455 requester’s April 28, 2011 comments submission count toward the page limit. Thus, the total number of pages of the ‘1455 requester’s April 28, 2011 comments submission exceeds the 50-page limit.

ADDITIONAL DISCUSSION

The 95/000,595 third party requester and the 95/001,499 third party requester have 30 days from the date of this decision, granting patent owner's April 12, 2011 petition under 37 CFR 1.183 and entering patent owner's April 12, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

Additionally, section III(B)(1) of the Office's May 24, 2011 "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS" states:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2). First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

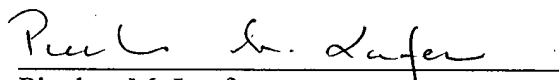
No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. [footnote omitted]

Thus, because the patent owner's April 12, 2011 corrected response submission was not entered until the mailing date of this decision, which is after merger of the '1455 proceeding with the '595 and '1499 proceedings, the entry of patent owner's April 12, 2011 corrected response submission

triggers a right for the 95/000,595 third party requester and the 95/001,499 third party requester to file a comment paper pursuant to 37 CFR 1.947 within 30 days of the mailing date of this decision.

CONCLUSION

1. Patent owner's April 12, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's April 12, 2011 corrected response submission. This waiver makes patent owner's April 12, 2011 corrected response submission page-length compliant.
2. The '1455 requester's April 28, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1455 requester's April 28, 2011 comments submission. This waiver makes the '1455 requester's April 28, 2011 comments submission page-length compliant.
3. The 95/000,595 third party requester and the 95/001,499 third party requester have 30 days from the mailing date of this decision, granting patent owner's April 12, 2011 petition under 37 CFR 1.183 and entering patent owner's April 12, 2011 corrected response submission, to file a comment paper pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

06-17-2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455 → 95/001,449 → 95/000,595	09/30/2010	7528782	3008.003REX0	7741
26111	7590	09/08/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,455 + 95/001499 + 95/000595

PATENT NUMBER 7528782.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,455 + 95/000,595 +
95/001,499

1. THIS IS A DECISION ON THE PETITION FILED on 08/30/2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 07/29/2011, which sets a two (2) month period for filing a response thereto, be extended by two (2) months.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☒ Other/comment: Requests for extensions of time for more than one (1) month will not be granted unless extraordinary circumstances are involved; e.g., death or incapacitation of the patent owner.
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/ for Mark Reinhart

SPE, Art Unit 3992

[Signature]

(Title)



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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For *Inter Partes* '1455 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,499
Filed: December 03, 2010
For: U.S. Patent No. 7,528,782

Inter Partes Reexamination Proceeding
Control No: 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,499, filed on September 16, 2011, is granted.

Inter partes reexamination proceeding control number 95/001,499 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,499, 95/000,595 and 95/001,455.

Inter partes reexamination proceeding 95/001,499, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,499 (the '1499 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1499 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '595 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '782 patent, which is the patent under reexamination in the '1499 proceeding, are listed in the consent judgment as claims 1, 2, 5-8, 11, 12, 15, 16, 18, and 22-28, which are identical to the claims that were requested to be reexamined by HTC in the '1499 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '782 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1499 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,499, 95/000,595 and 95/001,455.

Inter partes reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue**.² Any rejection proposed by HTC (the requester of the '1499 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

² As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '595 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.³

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,595 and 95/001,455, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,595 and 95/001,455 will otherwise remain, in general, as outlined by the decision, mailed on May 24, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1499 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,499 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,499 (the '1499 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,499, 95/000,595 and 95/001,455.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,595 and 95/001,455 **will continue** in the manner set forth in this decision.
- The prosecution of the '1499 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1499 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1499 proceeding, as set forth in this decision.

³ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455	09/30/2010	7528782	3008.003REX0	7741
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,595	12/14/2010	7528782	3008.003REX1	8977
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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NOVAK DRUCE & QUIGG, LLP
1000 Louisiana St., 53rd Floor
Houston, TX 77002

Date: **MAILED**

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.
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Washington, D.C. 20005

(For Patent Owner)

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Suite 100
San Diego, CA 92130-2040

(For *Inter Partes* '595 Requester)

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1455 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:¹

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,499, was granted. *Inter partes* reexamination proceeding 95/001,499 was severed from the merger of *inter partes* reexamination proceedings 95/001,499, 95/000,595 and 95/001,455, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,595 and 95/001,455.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,595, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,595 (the '595 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '595 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '782 patent's claims 1, 2, 5-8, 11, 12, 15, 16, 18, 22-28 all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 2, 5, 6, 11, 12, 15, 16 and 22-28 of the ‘782 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘595 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘595 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

² The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is dismissed.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘595 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘595 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,595 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script that reads "Brian E. Hanlon". The signature is written in black ink and is positioned above a horizontal line.

Brian E. Hanlon
Director
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455 + 95/005,95	09/30/2010	7528782	3008.003REX0	7741
26111	7590	01/04/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 01/04/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 1-4-12

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana St., 53rd Floor
Houston, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455 → 95/000595

PATENT NO. : 7528782

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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(For 95/000,595 Third Party Requester)

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(For 95/001,455 Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No. 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

:
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:
:
: **DECISION GRANTING**
: **PETITION UNDER**
: **37 CFR 1.183**
:
:
:

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 31, 2011 in reexamination proceeding control nos. 95/000,595, 95/001,455 and 95/001,499.

The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.183 is **granted** to the extent set forth below.

RELEVANT BACKGROUND

1. On May 5, 2009, U.S. patent number 7,528,782 (the '782 patent) issued to Carles Puente Baliarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '782 patent were filed, which requests were assigned Reexamination Control Nos. 95/001,455, 95/001,499, and 95/000,595, and for each of which reexamination was instituted by the Office.
3. On May 24, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1455 proceeding with the '1499 and '595 proceedings (the merged proceeding).
4. On July 29, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On October 31, 2011, patent owner filed a response to the July 29, 2011 Office action in the merged proceeding (the October 31, 2011 response submission), concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (petition under 37 CFR 1.183).¹
6. On December 12, 2011, the Office issued a "DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER," terminating the 95/001,499 proceeding and severing the 95/001,499 proceeding from the merged proceeding.²

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

¹ On September 8, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 29, 2011 Office Action.

² The merged proceeding continues as to the '595 and '1455 proceedings.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 31, 2011

On October 31, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.³ Patent owner asserts that the argument portion of the October 31, 2011 response submission is 86 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.⁴ Patent owner states

³ Because the '1499 proceeding has been terminated, this decision does not address the instant petition with respect to the '1499 proceeding.

⁴ Patent owner petition under 37 CFR 1.183 at page 2.

that it concurrently filed “a number of 132 Declarations” but asserts that the declarations are “drawn to fact, not argument, and thus does not count towards the 50-page limit.”⁵ Nonetheless, patent owner also requests waiver of the 50-page limit for “those portions of the 132 Declarations that the PTO holds count towards the 50 page limit....”⁶

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 31, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.⁷ Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 43 pages, it incorporates by reference almost 900 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”⁸ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”⁹

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),¹⁰ and the individual facts and circumstances of this case (such as the length of the July 29, 2011 Office action),¹¹ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s October 31, 2011 response submission. This waiver makes patent owner’s October 31, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,455 third party requester and the 95/000,595 third party requester have 30 days from the date of this decision, granting patent owner’s October 31, 2011 petition under 37 CFR 1.183

⁵ Id. at page 4 (identifying a copy of the declaration of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages), filed on October 3, 2011 in the ‘1390 proceeding, a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (14 pages), and a declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (11 pages), which references and includes a copy of the declaration of Dr. Yahya Rahmat-Samii under 37 C.F.R. § 1.132 (41 pages), previously entered in the ‘1455 proceeding).

⁶ Id. at page 2.

⁷ Id. at pages 4-6.

⁸ Id. at page 2-3.

⁹ Id. at page 3.

¹⁰ 86 pages of the remarks portion of patent owner’s October 31, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 7-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s October 31, 2011 response submission exceeds the 50-page limit by at least 36 pages.

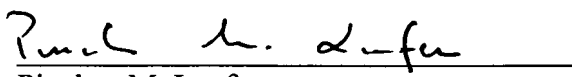
¹¹ On its face, the substantive portion of the July 29, 2011 Office action spans only approximately 43 pages, some of which pertain to rejections that have been withdrawn and not adopted, but in setting forth the rejections that have been adopted, it incorporates by reference over 100 pages from the ‘1455, ‘1499 and ‘595 requests for *inter partes* reexamination.

and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner's October 31, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner's October 31, 2011 response submission. This waiver makes patent owner's October 31, 2011 response submission page-length compliant.
2. The 95/001,455 third party requester and the 95/000,595 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 31, 2011 petition under 37 CFR 1.183 and entering patent owner's October 31, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.


Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,455	09/30/2010	7528782	3008.003REX0	7741
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Tracy W. Druce
NOVAK DRUCE & QUIGG, LLP
1000 Louisiana St., 53rd Floor
Houston, TX 77002

Date:

MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001455 + 95000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(For Patent Owner)

FEB 27 2012

CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP
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(For *Inter Partes* '595 Requester)

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1455 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,595
Filed: December 14, 2010
For: U.S. Patent No.: 7,528,782

Inter Partes Reexamination Proceeding
Control No. 95/001,455
Filed: September 30, 2010
For: U.S. Patent No. 7,528,782

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,455 (the '1455 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1455 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,499. *Inter partes* reexamination proceeding 95/001,499 was severed from the merger of *inter partes* reexamination proceedings 95/001,499, 95/000,595 and 95/001,455, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,595 and 95/001,455.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,595 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,595 (the '595 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,528,782 (the '782 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '595 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in

original). As discussed in the December 12, 2011 decision dismissing patent owner's September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '595 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '595 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,595 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,456	09/30/2010	7238380	2202625-121US1	7835
23377	7590	01/31/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2011

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Date:

Andrej Barbic, Ph.D.

WILMERHALE/BOSTON

60 State Street

Boston, MA 02109

MAILED

JAN 31 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001456

PATENT NO. : 7238380

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,456

THIS IS A DECISION ON THE PETITION FILED January 20, 2011

1. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

2. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on December 1, 2010, which sets a two-month period for filing a response thereto, be extended by _____.

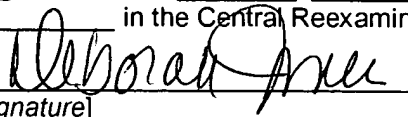
- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
- ii. ☐ Petition includes authorization to charge a credit card account.
- iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

3. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for one month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- ☐ Other/comment _____
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v. ☐ The petition is moot.
- vi. ☐ Other/comment: _____.

4. CONCLUSION Response is due on March 1, 2011

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535. In his/her absence, calls may be directed to _____ in the Central Reexamination Unit.


[Signature]

(Title) Deborah D. Jones
Supervisory Patent Examiner
CRU - ART Unit 3991



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,456	09/30/2010	7238380	SJS-0012A 2202625-121US1	7835
23377	7590	02/25/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 02/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Andrej Barbic, Ph.D.

WILMERHALE/BOSTON

60 State Street

Boston, MA 02109

Date:

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FEB 25 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001456

PATENT NO. : 7238380

TECHNOLOGY CENTER : 3999

ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/001,456

1. THIS IS A DECISION ON THE PETITION FILED February 22, 2011.
2. THIS DECISION IS ISSUED PURSUANT TO:
 - A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 - B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS
Patent owner requests that the period for responding to the Office action mailed on December 1, 2010, which sets a two-month period for filing a response thereto, be extended by two additional weeks. See conclusion _____.
 - A. ☒ Petition fee per 37 CFR §1.17(g):
 - i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
 - B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
 - C. ☒ Petition was timely filed.
 - D. ☒ Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
 - A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
 - B. ☐ Dismissed because:
 - i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.
5. CONCLUSION This petition extends the period for response for one month and two weeks. The response is due on March 15, 2011.

Telephone inquiries with regard to this decision should be directed to Deborah Jones _____ at 571-272-1535. In his/her absence, calls may be directed to _____ in the Central Reexamination Unit.

[Signature]

(Title)

Deborah D. Jones
Supervisory Patent Examiner
CRU - Art Unit 3991



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,457	09/30/2010	6248390	2202625-122US1	8020
23377	7590	01/31/2011	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 01/31/2011

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WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:

MAILED

JAN 31 2011

Transmittal of Communication to Third Party Requester **CENTRAL REEXAMINATION UNIT**
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001457
PATENT NO. : 6248390
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.:95/001,457

THIS IS A DECISION ON THE PETITION FILED January 20, 2011

1. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

2. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on December 1, 2010, which sets a two-month period for filing a response thereto, be extended by _____.

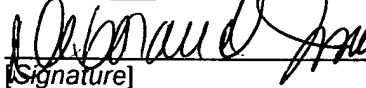
- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☒ Petition includes authorization to debit a deposit account.
 - ii. ☐ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

3. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☒ Granted-in-part for one month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment _____
- B. ☐ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☐ Other/comment: _____.

4. CONCLUSION Response is due on March 1, 2011

Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535. In his/her absence, calls may be directed to _____ in the Central Reexamination Unit.


[Signature]

Deborah D. Jones
Supervisory Patent Examiner
CRU - Art Unit 3991
(Title)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,457	09/30/2010	6248390	2202625-122US1	8020
23377	7590	04/19/2012	EXAMINER	
WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			ART UNIT	PAPER NUMBER

DATE MAILED: 04/19/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

Date:

MAR 30

APR 19 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001457
PATENT NO. : 6248390
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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Woodcock Washburn LLP
Circa Centre, 12th Floor
2929 Arch Street
Philadelphia, PA 19104-2891

(For Patent Owner)

WilmerHale/Boston
60 State Street
Boston, MA 02109

(For Third Party Requester)

In re Stillman
Inter partes Reexamination Proceeding
Control No: 95/001,457
Filing Date: September 30, 2010
For: U.S. Patent No.: 6,248,390

**DECISION GRANTING
PETITION TO
TERMINATE *INTER PARTES*
REEXAMINATION PROCEEDING**

This is a decision on the following petitions:

- The March 8, 2012 petition entitled "Joint Notification of Final Decision in Concurrent Proceeding and Petition to Terminate *Inter Partes* Reexamination Proceedings" (the March 8, 2012 petition to terminate); and
- The March 8, 2012 petition entitled "Joint Petition to Suspend *Inter Partes* Reexamination Proceedings" (the March 8, 2012 petition to suspend).

The March 8, 2012 petitions, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The March 8, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

The March 8, 2012 petition under 37 CFR 1.182 to suspend the present *inter partes* reexamination proceeding is **dismissed as moot**.

DECISION

The March 8, 2012 Petition to Terminate

The patent owner and the requester of the present proceeding (the parties) have jointly filed the present petition to terminate. The parties argue that termination of *inter partes* reexamination

proceeding control number 95/001,457 (the ‘1457 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The parties inform the Office that the patent under reexamination, U.S. Patent 6,248,390 (the ‘390 patent), was the subject of a civil action in district court, i.e., *Suzanne Jaffe Stillman v. Novartis Consumer Health, Inc. et. al*, Case No. 2:11-cv-5603 (C.D. Cal July 7, 2011) (the civil action). The parties submit a copy of a stipulated order and final decision, entered by the district court on March 6, 2012, in which the district court stated that “this Court enters this Order and Final Decision that is intended and shall constitute, for purposes of 35 U.S.C.

§ 317(b), a final decision entered against a party, Novartis Consumer Health, Inc. [the requester of the present reexamination proceeding], in a civil action arising in whole or in part under Section 1338 of Title 28 of the United States Code, that the party, Novartis Consumer Health, Inc., has not sustained its burden of proving invalidity of any patent claim of U.S. Patent No. 6,248,390 C1 . . . with all claims of . . . [the] patent having been in suit”. Claims 1-3, 5-44, 46-52 of the ‘390 patent, and newly added claims 53-66 are subject to reexamination in the present proceeding. The patent owner has submitted an amendment cancelling claims 4 and 53-66, rendering the claims under reexamination in the present proceeding identical to the claims in suit. The district court also stated, in the March 6, 2012 stipulated order and dismissal, that “[a]ll claims and counterclaims by and between Plaintiff Suzanne Jaffe Stillman and Novartis Consumer Health, Inc., as part of this action, are hereby dismissed with prejudice . . . This decision is an Order of the Court which is final, enforceable and not appealable”. Thus, elements 1-3 have been shown to be satisfied.

Regarding element 4, the parties provide a bald statement that “[t]he Stillman civil action raised or could have raised the same issues as to the validity of U.S. Patent Nos. 6,248,390 C1 . . . as the issues raised in the instant reexamination proceedings”, which, alone, is insufficient.¹ Office

¹ The parties are reminded that record must include *evidence* of all four of the above-listed factors. For example, to satisfy element 4, *evidence* must be provided which shows that the issues raised in the reexamination proceeding are the same issues that were raised or could have been raised by the requester in the civil action. Merely including a

records reveal, however, that the civil action was filed on July 7, 2011,² more than nine months after the request for reexamination was filed in the present reexamination proceeding on September 30, 2010, which provides evidence that any issues raised in the present reexamination proceeding could have been raised in the later-filed civil action. Thus, element 4 has been satisfied.

For the reasons given above, the March 8, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,457 (the ‘1457 proceeding) is hereby **terminated**.

The ‘1457 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM “Application Number Information” screen and the “Contents” screen will be printed, the printed copy will be annotated by adding the comment “PROCEEDING CONCLUDED,” and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

The March 8, 2012 Petition to Suspend

To have a petition to suspend a reexamination proceeding considered, any required response to an outstanding Office action must be filed either prior to, or concurrent with, the petition. The Office will not consider on the merits a petition to suspend a reexamination proceeding when such a response is due. In the present instance, the patent owner filed a notice of appeal on February 28, 2012. Patent owner’s appellant’s brief was due at the time of filing the present petition. Such petitions are generally dismissed as untimely. See MPEP 2686.04, which provides, in pertinent part:

[S]uspension will not be considered on its merits when there is an outstanding Office action.

In the present instance, however, the March 8, 2012 petition to suspend is **dismissed as moot**, in view of the present decision granting the parties’ concurrently-filed petition to terminate the present proceeding.

CONCLUSION

- The March 8, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.
- The March 8, 2012 petition under 37 CFR 1.182 to suspend the present *inter partes* reexamination proceeding is **dismissed as moot**.

statement to this effect by the petitioner(s) in the body of the petition is insufficient. In the present instance, however, Office records reveal that the reexamination proceeding was filed more than nine months before the commencement of the civil action, which provides evidence that any issues raised in the present reexamination proceeding could have been raised in the later-filed civil action.

² See the notice of concurrent proceedings, filed in the present proceeding on July 15, 2011.

- The prosecution of the '1457 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1457 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for processing of the March 8, 2012 amendment, and for further processing to conclude the '1457 proceeding, as set forth above.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

4 18 2012



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EDELL, SHAPIRO & FINNAN, LLP.
SUITE 400
1901 RESEARCH BOULEVARD
ROCKVILLE, MD 20850-3164

(For Patent Owner)

MAILED

APR 07 2011

MEYERTONS, HOOD, KIVLIN,
KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

(Courtesy Copy)

CENTRAL REEXAMINATION UNIT

NIXON & VANDERHYE, P.C.
901 NORTH GLEBE ROAD,
11TH FLOOR
ARLINGTON, VA 22203

(For Third Party Requester)

In re Feldman

Reexamination Proceeding

Control No.: 95/001,460

Filing Date: October 1, 2010

For: U.S. Patent No.: 7,121,982

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

The above reexamination proceeding is before the Director of TC 1600, who oversees the Central Reexamination Unit after receipt of a patent owner's petition of March 16, 2011, which is a petition under 37 CFR § 1.181 to invoke supervisory authority to not enter the February 17, 2011 requester comments, and an opposition petition filed March 24, 2011 by the third party requester to the March 16, 2011 petition.

The patent owner's petition of March 16, 2011, and the third party requester's opposition petition of March 24, 2011 are dismissed as premature.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,121,982 [hereinafter "the '982 patent"] was granted to *Feldman* on October 17, 2006.
2. On October 1, 2010, a request for *inter partes* reexamination of the '982 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,460 (the '460 proceeding).
3. On November 18, 2010, the Office issued an order granting *inter partes* reexamination in the '460 proceeding, with an accompanying Office action on the merits.
4. On December 21, 2010, a revocation of the power of attorney with an appointment of a new power of attorney was filed in the '460 proceeding.
5. On December 27, 2010 and January 4, 2011, the Office mailed notices entitled "NOTICE REGARDING CHANGE OF POWER OF ATTORNEY" and "NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY."
6. On January 18, 2011, patent owner filed a response to the Office action.
7. On February 17, 2011, the third party requester filed comments, a copy of which was served on patent owner at Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. in Austin, Texas.
8. On March 16, 2011, the patent owner filed a petition under 37 CFR 1.181, invoking supervisory review to not enter the third party requesters comments of February 17, 2011.
9. On March 24, 2011, third party requester filed an opposition to the March 16, 2011 petition, a copy of which was served on patent owner at Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. in Austin, Texas.
10. The examiner has not acted on the January 18, 2011 response and the February 17, 2011 comments to date.

DECISION

As pointed out, the patent owner filed a March 16, 2011 petition to not enter the third party requester's February 17, 2011 comments. On March 24, 2011, the requester filed an opposition to the March 16, 2011 petition. The March 16, 2011 petition is a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the requester's papers. However, there has been no decision by the examiner if the third party requester's comments of February 17, 2011 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory

authority regarding entry or refusal to enter the February 17, 2011 comments because the examiner has not made his decision. Thus, the patent owner's March 16, 2011 petition and the requester's March 24, 2011 opposition are premature and are accordingly dismissed.


POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address filed December 21, 2010 is ineffective because the December 21, 2010 communication was not filed in the file for the '982 patent. See the *Sua Sponte* Decision to Vacate the December 27, 2010 and January 4, 2011 Notices, mailed contemporaneously with this decision. **The current power of attorney and correspondence address in this reexamination proceeding remains to be EDELL, SHAPIRO & FINNAN, LLP., SUITE 400, 1901 RESEARCH BOULEVARD, ROCKVILLE, MD 20850-3164.** All future Office correspondence will be mailed to the above-mentioned address. As a one time courtesy, a copy is also being mailed to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. at the address listed in the December 21, 2010 communication.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 10/309,565) in order to properly effectuate a change in this reexamination proceeding.

CONCLUSION

1. The March 16, 2011 patent owner's petition, which is a petition under 37 CFR § 1.181, is dismissed as premature.
2. The March 24, 2011 third party requester's opposition petition is also dismissed as premature.
3. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.


Irem Yugel, Director
Technology Center 1600



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,460	10/01/2010	7121982	6496-00100	9962
35690	7590	03/02/2012	EXAMINER	
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398			ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Nintendo Co., Ltd. and Nintendo of America Inc.
Third Party Requester

v.

IA Labs CA, LLC
Patent Owner

Inter partes Reexamination Control 95/001,460
Patent 7,121,982

DECISION ON PETITIONS

This is a decision on:

1. "Patent Owner's Petition to Invoke the Supervisory Authority of the Director to Expunge an Improper Paper Pursuant to 37 C.F.R. § 1.181," filed December 28, 2011. (IA Labs Petition). The IA Labs Petition argues that "Third Party Requester's Appellant Brief . . . impermissibly attempts to introduce new evidence after the filing of a Notice of Appeal. Patent Owner . . . requests that the Appellant Brief be expunged as improper . . ." IA Labs Petition, p. 1; and
2. "Requester's Petition Under 37 C.F.R. § 1.183 and/or 37 C.F.R. § 1.182 to Deny the Patent Owner's December 28, 2011, Petition to Expunge Requester's November 2, 2011, Appeal Brief From the Record,"

Inter partes Reexamination Control 95/001,460
Patent 7,121,982

filed January 11, 2012. (Nintendo Petition). The Nintendo Petition argues that the IA Petition “is a litigation-style tactic that places an undue burden on the Patent Office’s resources and only serves to disrupt and delay the appeals process.” Nintendo Petition, p.1.

FINDINGS

1. On October 17, 2006, the Office issued Patent 7,121,982 (‘982 patent), which presently is assigned to IA Labs CA, LLC (“IA Labs”).
2. On October 1, 2010, Nintendo Co., Ltd. and Nintendo of America Inc. (collectively “Nintendo”) filed a request for *inter partes* reexamination of all claims of the ‘982 patent, claims 1-28.
3. On November 8, 2010, the Office granted Nintendo’s request for *inter partes* reexamination of claims 1-28 of the ‘982 patent. The reexamination proceeding was assigned control number 95/001,460.
4. Prosecution of the reexamination proceeding continued until the Office issued an Action Closing Prosecution on April 11, 2011, confirming claims 1-28 of the ‘982 patent..
5. On August 3, 2011, the Office issued a Right of Appeal Notice again confirming claims 1-28 of the ‘982 patent.
6. On September 2, 2011, Nintendo filed a Notice of Appeal.
7. On November 2, 2011, Nintendo filed Third Party Requester’s Appeal Brief (Appellant Brief).
8. Nintendo’s Appellant Brief discusses several items that previously had not been introduced into the record. Such items include four patents, a published application, and interrogatory responses in related litigation.
9. On December 2, 2011, IA Labs filed Patent Owner’s Respondent

Brief Under 37 C.F.R. § 41.68 (Respondent Brief).

10. On December 28, 2011, IA Labs filed the present IA Labs Petition seeking to have Nintendo's Appellant Brief expunged.

11. On January 11, 2012, Nintendo filed the present Nintendo Petition opposing the IA Labs Petition.

RELEVANT LEGAL AUTHORITY

With respect to evidence presented in an appellant brief in an *inter partes* reexamination proceeding, 37 C.F.R. § 41.67(c) states:

(1)(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.63 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner in any ground of rejection to be reviewed on appeal.

....

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

And 37 C.F.R. § 41.63(c) states:

Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

The authority to determine whether, in an *inter partes* reexamination proceeding appeal, the briefs comply with applicable rules is conferred upon

Inter partes Reexamination Control 95/001,460
Patent 7,121,982

the Chief Judge of the Board, as specified in 75 Fed. Reg. 50750 (Aug. 17, 2010):

[U]pon the filing of an appeal brief in an *inter partes* reexamination proceeding (i.e., an appellant's brief, a respondent's brief, or a rebuttal brief), the Chief Judge will review the appeal brief to determine whether the appeal brief complies with 37 CFR 1.943(c) and 37 CFR 41.67, 41.68, or 41.71 before it is forwarded to the Central Reexamination Unit (CRU) or other Technology Center examiner for consideration.

ANALYSIS

The parties are in agreement that the specific items that are alleged by IA Labs to be new evidence in fact have not been made of record in this proceeding prior to the filing of Nintendo's Appellant Brief.

"Evidence" is defined as:

Something (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact.

Black's Law Dictionary (9th ed. 2009).

Thus, all of the items first introduced by Nintendo in its Appellant Brief constitute new evidence.

Under Rules 41.67(c) and 41.63(c), new evidence is not permitted in an appellant brief.

In support of its position to permit the introduction of new evidence in its Appellant Brief, Nintendo argues, *inter alia*, that:

1. The Action Closing Prosecution presented, for the first time in this proceeding, a particular basis for patentability in respect to which such evidence is relevant (Nintendo Petition, pp. 8-9);
2. The Office may take official notice of patents and dictionaries to

Inter partes Reexamination Control 95/001,460
Patent 7,121,982

clarify the meaning of claim terminology (*id.* at 9-10);

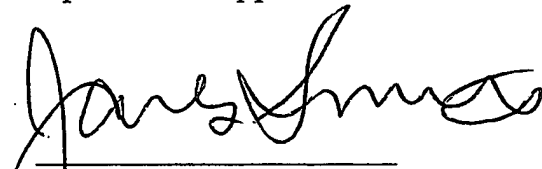
3. In this proceeding, IA Labs previously submitted identical information to the Office in an Information Disclosure Statement (*id.* at 11-12).

Nintendo could have presented arguments such as these in a petition under Rule 1.183 accompanying Nintendo's Appellant Brief seeking a waiver of Rules 41.67(c) and 41.63(c). However, no waiver of the applicable rules was sought prior to the filing of the IA Labs Petition.

DECISION

For the reasons discussed herein, the IA Labs Petition is GRANTED and the Nintendo Petition is DENIED. Nintendo's Appellant Brief filed November 2, 2011 will be expunged.

Nintendo is given one month from the date hereof to file a replacement appellant brief.



James Donald Smith
Chief Administrative Patent Judge

Inter partes Reexamination Control 95/001,460
Patent 7,121,982

Attorney for Patent Owner:
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Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
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Arlington, VA 22203



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STERNE, KESSLER, GOLDSTEIN & : (For Patent Owner)
FOX P.L.L.C. :
1100 NEW YORK AVENUE, N.W. :
WASHINGTON, DC 20005 :

MAILED

JAN 21 2011

CENTRAL REEXAMINATION UNIT

Tracy W. Druce : (For Third Party
NOVAK DRUCE & QUIGG LLP : Requester)
1000 LOUISIANA STREET :
53RD FLOOR :
HOUSTON, TX 77002 :

In re: Puente et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,461 : UNDER 37 CFR §§ 1.927 & 1.181
Deposited: October 1, 2010 :
For: U.S. Patent No.: 7,312,762 :

This is a decision on the petition filed by the third party requester on December 20, 2010, entitled "PETITION UNDER 37 CFR §§ 1.927 AND 1.181 FOR SUPERVISORY REVIEW OF REFUSAL TO ORDER REEXAMINATION FOR CLAIMS 1, 7-8, 11, AND 21," [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Granting the Request for *Inter Partes* Reexamination mailed November 19, 2010, which granted the request for claims 12, 14, 15, and 17, but denied the request for reexamination of claims 1, 7, 8, 11, and 21.

The petition is before the Director of the Central Reexamination Unit.

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,312,762 issued on December 25, 2007.
- A request for *inter partes* reexamination was filed October 1, 2010 and assigned control no. 95/001,461.
- Reexamination was requested of claims 1, 7, 8, 11, 12, 14, 15, 17, and 21. The request was granted in-part in an Order mailed November 19, 2010. The request was granted as to claims 12, 14, 15, and 17, and denied as to claims 1, 7, 8, 11, and 21.
- The instant petition was timely filed on December 20, 2010. The petition requests reconsideration and review of two proposed substantial new questions of patentability denied in the Order: that claims 1, 7, 8, 11, and 21 are obvious over WO528¹ in view of Ke, and that claims 1, 7, 8, 11, and 21 are obvious over WO528 in view of Turner.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1, 7, 8, 11, and 21 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of

¹ The terminology follows that presented in the Order. See that action for the precise citations of the references.

patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a “substantial new question of patentability” is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must “demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent.” MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the ‘762 Patent

The ‘878 patent contains claims 1-21, of which only claims 1, 7, 8, 11, and 21 are at issue in this Decision. The Director generally agrees² with the examiner’s discussion of the prosecution history in the Order Granting the Request mailed November 19, 2010 at pp. 3-4, and hereby incorporates that discussion by reference to the extent consistent with this Decision. Particularly, as discussed on page 3, it is apparent in the original examination that a reference to Sonoda was found to teach the features of claims 1 and 21 as issued, except for the material added with the addition of new claims—a conducting surface having a multilevel structure. It is also shown, as mentioned in the Order at page 4, that WO528 was discussed in the specification as teaching a multilevel antenna having a multilevel geometry. Applicant further noted in the specification that conducting surfaces could be made in accordance with the multilevel geometry discussed in WO528. Sonoda does not, however, explicitly discuss a loading structure as claimed, but the original examiner stated that this was obvious in Sonoda. This was not mentioned by the reexamination examiner and is an important point as will be discussed below.

Decision on the Request for Reexamination

As applicable here, the Request proposes that a substantial new question of patentability is raised as to claims 1, 7, 8, 11, and 21 based on WO528 in combination with either Ke or Turner. WO528 is used in precisely the same manner as it was discussed in the original specification—to show that conducting surfaces of an antenna could be made having a multilevel structure. Each of Ke and Turner are used in a similar way that Sonoda was used—to show the various limitations of the independent claims other than the conducting surfaces having a multilevel structure.

² Any agreement herein with the examiner is not to suggest that the requisite *de novo* review did not occur.

The teachings of these references do, however, differ from Sonoda. The examiner's denial was premised on the finding of fact that Ke and Turner are cumulative to Sonoda, therefore the consideration of these references with WO528 was cumulative to the implicit consideration of Sonoda with WO528. Upon further review, this is not the case.

In the original examination, Sonoda was applied against certain claims. In doing so, the original examiner stated that while elements 21a-d of Sonoda were not called a loading structure, the skilled artisan would have found it obvious to consider such elements a loading structure. *See* Non-Final Rejection mailed October 5, 2006, p. 2.

While the original examiner may be correct in that Sonoda's elements 21a-d could be obviously considered a loading structure by the skilled artisan (a point the Director need not decide), this point does alter the analysis. Ke and Turner each explicitly use a loading structure, and apparently teach reasons why a loading structure would be used. One can envision an examiner combining Ke and Turner, with these explicit teachings, with another reference (such as WO528), while determining not to combine Sonoda with the same reference in light of the more vague teachings of Sonoda. For example, while Sonoda's elements may be a loading structure, perhaps the examiner saw no reason to provide such structure in WO528 in light of Sonoda's lack of clear teachings. If that is the case, perhaps the examiner would have made the combination if he had a clearer reference with clearer motivation, such as Ke or Turner.

The Director therefore agrees with the petitioner at the middle paragraph of page 4 of the petition. Ke and Turner, unlike Sonoda, each provide an explicit teaching of a loading structure of an antenna. Each additionally, unlike Sonoda, provides a plausible reasoning as discussed in the request why a loading structure might be advantageous in an antenna. While the original examiner declined to combine Sonoda with WO528, it is not clear *why* that was the case. Given that Ke and Turner provide more explicit teachings relevant to the claims that might better support a combination, the Director does not agree with the reexamination examiner that Ke and Turner are cumulative to Sonoda.

In light of these findings, the combination of either Ke or Turner with WO528 is not cumulative to the implicit combination from the original examination of Sonoda with WO528. The combination of Ke or Turner with WO528 can plausibly be said to show all of the limitations of the relevant claims, including the material missing from the original examination, for the reasons presented in the request. The combinations therefore provide a new, non-cumulative technical teaching not present in the original examination, would have been important to a reasonable examiner, and raise a substantial new question of patentability as to claims 1, 7, 8, 11 and 21. Accordingly, the petition is granted.

Additional Discussion

Under 37 C.F.R. § 1.931(b), “If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination.” MPEP § 2648 permits the CRU Director to make an exception “Only in exceptional circumstances where no other examiner is available and capable to give a proper examination.” While the MPEP is silent as to any other exceptions, the rule does not prohibit other exceptions in an exceptional situation. The CRU Director finds this to be an exceptional situation.

The ‘762 patent is one of nine patents under reexamination owned by the patent owner. While not all of the patents are directly related, all are related to similar technology, and all are asserted by patent owner in a single copending litigation. Three different third parties have each filed *inter partes* reexamination requests for each of these patents. There are therefore 27 *inter partes* reexamination proceedings that have been filed for these patents.

As of this writing, the current reexamination examiner has issued an Order granting *inter partes* reexamination in 11 of these proceedings, including this proceeding. He has been docketed and begun work on an additional 8 of the proceedings, including two more involving the ‘762 patent. As the examiner is already intimately familiar with all of these cases, with all of their associated factual situations including similar claim terminology, it would be an extreme waste of administrative resources to transfer the case to a new examiner having no familiarity with the patent or the family of cases.

The reasoning behind the rule is likely to prevent any real or perceived bias caused by requiring an examiner to work on a case after having his decision overturned by the Director. Any such bias is deemed to be negligible here. First, the request in this proceeding has already been granted; the examiner would have been required to work on this case regardless of the instant decision. Second, while a specific finding of fact by the examiner has been overturned here (the nature of Ke and Turner being cumulative), this was not a point of emphasis in the request. There is no apparent bias as to what Ke and Turner, (or WO528 for that matter), actually teach—the denial was based not on the reading of the reference teachings, but was based on how those teachings compared to Sonoda. Now that the proposals are a part of the proceeding, there is no reason why the examiner would regard the references any differently than a new examiner.

If this were a sole request of a single patent, there would be no reason to not comply with the ordinary circumstances of section 1.931(b). In light of the above, the facts show this to be an exceptional circumstance such that this section need not be applied. The CRU Director in signing below leaves it to the Supervisory Patent Examiner in his discretion to determine if the proceeding should be kept with the same examiner or reassigned.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 1, 7, 8, 11, and 21 of the '762 patent is granted.
2. The examiner's other findings in the Order that were not mentioned in the petition are not disturbed.
3. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.
4. Claims 1, 7, 8, 11, 12, 14, 15, 17 and 21 are subject to reexamination in this proceeding. An Office action will follow in due course.
5. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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HOUSTON, TX 77002

(For requester)

MAILED

FEB 16 2011

CENTRAL REEXAMINATION UNIT

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,461
Filed: October 1, 2010
For: U.S. Patent No. 7,312,762

:
: DECISION
: DISMISSING
: PETITION
:

This is a decision on patent owner's December 7, 2010 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On December 25, 2007, the Office issued U.S. Patent No. 7,312,762 (the '762 patent) to Puente Baliarda *et al.*
2. On October 1, 2010, a first request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, assigned control No. 95/001,461 ("the '1461 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1461 requester").
3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, assigned control No. 95/000,587 ("the '587 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '587 requester").
4. For the '1461 proceeding, on November 19, 2010, *inter partes* reexamination was granted-in-part. Reexamination was granted for claims 12, 14-15, and 17 of the '762 patent, and it was denied for claims 1, 7-8, 11, and 21 of the '762 patent. An Office action was not concurrently issued. The order stated that an Office action would issue in due course.


5. On December 7, 2010, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1461 proceeding and the '587 proceeding.
6. On December 20, 2010, requester petitioned for supervisory review of the November 19, 2010 Order with regard to the denial-in-part of reexamination for claims 1, 7-8, 11 and 21 of the '762 patent. The petition requested reconsideration of the denial-in-part and a granting of reexamination of claims 1, 7-8, 11 and 21.
7. On January 21, 2011, the Office issued a decision granting the December 20, 2010 requester petition and ordering reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent.
8. On February 11, 2011, *inter partes* reexamination was ordered on claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '587 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
9. To date, no Office action has issued in the two *inter partes* reexamination proceeding ordered for the '762 patent.

DECISION

Patent owner's December 7, 2010 petition is dismissed. Initially, it is to be noted that, once all proceedings are ordered, the proceedings are ripe for consideration of whether or not to merge proceedings, and the Office's decision on whether or not to merge is within the sole discretion of the Office.¹ In this instance, as all of the reexamination proceedings have been ordered, a determination will be made in due course as to whether or not the Office will exercise its sole discretion to merge for the present situation.² In addition, should a decision be made to merge, procedures are in place to accommodate the merging of proceedings where an outstanding Office action exists.³ Accordingly, there is no basis to suspend proceedings in this instance.

CONCLUSION

1. Patent owner's December 7, 2010 petition is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet8/stay_supend... 2-15-11

¹ MPEP 2686.01 I

² MPEP 2686.01 III

³ Id.



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MAILED

MAY 25 2011

CENTRAL REEXAMINATION UNIT

In re Puente Ballarda et al
Inter Partes Reexamination Proceeding
Control No. 95/001,461
Filed: October 1, 2010
For: U.S. Patent No. 7,312,762

:
: **DECISION**
: **DISMISSING**
: **PETITION**
:

This decision is in response to the February 14, 2011 patent owner petition, entitled "Patent Owner Petition under 37 C.F.R. § 1.182 To Vacate Decision on Samsung's Petition under 37 C.F.R. § 1.927 and 1.181" (the February 14, 2011 patent owner petition).

This decision also addresses requester's opposition paper filed on March 11, 2011, entitled "Third Party Requester's Opposition under 37 C.F.R. §§ 1.182 and 1.183 to Patent Owner's Petition to Vacate Director's Decision" (the March 11, 2011 requester opposition).

The February 14, 2011 patent owner petition, the March 11, 2011 requester opposition, and the record as a whole, are before the Office of Patent Legal Administration.

SUMMARY

The February 14, 2011 patent owner petition under 37 CFR 1.182 is dismissed.

DECISION

The patent owner requests the Office to vacate its January 21, 2011 decision on requester's petition, filed on December 20, 2010.

On November 19, 2010, the Office mailed an order granting reexamination of claims 12, 14-15, and 17 of the patent under reexamination. The Office also determined, in the order, that no substantial new question (SNQ) was raised as to claims 1, 7-8, 11, and 21.¹ On December 20, 2010, the requester filed a petition requesting supervisory review of the "portion of the Order in which the Examiner refused to order reexamination of claims 1, 7-8, 11, and 21". On January 21, 2011, the Office mailed a decision granting requester's December 20, 2010 petition, and ordering the additional reexamination of claims 1, 7-8, 11, and 21 in the present proceeding.

¹ The requester did not request reexamination of claims 2-6, 9-10, 13, 16, and 18-20 of the patent under reexamination.

The patent owner asserts that the January 21, 2011 decision was an *ultra vires* action on the part of the Office, “that was not authorized by and is contrary to the Office’s Rules and the MPEP”. The patent owner argues that the Office had “no authority to reconsider a decision determining that no SNQ was raised by a reexamination request”, and that 37 CFR 1.927 “only purports to authorize the Office to review a decision on a reexamination request when there was ‘a determination refusing to order inter partes reexamination’”. The patent owner alleges that where, as here, the Office determined that SNQs were raised as to some of the patent claims, “[t]he rule does not authorize the Office to treat a reexamination request as several discrete requests on a claim-by-claim basis”

35 U.S.C. 312 provides, in pertinent part (emphasis added):

(a) REEXAMINATION. — Not later than 3 months after the filing of a request for inter partes reexamination under section 311, the Director shall determine whether a substantial new question of patentability **affecting any claim of the patent concerned** is raised by the request . . .

*

*

(c) FINAL DECISION. — **A determination by the Director under subsection (a)** shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

37 CFR 1.927 provides (emphasis added):

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of **the examiner’s determination refusing to order inter partes reexamination**. Any such petition must comply with § 1.181(b).

37 CFR 1.927 permits the determination of whether reexamination was denied on a claim-by-claim basis. There is nothing in the statute, or in the rule, that prohibits the Office from reconsidering its prior decision not to reexamine some of the patent claims that are requested to be reexamined, when the Office ordered reexamination of other patent claims based on the same request. While the statute or the rule does not specify whether they are applicable to a refusal to reexamine all, or only some of the claims that are requested to be reexamined, the Office has, and will continue to reasonably interpret the statute and the rule to apply equally in both situations.

The Office’s interpretation of statutory provisions concerning the conduct of proceedings in the Office has been given deference by the courts, as argued by the requester in its March 11, 2011 opposition paper. See *Chevron U.S.A., Inc., v. NRDC*, 467 U.S. 837, 104 S. Ct. 2778, 81 L. Ed. 2d 694 (1984). When the Office’s interpretation is reasonable, it is entitled to *Chevron* deference. *Cooper Technologies v. Dudas*, 536 F.3d 1330, 1332 (Fed. Cir. 2008). “Deference is also given to the PTO’s interpretations of its own procedural rules.” *In re Swanson*, 540 F.3d 1368, 1375 (Fed. Cir. 2008).

The Board of Patent Appeals and Interferences (Board) has recognized, with approval, that reexamination is ordered on a claim-by-claim basis. See *Belkin International, Inc. v. Optimumpath, LLC*, 2011 Pat. App. LEXIS 472 (BPAI, March 30, 2011) in which the Board stated “. . . when the Director makes a determination that a substantial new question of patentability **affecting a particular claim** is *not* raised, the Director does *not* order *inter partes* reexamination of the patent **with respect to those claims**” (emphasis in italics in original) (emphasis in bold added). In *Belkin*, reexamination was ordered as to some, but not all of the claims requested to be reexamined. The requester timely filed a petition under 37 CFR 1.927 seeking review of the refusal to reexamine some of the patent claims. In *Belkin*, the petition under 37 CFR 1.927 was denied because the Office determined that no SNQ was raised as to those claims.²

The patent owner argues that the language of the other rules governing *inter partes* reexamination support its conclusion that the triggering event for review under 37 CFR 1.927 is “the denial of an entire request”. The patent owner points to 37 CFR 1.931, which states that if an SNQ is found, “the determination will include an order for *inter partes* reexamination of the patent for resolution of the question”, and to 37 CFR 1.923, which provides that “[i]f the examiner determines that no substantial new question of patentability is present, the examiner shall refuse the request and shall not order *inter partes* reexamination”. The Office’s interpretation, however, does not conflict with these regulations. If no SNQ, as to all of the claims requested to be reexamined, is raised by the request, then reexamination is not ordered, as set forth in 37 CFR 1.923. Where, as here, at least one SNQ is originally found as to some of the patent claims, reexamination is ordered, as set forth in 37 CFR 1.931. Where the Office refuses reexamination of some, or all, of the claims requested to be reexamined, the requester may seek review by a petition to the Director under 37 CFR 1.181 within one month of the mailing date of the examiner’s determination refusing to order *inter partes* reexamination of those claims, as set forth in 37 CFR 1.927.

The patent owner argues that the example of a decision granting *inter partes* reexamination, set forth in MPEP 2647.01, supports the patent owner’s view, because in that example, the Office ordered reexamination as to claims 1-3 but refused to reexamine claim 4. The patent owner argues that the request for reexamination was granted in this example, but does not make any claim-by-claim distinction that the request was granted as to some claims but denied as to others. The patent owner appears to confuse an order granting a request for reexamination with the Office’s claim-by-claim determination, in that example, that an SNQ was determined to be raised as to claims 1-3, but no SNQ was raised as to claim 4. Contrary to patent owner’s arguments, a

² The appeal in *Belkin* involved an additional determination by the examiner that no SNQ was raised by certain references, as to some of the patent claims for which reexamination had been ordered based on other grounds. The Board explained that even if the determination that the references did not raise an SNQ were later withdrawn, “the proper sequence of events, under 35 U.S.C. 313 would be the issuance by the Director of an order ‘for *inter partes* reexamination. . .’” While the Board was referring to a determination that no SNQ as to some of the claims was raised by certain references (where reexamination of the same claims was ordered on other grounds), the Board’s analysis would apply equally where, as here, the Office refused to reexamine some of the patent claims.

claim-by-claim distinction was plainly made. Finally, the patent owner argues that the Office's form, PTOL-2603, includes a paragraph informing the requester that it may seek review of a denial of the request under 37 CFR 1.927 only when the request for reexamination is denied, and not when an SNQ is determined to be raised as to some, but not all, of the claims requested to be reexamined, i.e., the paragraph applies only when the second box is checked. However, the paragraph appears below *both boxes 1 and 2*, (i.e., whether the request is granted or denied), and applies no matter which box is checked.³ In addition, patent owner's argument is that the form could be better worded; however, the wording of the form is not determinative as to the Office's understanding of the rules.

For the reasons given above, the present petition is **dismissed**.

CONCLUSION

- The February 14, 2011 requester petition under 37 CFR 1.182 is **dismissed**.
- Any further correspondence with respect to this matter should be addressed as follows:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail: Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By Hand: Customer Service Window
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

By FAX to: (571) 273-9900
Central Reexamination Unit

³ If one were to adopt the interpretation that the paragraph informing the requester of the provisions of 37 CFR 1.927 only applies to box 2 of the form (stating that the reexamination request is denied), then the paragraph immediately beneath it, informing the parties that all correspondence relating to this *inter partes* reexamination should be directed to the Central Reexamination Unit (CRU), would equally apply only to box 2, which is a *non sequitur*.

- Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or to the undersigned, at (571) 272-7710.

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

5-24-11
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In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,461
Filed: October 1, 2010
For: U.S. Patent No. 7,312,762

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/000,599
Filed: December 3, 2010
For: U.S. Patent No. 7,312,762

: **DECISION,**
: ***SUA SPONTE,***
: **TO MERGE**
: **REEXAMINATION**
: **PROCEEDINGS**

In re Puente Baliarda et al.
Inter Partes Reexamination
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No. 7,312,762

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged (consolidated) at this time.

REVIEW OF FACTS

1. On December 25, 2007, the Office issued U.S. Patent No. 7,312,762 (the '762 patent) to Carles Puente Baliarda *et al.* with 21 claims.
2. On October 1, 2010, a request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, was filed by a third party requester and assigned control No. 95/001,461 ("the '1461 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1461 requester") as the real party in interest.
3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent, assigned control No. 95/000,587 ("the '587 proceeding"), was filed by a third party requester. The request identified Kyocera Communications, Inc. ("the '587 requester") as the real party in interest.
4. On November 19, 2010, *inter partes* reexamination of the '762 patent was granted-in-part in the '1461 proceeding. Reexamination was granted for claims 12, 14-15, and 17 of the '762 patent, and was denied for claims 1, 7-8, 11, and 21 of the '762 patent. An Office action was not concurrently issued. The order stated that an Office action would issue in due course.
5. On December 3, 2010, a third request for *inter partes* reexamination of claims 1, 8, 11 and 21 of the '762 patent, assigned control No. 95/000,599 ("the '599 proceeding"), was filed by a third party requester. The request identified HTC Corp. and HTC America, Inc. ("the '599 requester") as the real party in interest.
6. On December 20, 2010, the '1461 requester petitioned for supervisory review of the November 19, 2010 Order with regard to the denial of reexamination for claims 1, 7-8, 11 and 21 of the '762 patent in the '1461 proceeding. The petition requested that reexamination of claims 1, 7-8, 11 and 21 be ordered in the '1461 proceeding.
7. On January 21, 2011, the Office issued a decision granting the December 20, 2010 '1461 requester petition and ordering reexamination of claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '1461 proceeding.
8. On February 10, 2011, *inter partes* reexamination was ordered on claims 1, 8, 11, and 21 of the '762 patent in the '599 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.
9. On February 11, 2011, *inter partes* reexamination was ordered on claims 1, 7-8, 11-12, 14-15, 17 and 21 of the '762 patent in the '587 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

10. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '762 patent.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination is ordered in the three above-captioned proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* reexamination proceedings. All proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

The 95/001,461, 95/000,599 and 95/000,587 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of *rejection* can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

It is to be noted that, because the '599 *inter partes* third party requester did not propose any rejections of claims 7, 12, 14-15, and 17 in their request for reexamination, the '599 requester has no appeal rights as to those claims as they appear in the '762 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the third party requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by patent owner and the third party requesters should be directed as follows:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"

Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

by FAX to: (571) 273-9900
Central Reexamination Unit

by Hand to: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

by EFS: Registered users may submit papers via the
electronic filing system EFS-Web, at:

<https://spportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged

multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:


Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,461, 95/000,599 and 95/000,587 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.
2. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

May 31, 2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170
26111	7590	07/07/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG, LLP

1000 LOUISIANA STREET

53rd FLOOR

HOUSTON, TX 77002

MAILED

JUL 07 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001461

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,587 & 95/000,599 & 95/001,461
--	--

1. THIS IS A DECISION ON THE PETITION FILED 05 July 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
 The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 07 June 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

B. ☒ Other/comment: see attached

C. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[Signature]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the large number of related reexamination proceedings prosecuted at the same time as the instant proceedings as well as the length and complexity of the Office action. It is agreed that patent owner needs to be given opportunity to fully explore all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management with respect to workload resulting from related proceedings. Resource management takes into consideration the time required to respond to other Office actions.

While the additional workload from other proceedings is noted, it is the length and complexity of the office action that weighs most heavily in consideration of whether the patent owner has met the burden of providing "sufficient cause" for supporting the granting of an extension of time.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added.)

On balance, the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part



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Sterne, Kessler, Goldstein & Fox, P.L.L.C. (For Patent Owner)
1100 New York Avenue, N.W.
Washington, D.C. 20005
CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP (For *Inter Partes* '587 Requester)
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Baker Botts, LLP (For *Inter Partes* '599 Requester)
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980

Novak, Druce & Quigg, LLP (For *Inter Partes* '1461 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No.: 7,312,762

Inter Partes Reexamination Proceeding
Control No. 95/000,599
Filed: December 03, 2010
For: U.S. Patent No. 7,312,762

Inter Partes Reexamination Proceeding
Control No: 95/001,461
Filed: October 01, 2010
For: U.S. Patent No. 7,312,762

**DECISION GRANTING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND
SEVERING MERGER**

This is a decision on patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 16, 2011 petition to terminate).

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,599, filed on September 16, 2011, is granted.

Inter partes reexamination proceeding control number 95/000,599 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/000,599, 95/000,587 and 95/001,461.

Inter partes reexamination proceeding 95/000,599, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.¹

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,599 (the '599 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '599 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C. § 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338

¹ This petition does not address the petition under 37 CFR 1.182 to terminate the '587 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

of title 28". The "above listed claims" of one of the patents in suit, the '762 patent, which is the patent under reexamination in the '599 proceeding, are listed in the consent judgment as claims 1, 7, 8, 11, 12, 14, 15, 17, and 21, which include all of the claims that were determined to be subject to reexamination in the '599 proceeding (i.e., claims 1, 8, 11 and 21), and all of which are under reexamination in the merged proceeding.² The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '762 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '599 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.

Inter partes reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue**.³ Any rejection proposed by HTC (the requester of the '599 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or

² Claims 1, 8, 11, 12 and 21 were requested by HTC to be reexamined in the '599 proceeding. The Office determined, however, that no SNQ was raised by the request as to claim 12. For this reason, the claims that are subject to reexamination in the '599 proceeding are claims 1, 8, 11, and 21.

³ As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '587 proceeding which is presently pending. This petition will be addressed by a separate decision.

otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.⁴

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,587 and 95/001,461, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,587 and 95/001,461 will otherwise remain, in general, as outlined by the decision, mailed on June 01, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '599 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,599 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/000,599 (the '599 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/000,599, 95/000,587 and 95/001,461.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,587 and 95/001,461 **will continue** in the manner set forth in this decision.
- The prosecution of the '599 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '599 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '599 proceeding, as set forth in this decision.

⁴ A rejection proposed in the request that meets the requirements set forth in MPEP 2614 and 2617 may be considered to be proper. A rejection proposed in requester's comments that are timely filed after a response by the patent owner may be considered to be proper if the proposed rejection is necessitated by patent owner's amendment, if requester's comments, including the proposed rejection, satisfies 37 CFR 1.947 and 1.948, as appropriate, and if the proposed rejection also meets the requirements set forth in MPEP 2614 and 2617. See MPEP 2666.05.

- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet9



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,587	12/15/2010	7312762	3008.004REX1	3841
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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NOVAK DRUCE & QUIGG, LLP
1000 LOUISIANA STREET
53rd FLOOR
HOUSTON, TX 77002

MAILED

Date: DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001461
PATENT NO. : 7312762
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER, LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000587
PATENT NO. : 7312762
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

(For Patent Owner)

Morrison & Foerster, LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

(For *Inter Partes* '587 Requester) DEC 12 2011

CENTRAL REEXAMINATION UNIT

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1461 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No.: 7,312,762

Inter Partes Reexamination Proceeding
Control No. 95/001,461
Filed: October 01, 2010
For: U.S. Patent No. 7,312,762

DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION

This is a decision on the following patent owner petitions:¹

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,599, was granted. *Inter partes* reexamination proceeding 95/000,599 was severed from the merger of *inter partes* reexamination proceedings 95/000,599, 95/000,587 and 95/001,461, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,587 and 95/001,461.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,587, filed on September 30, 2011, is **dismissed**.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,587 (the '587 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '587 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '762 patent's claims 1, 7, 8, 11, 12, 14, 15, 17 and 21, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent

Judgment has been filed herewith UNDER SEAL” (emphasis in original).² The Office presumes that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner’s September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as “attached” to patent owner’s September 30, 2011 petition to terminate.³

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment “constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the ‘762 patent”. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”.

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the ‘587 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the ‘587 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to “provide an administrative record showing the evidence on which the findings are

² The September 30, 2011 petition to expunge is accompanied by a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

³ If this is not the case, the patent owner is required to so inform the Office.

based.” *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court’s later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to “consideration of the decision of the agency . . . and of the evidence on which it was based”); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) (“[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court.”). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA’s standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court’s later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO’s decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is **dismissed**.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled “Transmittal Letter to Accompany Information Submitted under MPEP § 724.02”, and a cover sheet containing a list of items, including an item referred to as “Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02”. The Office’s image file wrapper system, IFW, also includes a record of an “artifact sheet” that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), “. . . entered a Final Consent Judgment against Kyocera [the requester of the ‘587 *inter partes* reexamination proceeding]”, and that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). The patent owner states that the consent judgment “is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]”. The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court’s protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the ‘587 proceeding, has consented to a waiver of any protective order by the court,

if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.


The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,587 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

A handwritten signature in cursive script, reading "Brian E. Hanlon", written in dark ink.

Brian E. Hanlon
Director
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170
26111	7590	02/08/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/08/2012

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HOUSTON, TX 77002

Date:

MAILED

FEB 08 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001461

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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HOUSTON, TX 77002

(For '1461 Requester)

FEB 08 2012

CENTRAL RECORDS

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130

(For the '587 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,461
Filed: October 1, 2010
For: U.S. Patent No. 7,312,762

Inter Partes Reexamination Proceeding
Control No. 95/000,587
Filed: November 12, 2010
For: U.S. Patent No. 7,312,762

DECISION GRANTING
PETITION UNDER
37 CFR 1.183

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on September 7, 2011 in reexamination proceeding control nos. 95/000,587, 95/000,599 and 95/001,461.

The patent owner petition is before the Office of Patent Legal Administration.

The patent owner petition under 37 CFR 1.183 is **granted**, for the reasons set forth herein.

BACKGROUND

1. On December 25, 2007, United States Patent No. 7,312,762 (the '762 patent) issued to Puente Ballarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '762 patent were filed, which requests were assigned Reexamination Control Nos. 95/001,461, 95/000,587, and 95/000,599, and for each of which reexamination was instituted by the Office.
3. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1461 proceeding with the '587 and '599 proceedings (the merged proceeding).
4. June 7, 2011, the Office issued a non-final Office action in the merged proceeding.
5. On September 7, 2011, the patent owner timely filed a response submission in the merged proceeding, concurrently with the instant petition under 37 CFR 1.183.¹
6. On December 12, 2011, the Office issued a "DECISION GRANTING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING AND SEVERING MERGER," terminating the 95/000,599 proceeding and severing the 95/000,599 proceeding from the merged proceeding.²

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give

¹ On July 7, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the June 7, 2011 Office Action.

² The merged proceeding continues as to the '1461 and '587 proceedings.

rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see, e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of September 7, 2011

On September 7, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission.³ Patent owner asserts that the argument portion of the September 7, 2011 response submission is 81 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.⁴ Patent owner states that it concurrently filed a "132 Declaration" with the response submission but asserts that the declaration is "drawn to fact, not argument, and thus does not count towards the 50-page limit."⁵ Nonetheless, patent owner also requests waiver of the 50-page limit "as to those portions of the

³ Because the '599 proceeding has been terminated, this decision does not address the instant petition with respect to the '599 proceeding.

⁴ Patent owner petition under 37 CFR 1.183 at page 2.

⁵ *Id.* at page 4 (identifying a copy of the declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 (17 pages)).

132 Declaration that the PTO holds count towards the 50 page limit.”⁶ Patent owner asserts that both the response and the declaration satisfy formatting guidelines for waiver of the regulatory page limit.⁷

In support of its request for waiver of the rule, patent owner asserts that the declaration filed with the September 7, 2011 response submission does not include argument or opinions that would be counted towards the 50-page limit.⁸ Additionally, patent owner asserts that “the full length of the Response is needed to fully and adequately respond to the Office Action,” and that although the Office action “constitutes only 18 pages, it incorporates by reference almost 400 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination.”⁹ Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to “economize, avoid extraneous material and information already of record, and present arguments efficiently.”¹⁰

Based on the specific facts set forth in patent owner’s petition under 37 CFR 1.183, patent owner’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),¹¹ and the individual facts and circumstances of this case (such as the length of the June 7, 2011 Office action),¹² it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner’s petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s September 7, 2011 response submission. This waiver makes patent owner’s September 7, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,461 third party requester and the 95/000,587 third party requester have 30 days from the date of this decision, granting patent owner’s September 7, 2011 petition under 37 CFR 1.183 and entering patent owner’s September 7, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides (emphasis added):

⁶ Id. at page 2.

⁷ Id. at pages 2 and 6 (stating that the response and declaration satisfy “the following requirements: (1) double spaced; (2) non-script type font; (3) font size no smaller than 12-point; (4) conforms to the margin requirements of 37 C.F.R. § 1.52(a)(1)(ii); and (5) sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.”).

⁸ Id. at pages 4-5.

⁹ Id. at page 2-3.

¹⁰ Id. at page 3.

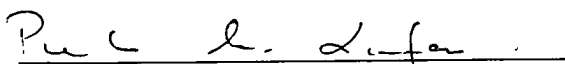
¹¹ Pages 12-94 of the remarks portion of patent owner’s September 7, 2011 response submission count toward the page limit (the cover page and table of contents pages are excluded from the page count, as is the 5-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Thus, the patent owner’s September 7, 2011 response submission exceeds the 50-page limit by at least 33 pages, without including any portions of the 17-page declaration that also count toward the page limit.

¹² On its face, the substantive portion of the June 7, 2011 Office action spans only approximately 14 pages, but in setting forth the rejections that have been adopted, it incorporates by reference over 180 pages from the ‘587, ‘599 and ‘1461 requests for *inter partes* reexamination.

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, “[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner’s completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed ... The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so.” Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

CONCLUSION

1. Patent owner’s September 7, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of patent owner’s September 7, 2011 response submission. This waiver makes patent owner’s September 7, 2011 response submission page-length compliant.
2. The 95/001,461 third party requester and the 95/000,587 third party requester each has 30 days from the mailing date of this decision, granting patent owner’s September 7, 2011 petition under 37 CFR 1.183 and entering patent owner’s September 7, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.
3. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.


Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

02-07-2012



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,461	10/01/2010	7,312,762	3008.004REX0	1170
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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HOUSTON, TX 77002

Date:

MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001461 + 95000587

PATENT NO. : 7312762

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 27 2012

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(For *Inter Partes* '587 Requester)

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(For *Inter Partes* '1461 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,587
Filed: December 15, 2010
For: U.S. Patent No.: 7,312,762

Inter Partes Reexamination Proceeding
Control No. 95/001,461
Filed: October 01, 2010
For: U.S. Patent No. 7,312,762

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).¹

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 & If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,461 (the '1461 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1461 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

¹ On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/000,599. *Inter partes* reexamination proceeding 95/000,599 was severed from the merger of *inter partes* reexamination proceedings 95/000,599, 95/000,587 and 95/001,461, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,587 and 95/001,461.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,587 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,587 (the '587 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,312,762 (the '762 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '587 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument". However, the copy of the court's September 22, 2011 consent judgment, which is attached to the present petition as "Exhibit A", contains, in the caption, the phrase "Order FILED UNDER SEAL", and is further stamped with the term "SEALED" above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02", that the "Final Consent Judgment was filed with

the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). As discussed in the December 12, 2011 decision dismissing patent owner’s September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.² The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court’s consent judgment to the Office and to disclose the court’s consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the ‘587 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner’s arguments, and requester’s opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the ‘587 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner’s response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

² For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,587 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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CENTRAL REEXAMINATION UNIT

In re: Sanz et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,462 : UNDER 37 CFR §§ 1.927 & 1.181
Deposited: October 1, 2010 :
For: U.S. Patent No.: 7,411,556 :

This is a decision on the petition filed by the third party requester on December 29, 2010, entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 CFR § 1.181 FOR SUPERVISORY REVIEW OF DENIAL OF REEXAMINATION FOR PATENT CLAIMS 23, 26, 28-30 AND 32-35" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Granting the Request for *Inter Partes* Reexamination mailed November 29, 2010, which granted the request for claims 36-41 and 43, but denied the request for reexamination of claims 23, 26, 28-30 and 32-35.

The petition is treated as a petition under 37 CFR §§ 1.927 and 1.181. The petition is before the Director of the Central Reexamination Unit.

The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,411,556 issued on August 12, 2008.
- A request for *inter partes* reexamination was filed October 1, 2010 and assigned control no. 95/001,462.
- Reexamination was requested of claims 23, 26, 28-30, 32-41, and 43. The request was granted in-part in an Order mailed November 29, 2010. The request was granted as to claims 36-41 and 43, and denied as to claims 23, 26, 28-30 and 32-35.
- The instant petition was timely filed on December 29, 2010. The petition requests reconsideration and review of the proposed substantial new questions of patentability denied in the Order that involved claims 23, 26, 28-30 and 32-35. See Petition pp. 2-3.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 23, 26, 28-30, and 32-35 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed

publications relied upon in the request raise a substantial question of patentability, then a “substantial new question of patentability” is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must “demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent.” MPEP § 2616. The converse is that if the cited patents or printed publications do not present a new, non-cumulative technical teaching then they do not raise a substantial new question of patentability. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the ‘556 Patent

The ‘556 patent contains claims 1-44, of which only claims 23, 26, 28-30 and 32-35 are at issue in this decision. The Director agrees¹ with the examiner’s discussion of the prosecution history in the Order Granting the Request mailed November 29, 2010 at pp. 4-6, and hereby incorporates that discussion by reference. Particularly, as discussed on page 6, it is apparent in the original examination, based on the rejections of nearly identical claims and the arguments of the applicant, that the material important to patentability of these claims was the requirement of the claimed “first radiating arm . . . having a section comprising a space-filling curve.” The Wong reference, used to reject said nearly identical claims, provided all of the limitations of the claims except for this feature. Wong was not applied against the present claims, which differed only by having this feature.

Decision on the Request for Reexamination

As applicable here, the Request proposes that a substantial new question of patentability is raised as to claims 23, 26, 28, 30 and 32-35 based on one of Yanagisawa, Ha, or Teng. The Request proposes a substantial new question of patentability of claim 29 based on either Ha or Teng combined with other references.

As to claims 23, 26, 28, 30 and 32-35, as described above the material missing from the original prosecution was the claimed “first radiating arm . . . having a section comprising a space-filling curve.” References showing this feature would provide the new, non-cumulative technical teaching necessary for raising a substantial new question of patentability. The question therefore comes down to whether Yanagisawa, Ha, or Teng show a space-filling curve.

¹ Any agreement with the examiner in this Decision is not to suggest that the requisite *de novo* review did not occur.

Claim Construction

Before one can determine if the references meet the claim terms, those terms must be construed. Here, the examiner in the Order construed the term “space-filling curve” in light of the specification of the ‘556 patent. Order pp. 7-9. It is apparent that this was not a simple exercise in light of the inconsistencies noted by the examiner. But the examiner’s discussion is well reasoned and the Director generally agrees with and adopts the reasoning to the extent it is consistent with this Decision. A modification to the definition will be discussed.

Under the examiner’s definition, which comes directly from the co-owned and incorporated by reference application, the meandering sections shown in Figs. 1 and 6 of the ‘556 patent fall within the definition of a space-filling curve. The sections shown in Figs. 2-5 do not fall under the definition. This is consistent with the specification for Figs. 1 and 6 (which the specification says includes space-filling curves) and Figs. 3-5 (which the specification says do not include space-filling curves). This is inconsistent with the specification for Fig. 2, which the specification says has a space-filling geometry.

Under the broader definition urged by the third party, *see* Petition p. 5 left col., which comes from the ‘556 specification, the meandering sections in all of Figures 1-6 fall within the definition of a space-filling curve. This is consistent with the remaining part of the specification for Figs. 1-2 and 6, and is inconsistent with the remainder of the specification for Figs. 3-5.

So, we have two definitions, each found in the specification,² for a space-filling curve. The two definitions are each inconsistent with other statements made in the specification. One might add that the narrower definition is more consistent with the specification, as only one figure has inconsistencies, rather than three. The two definitions, however, are not inconsistent with each other—one is simply a broader variant.

And there lies the problem in the examiner’s choice, and the petitioner’s subsequent argument. We do not have to choose one of the two definitions, we can choose both. The “broader” definition was set forth in the specification. Then the narrow definition was set forth, including the “broader” definition and then additional defined limits. If an applicant, in being his own lexicographer, sets forth a definition, and then sets forth additional limits on that definition, it does not make sense to ignore the additional limits. It should not have been a case, in the Order, of choosing between the two definitions, it was simply a case of continuing to read as the definition was further fleshed out.

² While one definition is actually found in another patent, that patent is incorporated by reference for its discussion of space-filling curves and therefore is as much a part of the ‘556 patent as if it had been written therein.

For example, if I were to say "The character A is a letter," and then later were to say "The character A is a letter, and is also a vowel," then there is no reason to choose between the two definitions. Each is consistent with the other, one is simply narrower and further defines the term. By stating both, I clearly meant both to be true, I did not intend ambiguity to force the reader to pick one. In the same way, applicant stating "A space-filling curve is characterized by X," and then later saying "The following definition is taken for a space-filling curve: X, and further Y," does not force the user to choose one definition over the other. The second definition is merely a fleshing out of the first.

Thus, to the extent that we have to choose between the broader and narrower definitions, the narrower should be chosen because it is simply fleshing out the definition, further defining the term. If a definition is set forth, you do not read just a part of it, you read it in its entirety. This definition is furthermore less inconsistent with the rest of the specification; the broad recitation wrongly includes Figs. 3-5, but when further limited these figures are rightfully excluded. Still, there is inconsistency in the specification as to Fig. 2 which must be explained.

As described, this definition is the one that the applicant set forth for space-filling curve in being its own lexicographer. This definition, however, would exclude the meandering section of Fig. 2 as it is periodic with less than ten segments in the period. Yet, the specification calls the Fig. 2 section a space-filling curve. There is no way to reconcile this given the various disclosures in the patent, except to simply say that: whatever is the definition of a space-filling curve, the definition also includes the curve 32 shown in Fig. 2.

This result is logical in that it is exactly what applicant told us was a space-filling curve. We use the entirety of the definition of space-filling curve, as applicant told us. But we were also told that Fig. 2 has a space-filling curve. The patent put the public on notice: a space-filling curve is [the narrower def. as adopted herein], and also the curve in Fig. 2 is a space-filling curve. There is no reason to go against the exact things that the patent specification is telling us.

The block quote on page 8 of the Order is therefore taken as the definition of a space-filling curve, with the additional caveat that regardless of what that definition says, Fig. 2 also shows a space-filling curve 32. If a curve meets the definition as set forth, or if the curve is the same curve as shown in Fig. 2, it can be called a space-filling curve as defined in the '556 patent. This result both uses the entirety of the definition as described in the patent, and also resolves the inconsistency presented by Fig. 2. It does not expand on what was already in the specification; that is, it does not include material other than what the public was already on notice for as being included as a space-filling curve. This is opposed to the petitioner's urging of the broader definition, which would expand the definition from what was already present in the specification—it would allow the claims to cover what is in Figs. 3-5 when they were explicitly excluded.

Once this claim construction is completed, it is clear that none of Yanagisawa, Ha, or Teng teaches a space-filling curve as claimed. The examiner has already explained in the Order why this is the case, and the explanation is agreed to by the Director and need not be repeated. *See* Order pp. 11-16. This discussion is not changed by the caveat introduced into the definition. The Director additionally agrees with the examiner that the allegedly new teachings of the Teng reference are substantially identical to the teachings of Wong that were already applied and considered during the original examination. The proposal based on Teng therefore is denied for the additional reason that Teng's teachings are cumulative to Wong's teachings, therefore even if a substantial question of patentability were raised it would not be a new question.

As to the claim 29 proposals, as explained by the examiner in the Order at page 16, the secondary references are provided only for their teachings as to dependent claim 29. They do not remedy the deficiencies of Ha or Teng as to parent claim 23, namely that Ha and Teng do not provide a new technical teaching not present during the original examination. These proposals therefore fail for the same reasons as the proposals that rely on Ha or Teng alone.

Accordingly, the Director finds that the Yanagisawa, Ha, and Teng references do not show the "space-filling curve" limitation, and therefore do not provide a new, non-cumulative technical teaching that was not present during the original examination. The references therefore fail to raise a substantial new question of patentability as to claims 23, 26, 28, 30 and 32-35. As to claim 29, the cited secondary references do not remedy these deficiencies and therefore likewise the combination of Ha or Teng with such references fails to raise a substantial new question of patentability for claim 29 for the same reasons. Teng is additionally cumulative to the Wong reference cited during the original examination, a further reason for denying the proposals based on that reference.

Response to the Petition

Even with the Director's *de novo* review set forth above, petitioner sets forth several arguments why the reexamination request should be granted as to these claims. These will be addressed.

(1) Argument that the examiner must use the broader of conflicting interpretations

As described in the Order and also discussed herein, the '556 patent is not entirely consistent in its definitions and description of space-filling curves. Petitioner argues that the examiner's construction that contradicts a disclosed embodiment does not comport with the broadest reasonable interpretation consistent with the specification. *See* Petition p. 2. Petitioner further argues that when faced with the inconsistencies of the specification and confronted with two different definitions, the examiner must use the broadest definition under the broadest reasonable

interpretation standard. *See* Petition pp. 4-6. Petitioner's statements are not necessarily incorrect, but they are not persuasive when applied to this case.

First, to the extent that Petitioner relies on the holding of *Vitronics* that a construction excluding the preferred embodiment is rarely correct, this holding is not applicable here. *See* Petition p. 2 (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)). Nowhere is Fig. 2 called a "preferred" embodiment, but in any event the Fig. 2 embodiment falls under the space-filling curve definition, as the construction herein modifies that of the Order. But even if that were not the case, many of the claims other than those at issue here are not limited to space-filling curves. Fig. 2 could potentially read on these other claims. There is no maxim that all claims must read on all embodiments. Any reliance on *Vitronics* is misplaced.

To the argument that the examiner must use the broadest of conflicting definitions, as described herein the definitions themselves do not conflict with one another, and the applied definition is not in actuality "choosing" one over the other. The Director is merely taking the full definition of the term as defined in the specification. There is no maxim that an examiner, when faced with a definition in the specification, must follow only a part of that definition simply because that would be broader. The requirement is to use the broadest reasonable interpretation *consistent with the specification*. As shown herein, the broader definition urged by the petitioner is not consistent with the specification. The narrower definition adopted herein with the caveat described above is consistent with the specification and therefore properly fits the requirements for claim construction as followed by the Office.

(2) Argument that patent owner's infringement contentions require a broad interpretation

Petitioner argues that the narrower definition adopted by the examiner is not consistent with the manner in which the patent owner has broadly construed the claims in litigation. Petition pp. 6-8. Simply put, the patent owner's contentions are not controlling on the Office, nor are they "admissions" as to what necessarily is the scope of the claims, therefore the argument is not persuasive.

It is true that, in a vacuum, what a patent owner says about his claim might impact the claim construction. Given nothing more to go on, a patent owner's contentions might shed a light as to what the broadest reasonable construction might encompass, and the examiner may utilize such contentions to help in construing the claims. But these arguments are not dispositive. It is not patent owner's place to tell us the construction of the claims. It is the responsibility of the Office (during examination) and of the courts (during litigation) to construe the claims. Any argument by the patent owner, or any other party, is just that—argument. If patent owner's argument in the courts is too broad, the Office trusts that the courts will do their job and rein in the

construction so that it is proper. The solution is not to construe the claims in an overly broad manner at the Office simply because the patent owner made such an argument in the courts.

In a similar vein, the arguments by patent owner as to claim construction presented to the court and submitted in the request are not “admissions” in the sense applicable to this proceeding. This is because, again, it is not the patent owner’s place to construe the claims. Admissions go to facts; for example the underlying factual inquiries such as what is in the prior art may be admitted to by a party. Claim construction is a matter of law, and it is the responsibility of the Office to determine the meaning of the claims during reexamination. It is not an issue that can be “admitted” by the parties.

To summarize this point: if the patent owner has improperly construed the claims in litigation, it is not the Office’s responsibility to continue to improperly construe the claims due to that fact. It is Court’s responsibility in the litigation to ensure that the patent owner’s construction, if improper, does not stand.

The petitioner further sets forth an interpretation, apparently endorsed by the patent owner, that when the definition of space-filling curve requires counting of segments this only means the perimeter of any segments and not the segments themselves. Petition p. 8. Such a reading is not persuasive as it goes expressly against what is in the specification. It is explicitly stated in the specification that Figs. 3-5 of the ‘556 patent do not show space-filling curves. If the claims were read as urged by the petitioner then there would be no avoiding calling the sections of Figs. 3-5 space-filling curves. Even if patent owner has read the claims in this manner, it is an unreasonable reading in light of the specification’s exclusion.

The petitioner’s arguments are therefore not persuasive. While a patent owner’s construction of the claims in litigation may have persuasive value, it is ultimately the Office that must determine the meaning of the claims in an Office proceeding, it is not something that can be admitted by the parties. If the parties have improperly construed the claims in the courts, it is up to the courts to correct this; it is not the Office’s place to issue an incorrect construction just to coincide with a party’s construction outside the Office.

(3) Argument that Teng is viewed in a new light

Petitioner finally argues that Teng is viewed in a new light based on the infringement contentions and petitioner’s claim construction argument. Petition p. 10. This argument could only succeed if the Director adopted the petitioner’s arguments as to claim construction. As these arguments are not adopted in the preceding sections, this argument is likewise unpersuasive. The figure presented from Teng is being viewed in the same way as the nearly identical figure from Wong, discussed and applied during the original examination.

Accordingly, because the proposals do not raise a substantial new question of patentability, the request for reexamination of claims 23, 26, 28-30 and 32-35 of the '556 patent is denied. Petitioner's additional arguments for ordering *inter partes* reexamination of the claims are not persuasive, and the petition filed December 29, 2010 is denied.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is denied. Accordingly, the request for *inter partes* reexamination of claims 23, 26, 28-30 and 32-35 of the '556 patent is denied.
2. The examiner's other findings in the Order that were not mentioned in the petition or herein are not disturbed.
3. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.
4. Claims 36-41 and 43 remain subject to reexamination in this proceeding.
5. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit



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CENTRAL REEXAMINATION

In re Sanz et al.
Inter Partes Reexamination
Control No. 95/001,462
Filed: October 1, 2010
For: U.S. Patent No. 7,411,556

:
: DECISION
: DISMISSING
: PETITION
:
:

This is a decision on patent owner's December 7, 2010 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On August 12, 2008 the Office issued U.S. Patent No. 7,411,556 (the '556 patent) to *Sanz et al.*
2. On October 1, 2010, a first request for *inter partes* reexamination of claims 23, 26, 28-30, 32-41 and 43 of the '556 patent, assigned control No. 95/001,462 ("the '1462 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1462 requester").
3. On November 16, 2010, a second request for *inter partes* reexamination of claims 23, 26, 28-30, 32-41 and 43 of the '556 patent, assigned control No. 95/000,590 ("the '590 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '590 requester").
4. On November 29, 2010, *inter partes* reexamination was ordered-in-part for claims 36-41, and 43, denied-in-part for claims 23, 26, 28-30, and 32-35 of the '556 patent in the '1462 proceeding based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requester in the October 1, 2010 request for

reexamination. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

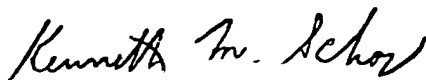
5. On December 7, 2010, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1462 proceeding and the '590 proceeding.
6. On December 29, 2010, requester petitioned for supervisory review of the November 29, 2010 Order with regard to the denial-in-part of reexamination for claims 23, 26, 28-30, and 32-35 of the '556 patent. The petition requested reconsideration of the denial-in-part and a granting of reexamination of claims 23, 26, 28-30, and 32-35 of the '556 patent
7. On January 21, 2011, the Office issues a decision denying the December 20, 2010 requester petition to order reexamination of claims 23, 26, 28-30, and 32-35 of the '556 patent
8. To date, no Office action has issued in the '1462 *inter partes* proceeding, and no order has issued in the '590 proceeding.

DECISION

Patent owner's December 7, 2010 petition is premature. The question of whether or not reexamination will be ordered the '590 proceeding has not yet been decided. The statutory mandate of special dispatch in reexamination calls for the Office to move forward with the issuance of an Office action in the '1462 *inter partes* proceeding, and issuance of such an action would not preclude merger at a later stage. Also note that a request for suspension until a merger decision issues is unnecessary, as decisions as to whether or not to merge are rendered in due course in accordance with special dispatch.¹ Furthermore, once all proceedings are ordered, the Office may decide not to merge, as merger is within the sole discretion of the Office.²

CONCLUSION

1. Patent owner's December 7, 2010 petition is dismissed.
2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

¹ MPEP 2686.01 III

² MPEP 2686.01 I



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462 95/000,590	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	05/05/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 05/05/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 5-5-11

NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET
53rd FLOOR
HOUSTON, TX 77002

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462 * 95/000590
PATENT NO. : 7411556
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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MAY 05 2011

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein, & Fox, PLLC (For Patent Owner)
1100 New York Avenue, NW
Washington, DC 20005

Morrison & Foerster LLP (For *Inter Partes* '590 Requester)
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Novak, Druce, & Quigg LLP (For *Inter Partes* '1462 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,590
Filed: December 16, 2010
For: U.S. Patent No. 7,411,556

:
:
:
: **DECISION, *SUA SPONTE*,**
: **MERGING**
: ***INTER PARTES***
: **PROCEEDINGS**

Inter Partes Reexamination Proceeding
Control No. 95/001,462
Filed: October 1, 2010
For: U.S. Patent No. 7,411,556

:
:
:
:

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,411,556 (the '556 patent) issued to Alfonso Sanz *et al.* on August 12, 2008.
2. The 95/001,462 *inter partes* proceeding.
On October 1, 2010, a request for *inter partes* reexamination of claims 36-41 and 43 of the '556 patent was filed by third party requester; the request was assigned control number 95/001,462 (the '1462 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest.
Reexamination was ordered on November 29, 2010.
3. The 95/000,590 *inter partes* proceeding.
On November 22, 2010, a request for *inter partes* reexamination of claims 36-41 and 43 of the '556 patent was deposited by third party requester; the request was assigned control number 95/000,590 (the '590 *inter partes* proceeding), and a filing date of December 16, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest.
Reexamination was ordered on February 18, 2011.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

As evidenced by the above review of facts, both the '1462 and the '590 reexamination proceedings are currently pending. Orders granting reexamination of claims 36-41 and 43 of the '556 patent have been mailed in both the '1462 and '590 reexamination proceedings, and a decision under 37 C.F.R. § 1.989(a) is timely. Both proceedings are at the same stage, in which no Office action on the merits has been issued.

The general policy of the Office is that two reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and (3) to expedite the prosecution of both proceedings. In the present instance, merger of the '1462 and '590 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the

'1462 and '590 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

The claims are identical in both proceedings. The patent owner is required to continue to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *inter partes* reexamination proceeding with another *inter partes* reexamination proceeding. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).¹ First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02, 2678 through 2683. As pointed out in MPEP 2674:

A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim

¹ Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

(i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office or filed by the patent owner and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requesters must consist of a single paper, **filed in duplicate**, each bearing a signature and identifying data for both proceedings, for entry into the file for each proceeding.

All papers that are filed by the patent owner and the third party requesters should be directed:

By EFS: Registered users may submit papers via the electronic filing system EFS-Web, at <https://spportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

For EFS-Web transmissions, 37 C.F.R. § 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 C.F.R. § 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

By Mail to: Mail Stop "Inter Partes Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand (or delivery service) to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

The patent owner and the requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, including papers filed *via* facsimile transmission, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 C.F.R. § 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 C.F.R. § 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters), even though the brief relates to merged multiple proceedings and even though copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

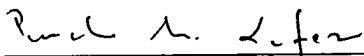
Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest and the third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 C.F.R. § 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 C.F.R. § 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,462 and *inter partes* Reexamination Control No. 95/000,590 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

May 3, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	06/14/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 06/14/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	06/14/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date: **MAILED**
JUN 14 2011
CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590
PATENT NO. : 7411556
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,590 & 95/001,462
--	--------------------------------------

1. THIS IS A DECISION ON THE PETITION FILED 06 June 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action dated 06 May 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

A. ☒ Petition fee per 37 CFR §1.17(g):

i. ☐ Petition includes authorization to debit a deposit account.

ii. ☐ Petition includes authorization to charge a credit card account.

iii. ☐ Other: _____

B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)

C. ☒ Petition was timely filed.

D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).

B. ☒ Other/comment: see attached

C. ☐ Dismissed because:

i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).

ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.

iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).

v. ☐ The petition is moot.

vi. ☐ Other/comment: _____

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/
 [Signature]

SPE, AU 3992 Central Reexamination Unit
 (Title)

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added).

On balance the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	10/27/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET
53rd FLOOR
HOUSTON, TX 77002

MAILED

Date: OCT 27 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462
PATENT NO. : 7411556
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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SUITE 100

SAN DIEGO, CA 92130-2040

Date: **MAILED**

OCT 27 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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(For Patent Owner)

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(For '590 *Inter Partes* Requester)

NOVAK, DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

(For '1462 *Inter Partes* Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,590
Filed: December 16, 2010
For: U.S. Patent No. 7,411,556

Inter Partes Reexamination Proceeding
Control No. 95/001,462
Filed: October 1, 2010
For: U.S. Patent No. 7,411,556

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: **DECISION**
: **GRANTING**
: **PETITIONS**
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MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

This is a decision on patent owner's petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on August 8, 2011. This is also a decision on third party requester's petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 CFR § 1.943(A)," filed on September 7, 2011.

Both the patent owner petition and the third party requester petition are before the Office of Patent Legal Administration.

The patent owner and the third party requester petitions are granted, for the reasons set forth herein.

BACKGROUND

1. On August 12, 2008, U.S. Patent No. 7,411,556 (the '556 patent) issued to Sanz *et al.*
2. On October 1, 2010, a first request for *inter partes* reexamination of the '556 patent, assigned control number 95/001,462 ("the '1462 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1462 requester").
3. On November 16, 2010, a second request for *inter partes* reexamination of the '556 patent, assigned control number 95/000,590 ("the '590 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '590 requester"). On December 16, 2010, a corrected request for *inter partes* reexamination was filed in the '590 proceeding.
4. On November 29, 2010, *inter partes* reexamination was ordered in the '1462 proceeding.
5. On February 18, 2011, *inter partes* reexamination was ordered in the '590 proceeding.
6. On May 5, 2011, a decision, *sua sponte*, merging the '1462 and '590 *inter partes* reexamination proceedings was mailed by the Office ("the merged proceeding").
7. On May 6, 2011, a non-final rejection was mailed by the Office in the merged proceeding.
8. On August 8, 2011, patent owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" ("patent owner petition under 37 CFR 1.183"), concurrently with a patent owner response to the May 6, 2011 Office action.¹
9. On September 7, 2011, the '1462 requester filed the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 CFR § 1.943(A)" ("the '1462 requester petition under 37 CFR 1.183"), concurrently with the '1462 requester's comments after the patent owner's August 8, 2011 response submission and the May 6, 2011 Office action.

DECISION

I. Relevant Authority

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be

¹ On June 14, 2011, the Office mailed a decision granting, in-part, patent owner's June 6, 2011 "Petition for Extension of Time to File Response to First Office Action Pursuant to 37 CFR 1.956 in Merged Proceedings" and extending the time period for patent owner's response to the May 6, 2011 Office action by one month.

suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts**, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited** to establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Additionally, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a patent owner response or third party requester comments submission that:

- 1) is one-and-a-half or double-spaced;
- 2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
- 3) has a font size no smaller than 12-point;
- 4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
- 5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a patent owner response or a third party requester comments submission.

A. Patent Owner Petition Under 37 CFR 1.183

Patent owner's August 8, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed response to the May 6, 2011 Office action, has been fully considered. In the instant petition under 37 CFR 1.183, patent owner requests that the page limit requirement of 37 CFR 1.943(b) be waived for patent owner's August 8, 2011 response submission.² In particular, patent owner states that "[t]he argument portion of the Response filed herewith is 104 pages. Also filed herewith is a 132 Declaration that totals 23 pages."³ Patent owner also asserts that "the declaration is drawn to fact, not argument, and thus does not count towards the 50-page limit. However, if the PTO should disagree, then Patent Owner hereby requests waiver of the 50-page limit for the 132 declaration...."⁴

In support of waiver of 37 CFR 1.943(b), patent owner states that "the full length of the Response is needed to fully and adequately respond to the Office Action" because "the Office Action is based on the combination of two *Inter Partes* reexamination requests and grants and additional rejections asserted by the Examiner."⁵ Patent owner asserts that "[s]pecifically, the Office Action includes 18 separate grounds of rejection over 8 separate references and five new rejections under Office Notice alleged by the Examiner" and that "[w]hile the pending Office action constitutes only 17 pages, it incorporates by reference almost 400 pages of argument and detailed claim charts...."⁶ Patent owner also states that it "has made a good faith effort to comply with the 50 page-limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently" and that "Patent Owner has avoided duplication of argument, referring back to sections containing applicable arguments (where such is possible without diluting the argument), rather than reproducing those arguments in multiple portions of the Response."⁷

² Patent owner petition under 37 CFR 1.183 at page 2.

³ Id. at page 2.

⁴ Id. at page 4.

⁵ Id. at page 2.

⁶ Id. at pages 2-3.

⁷ Id. at page 3.

In this instance, patent owner has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a response that is in excess of 50 pages. Based on the guidance set forth above, the remarks portion of the August 8, 2011 response includes up to 105 pages (pages 20-124) that count toward the regulatory page limit, and the declaration under 37 CFR 1.132 by Dr. Raj Mitra includes up to 20 pages (pages 3-22) that count toward the regulatory page limit.

Based on patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response which is in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the size of the May 6, 2011 Office action, including the number of rejections and incorporation by reference of pages from the requests for *inter partes* reexamination in the '1462 and '590 proceedings,⁸ it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's August 8, 2011 response submission exceeds the regulatory page limit by up to 75 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response to the May 6, 2011 Office action to exceed the page limit by up to 75 pages. This waiver makes patent owner's August 8, 2011 response submission page-length compliant.

B. The '1462 Requester Petition Under 37 CFR 1.183

The '1462 requester's September 7, 2011 petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its concurrently-filed comments submission, has been fully considered. In the instant petition under 37 CFR 1.183, the '1462 requester requests that the page limit requirement of 37 CFR 1.943(b) be waived for requester's September 7, 2011 comments submission to permit requester to submit comments including 63 pages of arguments and a 9-page declaration under 37 CFR 1.132 of Dr. Balanis.⁹ The '1462 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 63 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue."¹⁰ In particular, the '1462 requester states that "Samsung has attempted to respond in as

⁸ See May 6, 2011 Office action at pages 4-11.

⁹ The '1462 requester petition under 37 CFR 1.183 at page 1.

¹⁰ Id. at page 3. The '1462 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on pages 2-3, the '1462 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not

little a number of pages as possible but was unable to do so within the 50 page limit.”¹¹ Requester also asserts that “[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner’s 104 page response and 23 page declaration.”¹²

In support of waiver of 37 CFR 1.943(b), the ‘1462 requester asserts “[t]his waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions” and that “the Requester is asking for significantly fewer total pages that [sic] the Patent Owner has submitted...”¹³ The ‘1462 requester further asserts that “in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.”¹⁴

In this instance, the ‘1462 requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a comments submission that is in excess of 50 pages. Based on the guidance set forth above, the remarks portion of the September 7, 2011 comments submission includes up to 63 pages (pages 1-63) that count toward the regulatory page limit, and the declaration under 37 CFR 1.132 by Dr. Constantine A. Balanis includes up to 7 pages (pages 3-9) that count toward the regulatory page limit.

Based on the ‘1462 requester’s showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit and submitting the resulting comments submission which is in excess of 50 pages, and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent the ‘1462 requester’s September 7, 2011 comments submission exceeds the regulatory page limit by up to 20 pages. Accordingly, the ‘1462 requester petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the ‘1462 requester’s September 7, 2011 comments submission to exceed the regulatory page limit by up to 20 pages. This waiver makes the ‘1462 requester’s September 7, 2011 comments submission page-length compliant.

CONCLUSION

1. Patent owner’s August 8, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner’s August 8, 2011 response submission to exceed the regulatory page limit by up to 75 pages. This waiver makes patent owner’s August 8, 2011 response submission page-length compliant.
2. The ‘1462 requester’s September 7, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the ‘1462 requester’s

be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

¹¹ Id. at page 2.

¹² Id.

¹³ Id.

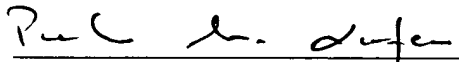
¹⁴ Id.

Inter Partes Reexamination Control Nos.
95/001,462 and 95/000,590

-7-

September 7, 2011 comments submission to exceed the regulatory page limit by up to 20 pages. This waiver makes the '1462 requester's September 7, 2011 comments submission page-length compliant.

3. The '590 requester has 30 days from the mailing date of this decision, making patent owner's August 8, 2011 response submission page-length compliant, to file written comments pursuant to 37 CFR 1.947.
4. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole Dretar Haines, Legal Advisor, at (571) 272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

10-26-2011



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,590	12/16/2010	7411556	3008.005REX1	9362
26111	7590	12/12/2011	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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DEC 12 2011

Date:

CENTRAL REEXAMINATION UNIT

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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000590
PATENT NO. : 7411556
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISIANA STREET
53rd FLOOR
HOUSTON, TX 77002

Date:

MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462
PATENT NO. : 7411556
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



United States Patent and Trademark Office

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(For Patent Owner)

MAILED

DEC 12 2011

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(For *Inter Partes* '590 Requester)

CENTRAL REEXAMINATION UNIT

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(For *Inter Partes* '1462 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,590
Filed: December 16, 2010
For: U.S. Patent No.: 7,411,556

Inter Partes Reexamination Proceeding
Control No. 95/001,462
Filed: October 01, 2010
For: U.S. Patent No. 7,411,556

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING AND PETITION
TO EXPUNGE INFORMATION**

This is a decision on the following patent owner petitions:

1. The September 30, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the September 30, 2011 petition to terminate); and
2. The September 30, 2011 petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge).

Patent owner's petition to terminate filed on September 30, 2011, patent owner's petition to expunge filed on September 30, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,590, filed on September 30, 2011, is dismissed.

Patent owner's petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP § 724.02, filed on September 30, 2011, is **dismissed**.

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,590 (the '590 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,411,566 (the '556 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '590 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '556 patent's claims 23, 26, 28-30, 32-41, and 43, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

As an initial matter, the Office has not received, to date, any paper entitled "Exhibit A" or any paper entitled "Final Consent Judgment" as an *attachment to the instant petition to terminate*. However, in its concurrently-filed petition entitled "Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02" (the September 30, 2011 petition to expunge, discussed below), the patent owner informs the Office that "[t]he Final Consent Judgment has been filed herewith UNDER SEAL" (emphasis in original).¹ The Office presumes

¹ The September 30, 2011 petition to expunge is accompanied by a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image

that the consent judgment, which has apparently been separately filed with the Office under seal as referenced in patent owner's September 30, 2011 petition to expunge, is the same consent judgment referred to by the patent owner as "attached" to patent owner's September 30, 2011 petition to terminate.²

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the currently pending claims] of the '556 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

For this reason, in order to rely on the consent judgment as the basis for the determination of whether the provisions of 35 U.S.C. 317(b), as outlined in the above-listed elements 1 – 4, have been met, the Office would be required to enter the consent judgment into the record prior to its consideration. The Office would then analyze the consent judgment, and refer to it in the decision as the basis for its determination. Any paper that has been entered into the record must be open to inspection by the general public. See 37 CFR 1.11(d), which provides, in pertinent part:

All papers or copies thereof relating to a reexamination proceeding which have been entered of record in the patent or reexamination file are open to inspection by the general public . . .

However, in its concurrently-filed petition to expunge, which is discussed below, the patent owner expressly requests that the consent judgment be *expunged* from the record after the concurrently-filed petition to terminate has been decided.

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '590 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '590 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

Furthermore, it is well settled that one of the paramount responsibilities of the Office is to preserve the integrity and completeness of the administrative record. The Office bears an obligation to "provide an administrative record showing the evidence on which the findings are based." *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002). That administrative record must be maintained for a court's later review. See *U.S. v. Carlo Bianchi & Co.*, 373 U.S. 709, 714-15 (1963) (court review of administrative decisions is to be confined to "consideration of the

file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

² If this is not the case, the patent owner is required to so inform the Office.

decision of the agency . . . and of the evidence on which it was based"); *Camp v. Pitts*, 411 U.S. 138, 142 (1973) ("[T]he focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court."). In addition, the Administrative Procedure Act (APA) governs judicial review of USPTO findings of fact. See 5 U.S.C. § 706; *Dickinson v. Zurko*, 57 U.S. 150, 152 (1999). Under the APA's standard of review, courts require substantial evidence based on the record as a whole. *In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The administrative record must be maintained for a court's later review even with respect to an issued patent. See, e.g., *Ray v. Lehman*, 55 F.3d 606, 608 (Fed. Cir. 1995) (holding USPTO's decision on a petition to reinstate an expired patent was reviewed on the record under APA).

In addition, as discussed in more detail below, the document(s) submitted under seal with the concurrently-filed petition to expunge, which apparently include(s) the consent judgment, will not be entered and considered in the absence of evidence that the Office will not be violating a protective order of the court by reviewing the document(s).

Accordingly, the September 30, 2011 petition to terminate is dismissed.

The September 30, 2011 Petition to Expunge

On September 30, 2011, the patent owner filed the present petition to expunge, with accompanying documents, including a paper entitled "Transmittal Letter to Accompany Information Submitted under MPEP § 724.02", and a cover sheet containing a list of items, including an item referred to as "Exhibit A: Final Consent Judgment Filed Under Seal Under MPEP § 724.02". The Office's image file wrapper system, IFW, also includes a record of an "artifact sheet" that indicates that an artifact of the type which includes material submitted under MPEP 724.02, was filed on September 30, 2011.

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), "... entered a Final Consent Judgment against Kyocera [the requester of the '590 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '590 proceeding, has consented to a waiver of any protective order by the court, if appropriate. Before the consent judgment is reviewed by the Office, the patent owner must provide evidence that the Office will not be violating a protective order of the court by reviewing

the document and making it available to the public, in the event that a decision is made to terminate based on the content of the consent judgment.

The parties have recourse through the courts to request the court's permission to submit the necessary materials in this merged proceeding. Therefore, there are adequate remedies to address this situation.

For these reasons, the document(s) submitted under seal with the present petition to expunge, which apparently include(s) the consent judgment, have not been reviewed, will not be entered into the record, and will not be considered.

Since the document(s) submitted under seal, which apparently include(s) the consent judgment, have not been entered into the record, there is no consent judgment to expunge from the record.

Accordingly, the September 30, 2011 petition to expunge information is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary evidence that the consent judgment, and any other documents submitted with the Office under seal with the consent judgment, may be submitted in this proceeding and become part of the public record.

The documents submitted with the present petition to expunge, including the document(s) submitted with the Office under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be retained pending a response to this decision, or the expiration of time for response to this decision, at which time the documents will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,590 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

- Any inquiry concerning this communication should be directed to Senior Legal Advisors Cynthia Nessler, at (571) 272-7724 or Pinchus Laufer, at (571) 272-7726.

Brian E. Hanlon

Brian E. Hanlon

Director

Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228

26111 7590 01/05/2012

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 01/05/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

NOVAK DRUCE & QUIGG LLP

1000 LOUISIANA STREET

53rd FLOOR

HOUSTON, TX 77002

Date:

MAILED

JAN 05 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**Decision on Petition for Extension
of Time in Reexamination**

Control No.: 95/000,590 + 95/001,462

JAN 05 2012

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 12/23/2011.

2. THIS DECISION IS ISSUED PURSUANT TO:

- A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

Patent owner requests that the period for responding to the Office action mailed on 12/14/2011, which sets a one (1) month period for filing a response thereto, be extended by one (1) month.

- A. ☒ Petition fee per 37 CFR §1.17(g):
- i. ☐ Petition includes authorization to debit a deposit account.
 - ii. ☒ Petition includes authorization to charge a credit card account.
 - iii. ☐ Other: _____.
- B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C. ☒ Petition was timely filed.
- D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)

- A. ☐ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
☐ Other/comment: _____.
- B. ☒ Dismissed because:
- i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
 - ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
 - iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
 - iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
 - v. ☐ The petition is moot.
 - vi. ☒ Other/comment: See Attached.

5. CONCLUSION

Telephone inquiries with regard to this decision should be directed to Eric Keasel at 571-272-4929. In his/her absence, calls may be directed to Mark Reinhart at 571-272-1611 or Sudhanshu C. Pathak at 571-272-5509 in the Central Reexamination Unit.

/Sudhanshu C. Pathak/
[Signature]

SPRS, CRU 3992
(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the **second** request for extension of time in this proceeding. The petition speaks to the considerations of the length and the complexity of the Office Action, specifically the excessive number of rejections; this is noted and is not persuasive. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceedings. The requirement for reasonably diligent behavior by patent owner includes resource management. Furthermore, Pursuant to MPEP § 2265 (in-part) "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. **Second or subsequent requests** for extensions of time, or requests for more than one month, will be granted only in extraordinary circumstances involved; e.g., death or incapacitation of the patent owner". Therefore, the Request for the extension of time is **denied**.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,462	10/01/2010	7,411,556	3008.005REX0	1228
26111	7590	02/27/2012	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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HOUSTON, TX 77002

Date: MAR 10

FEB 27 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001462 + 95000590

PATENT NO. : 7411556

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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FEB 27 2012

CENTRAL REEXAMINATION UNIT

Sterne, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
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(For Patent Owner)

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(For *Inter Partes* '590 Requester)

Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
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Fifty-third Floor
Houston, TX 77002

(For *Inter Partes* '1462 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,590
Filed: December 16, 2010
For: U.S. Patent No.: 7,411,556

Inter Partes Reexamination Proceeding
Control No. 95/001,462
Filed: October 01, 2010
For: U.S. Patent No. 7,411,556

**DECISION DISMISSING
PETITION TO TERMINATE
INTER PARTES REEXAMINATION
PROCEEDING**

This is a decision on patent owner's January 11, 2012 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182" (the January 11, 2012 petition to terminate).

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,462 (the '1462 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1462 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,590 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,590 (the ‘590 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,411,556 (the ‘556 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the ‘590 *inter partes* reexamination proceeding. A copy of the court’s September 22, 2011 consent judgment, designated as “Exhibit A”, is attached to the present petition (the September 22, 2011 consent judgment).

In the present petition to terminate, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled “Factual Background” and “Legal Argument”. However, the copy of the court’s September 22, 2011 consent judgment, which is attached to the present petition as “Exhibit A”, contains, in the caption, the phrase “Order FILED UNDER SEAL”, and is further stamped with the term “SEALED” above the caption. In addition, the patent owner has previously stated, in its September 30, 2011 petition entitled “Petition under 37 C.F.R. §§ 1.59 & 1.182 to Expunge Information Submitted under MPEP § 724.02”, that the “Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public” (emphasis in original). As discussed in the December 12, 2011 decision dismissing patent owner’s September 30, 2011 petition, it is not clear whether the district court issued a protective order which placed the consent judgment under seal, or whether the consent judgment was merely filed under seal with the district court by the patent owner. The consent judgment will not be entered and considered in the absence of evidence, originating from either the court or from the requester

Kyocera, that the Office will not be violating a protective order of the court by entering and considering the consent judgment, and by making it available to the public. In addition, the consent judgment will not be entered and considered in the absence of evidence that the requester Kyocera has provided its consent to make the consent judgment public, and to a waiver, if applicable, of any protective order by the court.

In the present petition, however, the patent owner has not provided any evidence, originating either from the court or from the requester Kyocera, showing whether the consent judgment is under a protective order by the court.¹ The patent owner merely states that it has obtained the permission of the requester Kyocera to submit the court's consent judgment to the Office and to disclose the court's consent judgment to the public. The patent owner, however, has not provided any written evidence of this, originating from the requester Kyocera. Mere attorney argument is not evidence.

For this reason, no determination on the presently filed petition to terminate the '590 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '590 *inter partes* reexamination proceeding is terminated.

Accordingly, the January 11, 2012 petition to terminate is **dismissed**.

The patent owner has **thirty (30) days from the mail date of this decision** to obtain the necessary **evidence** that the September 22, 2011 consent judgment may be submitted in this proceeding and become part of the public record.

The September 22, 2011 consent judgment has been **temporarily sealed** pending patent owner's response to this decision, or the expiration of time for response to this decision, at which time the consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,590 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day period, the September 22, 2011 consent judgment will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve it.

¹ For that matter, the patent owner has not even provided an explanation regarding whether the consent judgment is under a protective order by the court.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,464	10/11/2010	7,578,439	BKHK-002/00US 313613-2002	1524
94551	7590	09/12/2011	EXAMINER	
LANDMARK INTELLECTUAL PROPERTY LAW, PLLC 19925 Stevens Creek Blvd, Suite 100 Cupertino, CA 95014				
			ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY LLP
ATTN: PATENT GROUP
777 - 6TH STREET, N.W., SUITE 1100
WASHINGTON, DC 20001

Date:

MAILED

SEP 12 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001464
PATENT NO. : 7578439
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry

addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)



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LANDMARK INTELLECTUAL : (For Patent Owner)
PROPERTY LAW, PLLC :
P.O. BOX 1266 :
MIDLOTHIAN, VA 23113 :

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SEP 12 2011

CENTRAL REEXAMINATION UNIT

COOLEY LLP : (For Third Party
ATTN: PATENT GROUP : Requester)
777-6TH STREET, NW, SUITE 1100 :
WASHINGTON, DC 20001 :

In re: Graves et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,464 : UNDER 37 CFR §§ 1.927 & 1.181
Deposited: October 11, 2010 :
For: U.S. Patent No.: 7,578,439 :

This is a decision on the petition filed by the third party requester on February 7, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.181 AND 37 C.F.R. § 1.927" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Denying the Request for *Inter Partes* Reexamination mailed January 7, 2011, which denied the request for reexamination of claims 1-29 of U.S. Patent No. 7,578,439.

The petition is before the Director of the Central Reexamination Unit.

The petition is granted-in-part.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,578,439 issued on August 25, 2009.
- A request for *ex parte* reexamination was filed June 28, 2010 and assigned control no. 90/011,070. It was determined that a substantial new question of patentability was raised with respect to claims 1, 3-7, 12, 14, 16, 19 and 21-25 by a number of prior art references.
- A request for *inter partes* reexamination was filed October 11, 2010 and assigned control no. 95/001,464. The third party requester proposed that a substantial new question of patentability was raised with respect to claims 1-29 by a number of prior art references.
- The examiner denied the *inter partes* request in a determination mailed January 7, 2011. At the time of the determination, the '11070 proceeding was still pending, and the basis for the denial was that the proposals raised the same question of patentability raised in that proceeding. The '11070 proceeding has since been terminated and a reexamination certificate has issued, confirming claims 1, 3-7, 12, 14, 16, 19 and 21-25 as patentable.
- The instant petition was timely filed on February 7, 2011. The petition requests reconsideration and reversal of the examiner's determinations that the proposed combinations of references failed to raise substantial new questions of patentability.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. As the review is *de novo*, we are not limited only to the facts as they existed at the time of the original determination, or at the time the request was filed. In other words, the determination made herein may consider what occurred in the formerly pending related reexamination—even what occurred after the filing of the present request or the examiner's determination thereon—in determining whether a question of patentability is new.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the '439 Patent, and Claim Construction

The '439 patent contains 29 claims, which are the same as those originally filed. In a first Office action the examiner rejected claims 1-9 and 12-27 as anticipated by Graves, and claims 10-11 and 28-29 as obvious over Graves in view of Oka. In response, applicant argued that Graves was not prior art to the application, and the examiner issued a Notice of Allowance. The examiner did not explicitly analyze the priority claim, but as that was applicant's only argument it can clearly be inferred that the examiner considered and agreed with the priority argument. In that paper, the examiner gave reasons for allowance as follows:

The following is an examiner's reason for allowance: Although prior art includes teachings of computer-implemented methods for processing stored-value card transaction requests in a card data management system having a central processor in communication with a plurality of point-of-sale terminals over a communications network, the identified prior art of record, taken alone, or in combination with any other prior art, fails to teach or fairly suggest the specific features of claims 1-29 of the present claimed invention. Specifically, prior art fails to teach the method or system wherein each of the one or more terminals has a unique terminal identifier and is associated with a location and a prepaid card merchant, and further,

the central processor is in communication with a database having stored therein a plurality of card records, wherein each card record contains data associated with a stored-value card distributed to a prepaid card merchant for further distribution to purchasers at a location controlled by the prepaid card merchant. The claimed method includes receiving the stored-value card transaction request from a requesting terminal, wherein the requesting terminal is one of the plurality of point-of-sale terminals, and wherein the transaction request comprises a requesting terminal identifier, a card identifier assigned to a stored value card, and information indicative of a requested transaction type; determining if the requesting terminal is authorized to request the requested transaction type for the stored value card; and responsive to a determination that the requesting terminal is authorized to request the requested transaction type, initiating the requested transaction and transmitting a request response to the requesting terminal.

It is seen that the examiner stated that the prior art teaches a computer-implemented method for processing stored-value card transaction requests in a card data management system having a central processor in communication with a plurality of point-of-sale terminals over a communications network, but that the prior art lacked the remaining features of claim 1.

The '439 patent was additionally subject to now-concluded reexamination 90/011,070. In that proceeding, only claims 1, 3-7, 12, 14, 16, 19 and 21-25 were subject to reexamination. In the Order Granting the Request, the examiner found an SNQ raised as to these claims by references to Dawson and Sobek, alone or in combination with other references. In the first action on the merits, the examiner rejected claims 1, 3-6, 12, 16, 19 and 21-24 as anticipated by Dawson, obvious over Dawson in view of Weber, and obvious over Sobek in view of Weber, all as presented in the Request. The examiner additionally rejected these claims as obvious over Lorsch in view of Murphree. Claims 7, 14, and 25 were confirmed. The examiner also made findings as to priority, which are discussed elsewhere herein.

In response, patent owner argued that Sobek is not prior art, and argued against the merits of the other three rejections. The examiner issued a Notice of Intent to Issue *Ex Parte* Reexamination Certificate on April 7, 2011 ["NIRC"], confirming all claims. The examiner agreed that Sobek is not prior art, and agreed the other references lacked certain features of the claims.

As reasons for confirmation in the NIRC, the examiner stated:

Referring to claims [sic] 1, . . . the prior art does not explicitly teach receiving a stored-value card transaction request from a requesting terminal, the requesting terminal being one of the plurality of point-of-sale terminals, the transaction request comprising a requesting terminal identifier, a card identifier assigned to a stored value card, and information indicative of a requested transaction type and determining if the requesting terminal is authorized to request

the requested transaction type for the stored value card in combination with the remaining elements or features of the claimed invention.

Referring to claims [sic] 12, . . . the prior art does not explicitly teach a central processor in communication with the network, the central processor being adapted to receive the transaction request from the point-of-sale terminal, the stored-value card transaction request comprising a unique card identifier for the particular stored value card, the terminal identifier of the point-of-sale terminal, and information indicative of a requested transaction type, and a transaction authorization module in the central processor configured for determining, based on information in the transaction request and the database, whether the requesting terminal is authorized to request the requested transaction type in combination with the remaining elements or features of the claimed invention.

Referring to claims [sic] 19, . . . the prior art does not explicitly teach [the same material as discussed as to claim 1 above].

NIRC pp. 9-10.

The examiner also pointed out why the prior rejections were withdrawn. NIRC pp. 8-9. Again, Sobek was deemed not to be prior art due to the corrected priority claim in the parent. Dawson, Weber, and Lorsch were each said to lack “making a determination of whether a uniquely identified terminal is authorized for the particular transaction type indicated within the request.” More particularly, the examiner found that Dawson is focused on whether a request is originating from the same customer to which the card was assigned, without regard to any particular transaction type. The examiner found that Weber discloses a protocol for request messages that includes terminal ID and transaction type as components, but does not use this information for transaction authorization and therefore does not make a determination based on transaction type. The examiner found that Lorsch controls activation by seeking an association between the requesting terminal and the merchant, again without regard to any particular transaction type. Thus, the issue of whether these references teach these “determining [if] the requesting terminal is authorized to request the requested transaction type” steps of the claims was squarely before the examiner in that proceeding, and the examiner decided in favor of the patent owner.

Additionally, the patent owner argued in response to the original rejections that Murphree lacks this feature as well. Response filed March 7, 2011 at 43-45. Patent owner, citing Murphree col. 3 lines 18-29 and col. 4 lines 7-31, argued that Murphree does not cure the deficiencies of Lorsch. Patent owner explained that Murphree encodes a merchant ID, terminal ID, store ID, card number, and phone number into the card magnetic stripe. When the card is swiped, the encoded merchant ID is compared with the like number within the terminal, and if they match the transaction is authorized. Thus, like Lorsch, it is only determined whether the requesting

terminal matches the merchant as encoded in the card; there is no determination based on any particular transaction type.

While the examiner did not explicitly mention Murphree in the NIRC, the examiner must necessarily have agreed with patent owner that Murphree lacked this feature. This is the only manner in which Lorsch was distinguished, and the examiner stated Lorsch lacked the feature. Lorsch was already combined with Murphree in the prior rejection, and if the examiner believed Murphree taught this feature he would clearly have modified the rejection to say so, rather than simply confirming the claims. In light of patent owner's arguments, and Murphree's use in the prior rejection, the issue of whether Murphree taught this feature was before the examiner and decided in favor of patent owner.

It should be additionally stated—the claims require determining whether the terminal is authorized to request the requested *transaction type*. A “transaction type” is exactly what it says—a particular kind of transaction. Non-limiting examples are shown in claim 2, things such as card activation. The limitation does not envision *any* authorization, such as authorizing if the terminal matches a known terminal, if it exceeds a particular dollar amount, or generically authorizing a transaction; it requires determining if a type of transaction is authorized. For example, as found by the examiner in the NIRC at pp. 7-8, the request must include “information that specifically indicates the type of transaction being requested, thus delineating it from all other requests.” Additionally, a terminal *performing* a particular transaction type, such as card activation, does not mean it was ever determined if the terminal was authorized to request the transaction type. Some devices simply do not care whether the particular transaction type was ever authorized, they seemingly allow any known transaction type at any terminal, in which case there is no determination. This lack of disclosure is not a disclosure of the claim limitation, which actually requires the step of *determining* whether the particular transaction type is an authorized type.

Decision on the Request for Reexamination

The Priority Issue

Several of the proposals rely on intervening art, and therefore would only be based on prior art if the '439 patent were not entitled to its priority date. While such a situation may in general permit a new question of patentability, certain of these issues were already decided in the previous reexamination.

The priority issue is presented in the Request at pp. 11-19, where the third party argued that the priority claim is defective due to an improper manner of claiming priority in a parent application. Pages 11-18, Sections V.A.-V.B. of the Request, are essentially the same as the priority discussion on pages 8-15 of the '11070 Request. Pages 18-19, Section V.C. of the Request,

argues that the patent owner bears the burden of establishing entitlement to a priority date,¹ and cannot do so due to the defects as noted and due to the lack of 35 U.S.C. § 112 support of the claimed material in the parent application.

As to whether the priority claim is defective, as just mentioned the third party's arguments are substantially identical to those presented in the '11070 Request. In the first Office action of the '11070 proceeding, the examiner specifically addressed these arguments. Non-final Rejection mailed January 7, 2011 at 45-48. The examiner stated that at that time the priority claim was defective, but the defects would be cured with the grating of a petition in the parent application. This petition was later granted, and the examiner confirmed in the NIRC at p. 8 the finding that the priority issue had been decided in patent owner's favor, removing the Sobek reference as prior art. This exact issue was therefore squarely before the examiner and decided in the previous examination, and will not be revisited.

As to whether there is sufficient support under 35 U.S.C. § 112 for the priority claim, the third party's argument is that the provisional application does not support a transaction type being "card value redemption" as recited in claims 2 and 20, a card transaction being a "card value redemption transaction" as in claims 9 and 27, or a transaction processing module being a "card value redemption module" as in claim 17. This issue was not before the examiner previously, therefore this particular issue may be a new issue permitting intervening art to be applied against these claims. This would appear to permit the use of Gould and Fox against the claims, references that would not be prior art if the provisional supported the claims. Note this is not a finding that the provisional does not support the claims, but merely a finding that this is a new issue for consideration and permits an SNQ to be raised by such intervening references if an SNQ is otherwise present. Further analysis of the substance of these references is found herein.

Note however that the reference to Graves from proposals 28 and 29 cannot be applied against the claims as it is not prior art. Graves is a continuation of and has the same disclosure as 10/411,971, which is also within the priority chain of the '439 patent. As we are not revisiting the argument as to the procedural defects of the priority chain, we are only considering arguments concerning § 112 support for the priority claim. However, due to the shared priority

¹ It is not entirely clear what the third party is intending with this "burden of establishing" argument. First, the burden of proof before a trial court during litigation is not relevant to proceedings before the Office. Furthermore, establishing some sort of burden here would seem to ignore the statement by the Federal Circuit in the very case the third party cites, that "*When neither the PTO nor the Board has previously considered priority, there is simply no reason to presume that claims in a CIP application are entitled to the effective date of an earlier filed application.*" *PowerOasis Inc. v. T-Mobile USA Inc.*, 86 USPQ2d 1385, 1389 (Fed. Cir. 2008) (emphasis added). Here, the PTO has already considered priority, during the '11070 proceeding (admittedly, the third party did not know this at the time of filing the Request), therefore even if *PowerOasis* stands for something relevant to this proceeding, its facts are distinguishable. To the extent there is any burden here, it is on the party attempting to prove that an SNQ exists. In any case, priority will be more fully considered as needed during the examination stage.

claim, to the extent that Graves is useable in a rejection the claims would also be supported for priority purposes. That is, the effective date of Graves for the purposes of making a rejection is the earliest date where its parent applications support the disclosure of the claims. Yet, the effective priority date of the claims of the '439 patent is also the earliest date where its parent applications support the disclosure of the claims. Graves cannot be prior art based only on the priority documents not supporting the claims, because in that case the priority documents would not support Graves for rejection purposes either. Graves could potentially be prior art if the priority claim were procedurally defective, but that issue was already decided in the previous examination and is not a new issue for consideration in this proceeding. Graves therefore does not raise a new question of patentability, and proposals 28 and 29 are denied.

The request for reexamination proposed that SNQs are raised by the references as in the following proposed rejections. See Request pp. 25-26 (references), 26-29 (listing of proposals):

1. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are anticipated by Lorsch

As described herein, the Office has already considered these claims in light of Lorsch in the '11070 proceeding. While the examiner considered the combination of Lorsch with Murphree in that proceeding, the examiner's findings apply equally to Lorsch alone. The examiner found that Lorsch lacks making a determination of whether a uniquely identified terminal is authorized for the particular transaction type indicated within the request, and confirmed the claims over Lorsch due to their inclusion of like limitations. The third party here relies on the same or similar teachings of Lorsch as allegedly showing this limitation; no new or different interpretation of Lorsch is provided. The Office has already determined that these teachings of Lorsch do not show the claimed features, and this decision will not be revisited. Lorsch does not provide a new technical teaching different than that present in the '11070 proceeding, therefore it does not raise a new question of patentability. Proposal 1 is denied.

2. Claims 1-7, 9, 12, 14, 16 and 19-25 are obvious over Lorsch in view of Murphree

As described herein, the Office has already considered the claims in light of the combination of Lorsch and Murphree in the '11070 proceeding. In confirming the claims over these references, the examiner found that they lack making a determination of whether a uniquely identified terminal is authorized for the particular transaction type indicated within the request. The third party here relies on the same or similar teachings of Lorsch and Murphree as allegedly showing this limitation; no new or different interpretation of the references is provided. The Office has already determined that these teachings of the references do not show the claimed features, and this decision will not be revisited. The combination of Lorsch and Murphree does not provide a new technical teaching different than that present in the '11070 proceeding, therefore it does not raise a new question of patentability. Proposal 2 is denied.

It is understood that the claims in the present proposal are not identical to those considered in the '11070 proceeding, as claims 2 and 20 are added. It is true that SNQs are typically determined

on a claim-by-claim basis, however the addition of claims 2 and 20 to the proposal does not add anything to the patentability question. That is, it was already determined that Lorsch and Murphree do not teach the limitations of parent claims 1 and 19. The dependent claims are therefore patentable over these references for the same reasons. The question of whether claims 2 and 20 are patentable is the same question of patentability as whether claims 1 and 19 are patentable, the same question that has already been decided. The proposal is therefore denied as to these claims as well. The reasoning in this paragraph is also relevant to other denied proposals discussed herein that relate to more claims than those in the '11070 proceeding.

3. Claims 1-7, 9, 12, 14, 16-17 and 19-25 are obvious over Lorsch in view of Dorf

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. The addition of more claims also does not raise an SNQ, for the same reason as discussed in the last paragraph as to proposal 2. Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Dorf to show this determining limitation. Despite what third party says, however, Dorf clearly does not show this limitation. At Request Exh. S pp. 20-21, the third party alleges Dorf shows this feature because a security check is performed to verify that the transaction is originating from a retailer that is authorized. But determining whether a *retailer* is authorized is not the same as determining whether a *transaction type* is authorized. The third party merely states that Dorf also sends a transaction type, but this does not mean that there is any check or test as to whether such transaction type is authorized, as claimed. Instead, it is apparent that Dorf is no better than Dawson or Lorsch from the '11070 proceeding, which the examiner found provided authorization based on who the request was coming from, not based on transaction type. In other words, Dorf's system does not appear to care or check or determine what *type* of transaction is to occur, so long as the terminal itself is authorized. Dorf clearly does not teach the material that was found to be missing in the prior art during the '11070 proceeding, therefore it does not provide a new technical teaching not present in that proceeding and relevant to the claims. The combination of Lorsch with Dorf would therefore not have been important to a reasonable examiner in determining the patentability of the claims. Accordingly, this proposal is denied.

4. Claims 1-7, 12, 14, 16 and 19-25 are obvious over Lorsch in view of Stimson

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. The addition of more claims also does not raise an SNQ, for the same reason as discussed in the last paragraph as to proposal 2. Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Stimson to show this determining limitation. Despite what third party says, however, Stimson clearly does not show this limitation. At Request Exh. T pp.

17-18, the third party alleges Stimson shows this feature because the terminal transmits the request for a transaction to occur and receives authorization. But determining whether a transaction, overall, is authorized is not a disclosure of determining whether a transaction type is authorized, and permitting different transaction types to occur does not mean it was ever determined whether such type was authorized. In the cited section from the Request, Stimson does not apparently check or care or determine what *type* of transaction is to occur, but merely, generically, authorizes. Stimson is no better than the references from the '11070 proceeding, which the examiner found provided authorization but not a determination or authorization based on transaction type. Stimson clearly does not teach the material that was found to be missing in the prior art during the '11070 proceeding, therefore it does not provide a new technical teaching not present in that proceeding and relevant to the claims. The combination of Lorsch with Stimson would therefore not have been important to a reasonable examiner in determining the patentability of the claims. Accordingly, this proposal is denied.

5. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of Watson

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Watson to show this determining limitation. At Request Exh. U pp. 13-14, the third party alleges Watson shows this feature because the transaction is authorized based on account code, amount, and merchant and industry codes, comparing to a table of pre-authorization limits. Importantly, Watson also states that the table may include specified categories of transactions that may be allowed to proceed. (Note the cite in the Request is incorrect; see instead col. 10 lines 19-34). The examiner will determine if this is sufficient disclosure of transaction types in the sense used in the '439 patent, but on its face Watson appears to show determining if the terminal is authorized to request the requested transaction type, the feature deemed missing from the prior art during the previous examination. These new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Lorsch and Watson would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

6. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of ISO 8583

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on ISO 8583 to show this determining limitation. At Request Exh. V pp. 18-22, the third party alleges ISO 8583 shows this feature. ISO 8583 indicates there

is a message class which describes the specific activities being performed. The third party also shows that ISO 8583 p. 53 includes codes stating whether a transaction is permitted, and reference to code 115 “requested function not supported” provides some indication that a determination is made whether the particular function, or transaction type, is an authorized type. The examiner will determine if this is sufficient disclosure of transaction types in the sense used in the ‘439 patent, but on its face ISO 8583 appears to show determining if the terminal is authorized to request the requested transaction type, the feature deemed missing from the prior art during the previous examination. These new technical teachings, along with the item matching of the references to the claims and the third party’s statements of reasons to combine the references, show that the combination of Lorsch and ISO 8583 would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

7. Claims 1, 3-8, 12-14, 16, 19 and 21-25 are obvious over Lorsch in view of Schlafly

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. The addition of more claims also does not raise an SNQ, for the same reason as discussed in the last paragraph as to proposal 2. Lorsch does not describe the key limitation, as decided in the ‘11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Schlafly to show certain determining limitations. At Request Exh. W, the third party does not actually allege Schlafly shows this particular limitation, but on further examination of the Request there is some indication it may. Exh. W p. 4 cites to Schlafly col. 10 line 56 – col. 11 line 20, where it is said that a processor tests at 278 as to what type of service is being requested, and then a test is made at 280 whether the requested service is authorized. A type of service could be a transaction type as claimed, therefore this appears to facially be a step of determining if the terminal is authorized to request the requested transaction type, the feature deemed missing from the prior art during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party’s statements of reasons to combine the references, show that the combination of Lorsch and Schlafly would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

8. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of Findley

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. Lorsch does not describe the key limitation, as decided in the ‘11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Findley to show this determining limitation. Despite what third party says, however, Findley clearly does not show this limitation. At Request Exh. X pp. 17-18, the third party alleges Findley shows this feature because the transaction is authorized

based on history factors, such as previous purchases from the same origin or card number, or whether the transaction exceeds a monetary amount or corresponds to particular merchandise. None of these things are a transaction type as determined by the examiner in the '11070 proceeding. Whether a request comes from a known origin or card number is no different than what was in Dawson, where authorization was also based on where the request originated. Whether a request exceeds a particular monetary amount, or whether a purchase is of items previously purchased, does not change the underlying *type* of transaction. If so, then the limitation would have no meaning, as we could simply define as a "type" of transaction those that contain authorizable requests, and it is apparent from the related reexamination that more than merely any authorization is needed. A purchase will always be of something being purchased, and will always include some kind of price; thus whether the price is too high or the goods are on the approved list are parts of a transaction, but do not define its type. Findley does not teach the material that was found to be missing in the prior art during the '11070 proceeding, therefore it does not provide a new technical teaching not present in that proceeding and relevant to the claims. The combination of Lorsch with Findley would therefore not have been important to a reasonable examiner in determining the patentability of the claims. Accordingly, this proposal is denied.

9. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of Lee

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims. Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Lee to show this determining limitation. Despite what third party says, however, Lee clearly does not show this limitation. At Request Exh. Y p. 10, the third party alleges Lee shows this feature because the terminal and card are authenticated to each other. But determining whether a card or terminal is authenticated has no bearing on whether the underlying transaction type is authorized. This teaching is no better than that found in Murphree, where there is authentication by comparing ID codes on the card with the terminal where it is swiped, and which the examiner already confirmed the claims over in the '11070 proceeding. Lee, as cited in the Request, does not apparently check or care or determine what *type* of transaction is to occur, but merely, generically, authorizes based on the card and terminal. Lee clearly does not teach the material that was found to be missing in the prior art during the '11070 proceeding, therefore it does not provide a new technical teaching not present in that proceeding and relevant to the claims. The combination of Lorsch with Lee would therefore not have been important to a reasonable examiner in determining the patentability of the claims. Accordingly, this proposal is denied.

10. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of Wood

As described above as to proposal 1, Lorsch alone does not raise an SNQ as to the claims.

Lorsch does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Wood to show this determining limitation. Despite what third party says, however, Wood clearly does not show this limitation. At Request Exh. YY pp. 18-19, the third party alleges Wood shows this feature because the host authorizes a transaction. But determining whether a transaction, overall, is authorized is not a disclosure of determining whether a transaction type is authorized. In the cited section from the Request, Wood does not apparently check or care or determine what *type* of transaction is to occur, but merely, generically, authorizes. Indeed, Wood appears to be drawn to only a single transaction type. Wood is no better than the references from the '11070 proceeding, which the examiner found provided authorization but not a determination or authorization based on transaction type. Wood clearly does not teach the material that was found to be missing in the prior art during the '11070 proceeding, therefore it does not provide a new technical teaching not present in that proceeding and relevant to the claims. The combination of Lorsch with Wood would therefore not have been important to a reasonable examiner in determining the patentability of the claims. Accordingly, this proposal is denied.

11. Claims 1-6, 9-13, 16-25 and 27-29 are obvious over Gould in view of Murphree

As described herein, the key limitation leading to confirmation of the claims, as decided in the '11070 proceeding, is the step of determining if the terminal is authorized to request the requested transaction type.

At Request Exh. Z pp. 21-25, the third party alleges Gould describes this feature because the server checks that the terminal is a valid terminal (Gould par. [0051]), because there is verification during activation that the terminal belongs to the merchant who originally purchased the card (par. [0034]), and because the terminal may perform processes like activation, authorization, and financial transaction processing (par. [0028]).

The problem here is that such teachings are entirely cumulative to those of Dawson, already considered during the '11070 proceeding and found not to read on the claims. In that proceeding, the examiner originally rejected the claims as being anticipated by Dawson, as shown in Exh. F of the '11070 Request. The third party relied on Dawson as showing this limitation because the host verifies during activation that the terminal belongs to the particular customer, i.e. the merchant who purchased the card. '11070 Request Exh. F p. 6. Dawson also performs various transaction types, such as activation and recharging, just like Gould. Gould, as cited by the third party, provides no more as to this key limitation than did Dawson, and the Office has already determined that such teachings do not read on the claims. The question of patentability raised by Gould is the same as that raised by Dawson, already decided in patent owner's favor.

Additionally, as described as to proposals 2 and 20 herein, Murphree's teachings are not sufficient to raise an SNQ. As Gould's and Murphree's teachings do not provide a new technical teaching sufficient for raising an SNQ, their combination fails for the same reasons. Accordingly, this proposal is denied.

12. Claims 1-7, 9-14, 16-25 and 27-29 are anticipated by Fox

As a first issue, the third party states at Request Exh. AA p. 1 n.1 that Fox has a priority date to the U.S. utility application filed February 24, 1999, and was published August 31, 2000. Like any other publication, Fox is available for use as prior art as of its publication date, but Fox does not have a 102(e) date for prior art purposes and the U.S. application date cannot be used. Fox's international filing date is February 23, 2000, which is before November 29, 2000, therefore the reference does not have a 102(e) date and is not prior art under that subsection, via either the international filing or the U.S. priority date. See MPEP § 706.02(f)(1)(I)(C)(3)(b). Fox is only available as of its publication date of August 31, 2000, and therefore is only prior art to the extent the '439 patent is not entitled to its priority date. Whether the parents sufficiently support the claims of the '439 such that it is entitled to its priority date, and thus the prior art status of Fox, will be explored more fully during the examination stage as necessary.

As stated previously, the key limitation that was deemed lacking in the previous reexamination was the step of determining if the requesting terminal is authorized to request the requested transaction type. At Request Exh. AA pp. 12-14, the third party alleges Fox shows this feature in various ways.

Among other things, a cited excerpt from Fox pp. 11-12 states that Fox determines if a card used in a manager terminal is a valid manager card, and that certain functions such as add/delete of clerks can only be used at a manger terminal when a manager card is swiped. This may at first glance appear similar to Dawson, from the previous examination, where it was verified whether a terminal was authorized but the examiner found was not related to transaction type. Fox, however, seems to differ from Dawson (and the teachings that the examiner found did not read on the claims) because it is focused not only on the terminal, but on the particular transaction that is requested at the terminal, i.e. particular manager only type transactions. If an add/delete function is requested, there must be a determination whether the requesting terminal is a manager terminal. Thus, this would seem to show a determination if the requesting terminal is authorized to perform the requested transaction, the feature that was deemed missing from the prior art during the previous examination.

It is not decided whether this is sufficient to read on the claims. For example, in performing an add/delete function, it may not be the case that this transaction request is associated with a stored value card as claimed. But on its face, Fox appears to provide new and different technical teachings than those present during the previous examination, teachings that a reasonable

examiner would find important in considering patentability. Accordingly, this proposal is granted.

13. Claims 1-7, 9, 12, 14, 16 and 19-25 are obvious over Dorf in view of Lorsch

The teachings of Dorf and Lorsch are discussed above as to proposals 3 and 1, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

14. Claims 1-7, 9, 12, 14, 16 and 19-25 are obvious over Dorf in view of Murphree

The teachings of Dorf and Murphree are discussed above as to proposals 3 and 2, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

15. Claims 1-2, 4-7, 9, 19-20 and 22-25 are obvious over Dorf in view of Watson

As described above as to proposal 3, Dorf does not raise an SNQ as to the claims. Dorf does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Watson, and as discussed above as to proposal 5, Watson does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Dorf and Watson would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

16. Claims 1-7, 9, 11-14, 16, 19-25 and 27-29 are obvious over Dorf in view of Schlafly

As described above as to proposal 3, Dorf does not raise an SNQ as to the claims. Dorf does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Schlafly, and as discussed above as to proposal 7, Schlafly does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of

reasons to combine the references, show that the combination of Dorf and Schlafly would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

17. Claims 1-2, 4-7, 9, 19-20 and 22-25 are obvious over Dorf in view of ISO 8583

As described above as to proposal 3, Dorf does not raise an SNQ as to the claims. Dorf does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on ISO 8583, and as discussed above as to proposal 6, ISO 8583 does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Dorf and ISO 8583 would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

18. Claims 1-7, 9, 12, 14, 16 and 19-25 are obvious over Dorf in view of Stimson

The teachings of Dorf and Stimson are discussed above as to proposals 3 and 4, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

19. Claims 1-3, 9, 11-12, 19-21 and 27-29 are obvious over Dorf in view of Findley

The teachings of Dorf and Findley are discussed above as to proposals 3 and 8, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

20. Claims 1-6, 9-13, 16-24 and 27-29 are anticipated by Murphree

The teachings of Murphree were already discussed above as to proposal 2. Murphree was already present in the previous examination and the claims confirmed over the reference, and the third party has not provided any new or different way that Murphree should be considered in this proceeding. The Office will not revisit the prior findings, and Murphree does not provide a new technical teaching not present in the previous examination and does not raise an SNQ. This proposal is denied.

21. Claims 1-7, 9-10, 12, 14, 16-17, 19-25 and 27-29 are obvious over Murphree in view of Dorf
The teachings of Murphree and Dorf are discussed above as to proposals 2/20 and 3, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

22. Claims 1-6, 9, 12, 16-17, 19-24 and 27-29 are obvious over Murphree in view of Stimson
The teachings of Murphree and Stimson are discussed above as to proposals 2/20 and 4, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

23. Claims 1-7, 9-10, 12, 14, 16-17, 19-25 and 27-29 are obvious over Murphree in view of Watson

As described above as to proposals 2/20, Murphree alone does not raise an SNQ as to the claims. Murphree does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on Watson, and as discussed above as to proposal 6, Watson does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Dorf and Watson would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

24. Claims 1-6, 9-10, 12, 16-17, 19-24 and 27-29 are obvious over Murphree in view of ISO 8583

As described above as to proposals 2/20, Murphree alone does not raise an SNQ as to the claims. Murphree does not describe the key limitation, as decided in the '11070 proceeding, of determining if the terminal is authorized to request the requested transaction type.

The third party additionally relies on ISO 8583, and as discussed above as to proposal 6, ISO 8583 does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Murphree

and ISO 8583 would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

25. Claims 1-7, 9-10, 12, 14, 16-17, 19-25 and 27-29 are obvious over Murphree in view of Lorsch

The teachings of Murphree and Lorsch are discussed above as to proposals 2/20 and 1, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

26. Claims 1-6, 9-13, 16-24 and 27-29 are obvious over Murphree in view of Wood

The teachings of Murphree and Wood are discussed above as to proposals 2/20 and 10, respectively. It was found that neither of the references provides a new technical teaching not present in the previous examination and that the references do not raise an SNQ. Combining them in this proposal does not change this result and likewise does not raise an SNQ. This proposal is denied.

27. Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Dawson in view of Watson

As described above, Dawson was present and applied against the claims during the previous reexamination. The examiner confirmed the claims over the reference, finding it did not disclose the features of determining if the terminal is authorized to request the requested transaction type.

The third party now relies on Watson in addition to Dawson. As discussed above as to proposal 5, Watson does appear to provide a new technical teaching not present during the previous examination. The examiner will determine if the other limitations of the claims are satisfied and whether there is sufficient reason to combine during the examination stage, but these new technical teachings, along with the item matching of the references to the claims and the third party's statements of reasons to combine the references, show that the combination of Dawson and Watson would have been important to a reasonable examiner in determining patentability. Accordingly, this proposal is granted.

28. Claims 1-9 and 12-27 are anticipated by Graves

29. Claims 10, 11, 28 and 29 are obvious over Graves in view of Oka

As discussed herein, the issue of whether the priority claim is procedurally defective was before the examiner in the prior reexamination and will not be revisited. Because of this, and because of the common chain of priority between Graves and the '439 patent, Graves is not prior art. Accordingly, these proposals are denied.

To summarize, the following proposed SNQs are granted:


Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of Watson
Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Lorsch in view of ISO 8583
Claims 1, 3-8, 12-14, 16, 19 and 21-25 are obvious over Lorsch in view of Schlafly
Claims 1-7, 9-14, 16-25 and 27-29 are anticipated by Fox
Claims 1-2, 4-7, 9, 19-20 and 22-25 are obvious over Dorf in view of Watson
Claims 1-7, 9, 11-14, 16, 19-25 and 27-29 are obvious over Dorf in view of Schlafly
Claims 1-2, 4-7, 9, 19-20 and 22-25 are obvious over Dorf in view of ISO 8583
Claims 1-7, 9-10, 12, 14, 16-17, 19-25 and 27-29 are obvious over Murphree in view of Watson
Claims 1-6, 9-10, 12, 16-17, 19-24 and 27-29 are obvious over Murphree in view of ISO 8583
Claims 1, 3-7, 12, 14, 16, 19 and 21-25 are obvious over Dawson in view of Watson

The teachings of these references, as discussed herein in the described combinations, are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Accordingly, the petition is granted-in-part.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted-in-part. Accordingly, the request for *inter partes* reexamination of claims 1-14, 16-25 and 27-29 of the '439 patent is granted. Those claims will be reexamined. In accordance with this decision, an Office action on the merits will issue in due course.
2. No substantial new question of patentability is raised as to claims 15 and 26, therefore they will not be reexamined except at the discretion of the Office.
3. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.
4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.


Irem Yucel
Director, Central Reexamination Unit



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Daniel R. Brown
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For Patent Owner

MAILED

NOV 08 2011

David G. Wille
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2001 Ross Avenue, Suite 600
Dallas, TX 75201-2980

3^d Party Requester

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,465
Filed: December 17, 2010
For: U.S. Patent No. 7,317,173

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed April 25, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) is mailed.

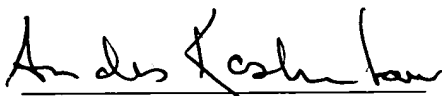
Petitioner requests that "highly confidential" material that is subject to a protective order in the United States District Court for the Northern District of Texas, Wichita Falls Division, submitted in a sealed envelop on April 25, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Reexam Control Nos. 95/001,465

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

A handwritten signature in black ink, appearing to read "Andres Kashnikow", written over a horizontal line.

Andres Kashnikow, SPE
Central Reexamination Unit 3993



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,465	12/17/2010	7317173	062946.0115	3752
73994	7590	02/22/2012	EXAMINER	
Daniel R. Brown 57 Stagecoach Road Fort Worth, TX 76244			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	08/30/2006	Janus Bartelick	110074.00006CON	5367

26710	7590	02/24/2012
QUARLES & BRADY LLP		
411 E. WISCONSIN AVENUE		
SUITE 2040		
MILWAUKEE, WI 53202-4497		

EXAMINER	
PELHAM, JOSEPH MOORE	

ART UNIT	PAPER NUMBER
3742	

NOTIFICATION DATE	DELIVERY MODE
02/24/2012	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pat-dept@quarles.com



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

David G. Wille

BAKER BOTTS LLP

2001 Ross Avenue, Suite 600

Dallas, TX 75201-2980

Date:

MAILED

FEB 22 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001465

PATENT NO. : 7317173

TECHNOLOGY CENTER : 3999

ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Quarles & Brady LLP
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(For Patent Owner)

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FEB 22 2012

CENTRAL REEXAMINATION UNIT

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2001 Ross Avenue, Suite 600
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(For Third Party Requester)

Daniel R. Brown
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(Courtesy Copy)

In re Bartelick et al	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,465	:	DISMISSING
Filing Date: December 17, 2010	:	PETITION
For: U.S. Patent No.: 7,317,173	:	

This is a decision on the September 15, 2011 patent owner petition under 37 CFR 1.182, entitled "Petition to Suspend *Inter Partes* Reexamination Under 37 C.F.R. § 1.182 and 37 C.F.R. § 1.987 and Proposed Amendment Under 37 C.F.R. § 1.951" (the September 15, 2011 patent owner petition).

This decision also addresses:

- Requester's September 29, 2011 opposition paper entitled "Requestor's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Under 37 C.F.R. § 1.182" (requester's September 29, 2011 opposition); and
- The change of correspondence address filed by the patent owner in the present reexamination proceeding on November 23, 2010.

The September 15, 2011 patent owner petition, the September 29, 2011 requester opposition, the change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The September 15, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

The amendment appearing within the body of the present petition, requesting cancellation of present claim 13, **has not been entered**.

The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**.

DECISION

The September 15, 2011 Petition to Suspend

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner effectively argues that good cause exists to suspend the present proceeding because the requester, Cleveland Range, LLC, is apparently a co-defendant in the copending litigation, *Alto-Sham, Inc., v. Cleveland Range, LLC et al.*, Case No. 7:09-CV-00018-0 (N.D. Tex.). Upon brief review of the record in the present proceeding, the Office has verified that the requester, Cleveland Range, is a co-defendant in the copending litigation, which satisfies item A.²

The patent owner further asserts, without any supporting evidence, that the claims at issue in the reexamination are identical to those in the litigation. Without supporting evidence, such as a document originating from the court or drafted for submission in court, a determination regarding whether the claims at issue in the litigation and those under reexamination are identical cannot be made.³ The patent owner states that the claims at issue in the present proceeding include claims 1 and 13, while claim 1 is the sole claim at issue in the litigation. The patent owner includes, within the body of the present petition, an amendment requesting the cancellation of present claim 13. To be entered, however, the amendment must be filed as a separate paper pursuant to 37 CFR 1.4(c), as discussed in more detail below. For these reasons, the patent owner has not sufficiently shown that the claims at issue in the litigation are identical to the claims under reexamination. Thus, item B has not been shown to have been satisfied.

The patent owner asserts, without any supporting evidence, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. The patent owner provides, within the body of the present petition, a list of references that are stated to have been raised in the reexamination, which are also “identified by their respective litigation Exhibit identities”, e.g., “Lit. Ex. 592”. The patent owner has not, however, provided any written evidence to support its assertion, such as, for example, an appropriately redacted document originating from the court or drafted for submission in court, that includes these references as part of a list of trial exhibits. Without supporting evidence, no determination can be made regarding whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. For these reasons, item C has not been shown to have been satisfied.

The patent owner further argues, without pointing to any supporting evidence, that because the patent owner has filed a notice of appeal to the Federal Circuit, the court proceedings have reached an advanced stage. Without supporting evidence, no determination can be made on the

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, after brief review, the Office was able to verify patent owner’s statement, and was able to obtain the citation for the copending litigation. However, if more than a brief review of the file is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

³ The patent owner is reminded that any evidence filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office’s statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c).

issue of whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Upon brief review of the file, however, the Office notes that a copy of the notice of appeal to the Federal Circuit was filed on September 12, 2011. The patent owner, however, has not provided any evidence that the appeal has been fully briefed. Furthermore, as argued by the requester in its September 29, 2011 opposition, patent owner's appeal is from a partial summary judgment by the district court, rather than a final judgment, which may result in a remand by the Federal Circuit back to the district court, rather than a final decision adverse to the requester. For these reasons, the patent owner has not shown whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '173 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the patent owner effectively states that the request for *inter partes* reexamination was filed before any final judgment by the district court. Furthermore, unlike *Sony*, the Office has already issued an action closing prosecution, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.⁴ In the present case, however, the patent owner has not shown that patent owner's appeal to the Federal Circuit has been fully briefed, or that patent owner's appeal, which is from a partial summary judgment by the district court, rather than a final judgment, is not likely to result in a remand by the Federal Circuit back to the district court, rather than a final decision adverse to the requester. Thus, the patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not yet shown that the claims in suit are identical to the claims under reexamination in the present proceeding.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the September 15, 2011 patent owner petition is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

⁴ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

The Proffered Amendment

The patent owner includes, within the body of the present petition, an amendment requesting the cancellation of present claim 13. However, to be entered, the amendment must be filed as a separate paper, distinct from the present petition. "Since different matters may be considered by different branches or sections of the [Office], each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." 37 CFR 1.4(c). In the present case, the instant petition is being decided by a section of the Office which differs from the section that would enter the amendment.

For the reasons given above, the amendment within the body of the present petition, requesting cancellation of present claim 13, **has not been entered**.

The Change of Correspondence Address of the Patent Owner Is Ineffective

The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is ineffective because the official correspondence address of record for the patent owner in a reexamination proceeding is the correspondence address of record in the patent file, and is shown on the first page of this decision. See 37 CFR 1.33(c) and MPEP 2222. Office records fail to reveal that a change of correspondence address was received in the patent file, i.e., the file for application no. 11/468,678.

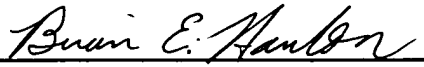
For the reasons given above, the change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**.

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Daniel R. Brown. However, in the absence of a proper change of correspondence address for the patent owner in the patent file, application no., 11/468,678, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The September 15, 2011 patent owner petition is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The amendment appearing within the body of the present petition, requesting cancellation of present claim 13, **has not been entered**.
- The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**. Absent the filing of a change of correspondence address in the patent file, which is application no. 11/468,678, all future correspondence will be mailed to the official correspondence address of record for the patent owner, as shown in the caption of this decision.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon
Director
Office of Patent Legal Administration



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For Patent Owner

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SEP 06 2011

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3^d Party Requester

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,466
Filed: December 16, 2010
For: U.S. Patent No. 7,157,668

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed April 25, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) is mailed.

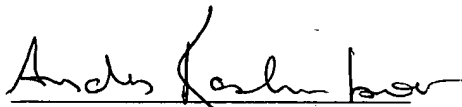
Petitioner requests that "highly confidential" material that is subject to a protective order in the United States District Court for the Northern District of Texas, Wichita Falls Division, submitted in a sealed envelop on April 25, 2011 be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

As outlined in section 724.05 of the MPEP, material submitted under MPEP § 724.04 will be expunged, if it is found not to be material to patentability and the petition seeking to have the material expunged contains: (A) a clear identification of the information to be expunged without disclosure of the details thereof; (B) a clear statement that the information to be expunged is trade secret material, proprietary material and/or subject to a protective order, and that the information has not been otherwise made public; (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information has been submitted; (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information; and (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b). All the above-identified items have been provided.

Reexam Control Nos. 95/001,466

Per the guidelines set forth in section 724.04(c), a final decision on whether the information in question is "material to patentability" in the instant reexamination proceeding will be made prior to the mailing of a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC). The submitted information will be maintained separate from the reexamination file and will not be publicly available until a final determination is made as to whether or not the information is material to patentability.

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

A handwritten signature in black ink, appearing to read "Andres Kashnikow", written over a horizontal line.

Andres Kashnikow, SPE
Central Reexamination Unit 3993



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,466	12/16/2010	7157668	062946.0114	3851
73994	7590	02/22/2012	EXAMINER	
Daniel R. Brown 57 Stagecoach Road Fort Worth, TX 76244			ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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Quarles & Brady LLP
411 E. Wisconsin Avenue
Suite 2040
Milwaukee, WI 53202-4497

(For Patent Owner)

MAILED

FEB 22 2012

David G. Wille
Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, TX 75201-2980

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT

Daniel R. Brown
57 Stagecoach Road
Fort Worth, TX 76244

(Courtesy Copy)

In re Bartelick	:	
<i>Inter partes</i> Reexamination Proceeding	:	DECISION
Control No: 95/001,466	:	DISMISSING
Filing Date: December 16, 2010	:	PETITION
For: U.S. Patent No.: 7,157,668	:	

This is a decision on the September 15, 2011 patent owner petition under 37 CFR 1.182, entitled "Petition to Suspend *Inter Partes* Reexamination Under 37 C.F.R. § 1.182 and 37 C.F.R. § 1.987" (the September 15, 2011 patent owner petition).

This decision also addresses:

- Requester's September 29, 2011 opposition paper entitled "Requestor's Opposition to Patent Owner's Petition to Suspend *Inter Partes* Reexamination Under 37 C.F.R. § 1.182" (requester's September 29, 2011 opposition); and
- The change of correspondence address filed by the patent owner in the present reexamination proceeding on November 23, 2010.

The September 15, 2011 patent owner petition, the September 29, 2011 requester opposition, the change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The September 15, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**.

DECISION

The September 15, 2011 Petition to Suspend

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

[35 U.S.C. 314(c)]¹ thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory “good cause” for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

- A. Whether the third party requester is a party to the litigation;
- B. Whether the claims in suit are identical to the claims under reexamination;
- C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;
- D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and
- E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

¹ 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

The patent owner effectively argues that good cause exists to suspend the present proceeding because the requester, Cleveland Range, LLC, is apparently a co-defendant in the copending litigation, *Alto-Sham, Inc., v. Cleveland Range, LLC et al.*, Case No. 7:09-CV-00018-0 (N.D. Tex.). Upon brief review of the record in the present proceeding, the Office has verified that the requester, Cleveland Range, is a co-defendant in the copending litigation, which satisfies item A.²

The patent owner further asserts, without any supporting evidence, that the claims at issue in the reexamination are identical to those in the litigation. Without supporting evidence, such as a document originating from the court or drafted for submission in court, a determination regarding whether the claims at issue in the litigation and those under reexamination are identical cannot be made.³ The patent owner states that the sole claim at issue in the present proceeding and in the litigation is claim 11. However, the patent owner has not pointed to, and provided as an exhibit attached to the present petition, any document originating from the court or drafted for submission in court, that shows that the sole claim at issue in the litigation is claim 11. For this reason, the patent owner has not sufficiently shown that the claims at issue in the litigation are identical to the claims under reexamination. Thus, item B has not been shown to have been satisfied.⁴

The patent owner asserts, without any supporting evidence, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. The patent owner provides, within the body of the present petition, a list of references that are stated to have been raised in the reexamination, which are also “identified by their respective litigation Exhibit identities”, e.g., “Lit. Ex. 592”. The patent owner has not, however, provided any written evidence to support its assertion, such as, for example, an appropriately redacted document originating from the court or drafted for submission in court, that includes these references as part of a list of trial exhibits. Without supporting evidence, no determination can be made regarding whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. For these reasons, item C has not been shown to have been satisfied.

The patent owner further argues, without pointing to any supporting evidence, that because the patent owner has filed a notice of appeal to the Federal Circuit, the court proceedings have

² The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, after brief review, the Office was able to verify patent owner’s statement, and was able to obtain the citation for the copending litigation. However, if more than a brief review of the file is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

³ The patent owner is reminded that any evidence filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office’s statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c).

⁴ The Office notes that requester appears to acknowledge, in its September 29, 2011 opposition paper, that the sole claim at issue in the litigation is claim 11. Nevertheless, the patent owner has the burden of providing supporting evidence originating from the court, or drafted for submission in court, showing that claim 11 is the sole claim at issue in the litigation.

reached an advanced stage. Without supporting evidence, no determination can be made on the issue of whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Upon brief review of the file, however, the Office notes that a copy of the notice of appeal to the Federal Circuit was filed on September 12, 2011.⁵ The patent owner, however, has not provided any evidence that the appeal has been fully briefed. Furthermore, as argued by the requester in its September 29, 2011 opposition, patent owner's appeal is from a partial summary judgment by the district court, rather than a final judgment, which may result in a remand by the Federal Circuit back to the district court, rather than a final decision adverse to the requester. For these reasons, the patent owner has not shown whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '668 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the patent owner effectively states that the request for *inter partes* reexamination was filed before any final judgment by the district court. Furthermore, unlike *Sony*, the Office has already issued an action closing prosecution, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.⁶ In the present case, however, the patent owner has not shown that patent owner's appeal to the Federal Circuit has been fully briefed, or that patent owner's appeal, which is from a partial summary judgment by the district court, rather than a final judgment, is not likely to result in a remand by the Federal Circuit back to the district court, rather than a final decision adverse to the requester. Thus, the patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not yet shown that the claims in suit are identical to the claims under reexamination in the present proceeding.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the September 15, 2011 patent owner petition is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

⁵ See footnote 3.

⁶ A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

The Change of Correspondence Address of the Patent Owner Is Ineffective

The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is ineffective because the official correspondence address of record for the patent owner in a reexamination proceeding is the correspondence address of record in the patent file, and is shown on the first page of this decision. See 37 CFR 1.33(c) and MPEP 2222. Office records fail to reveal that a change of correspondence address was received in the patent file, i.e., the file for application no. 10/914,880.

For the reasons given above, the change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**.

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Daniel R. Brown. However, in the absence of a proper change of correspondence address for the patent owner in the patent file, application no., 10/914,880, all future correspondence in this reexamination proceeding will be mailed ONLY to the official correspondence address of record for the patent owner, as shown in the caption of this decision.

CONCLUSION

- The September 15, 2011 patent owner petition is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The change of correspondence address filed by the patent owner in the present proceeding on November 23, 2010 is **ineffective**. Absent the filing of a change of correspondence address in the patent file, which is application no. 10/914,880, all future correspondence will be mailed to the official correspondence address of record for the patent owner, as shown in the caption of this decision.
- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.



Brian E. Hanlon

Director

Office of Patent Legal Administration



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,467	10/13/2010	7604929	5662-00007	5191
69139	7590	05/04/2011	EXAMINER	
LOEB & LOEB, LLP 321 NORTH CLARK SUITE 2300 CHICAGO, IL 60654-4746			ART UNIT	PAPER NUMBER

DATE MAILED: 05/04/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE
SUITE 1100
MILWAUKEE, WI 53202

Date:

MAILED

MAY 04 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001467
PATENT NO. : 7604929
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Loeb & Loeb, LLP
321 North Clark, Suite 2300
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(For Patent Owner)

MAILED

MAY 04 2011

CENTRAL REEXAMINATION UNIT

Andrus, Sceales, Starke & Sawall
100 East Wisconsin Ave, St 1100
Milwaukee, WI 53202

(For Third Party Requester)

In re Dryden et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,467
Filed: October 13, 2010
For: U.S. Patent No. 7,604,929 B2

:
: **DECISION ON**
: **PETITION**
: **UNDER § 1.182**
:

This is a decision on the January 5, 2011 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR EXPEDITED CONSIDERATION OF PETITION FROM DENIAL OF REQUEST FOR *INTER PARTES* REEXAMINATION AND REQUEST THAT THE STATUS QUO BE MAINTAINED IN *EX PARTE* REEXAMINATION PENDING DETERMINATION OF THE § 181 PETITION."

The third party requester petition is before the Office of Patent Legal Administration.

The instant petition under 37 C.F.R. § 1.182 to request expedited consideration of the December 21, 2010 third party requester petition under § 1.181 is **dismissed**. Consideration of the December 21, 2010 petition will be not expedited to any greater extent than the current handling of all reexamination proceedings with the statutorily required special dispatch. Further, the distinct action requested to be taken in a separate reexamination proceeding to which the petitioner is not a party will not be taken.

BACKGROUND

1. On October 20, 2009, U.S. Patent Number 7,604,929 B2 was issued to Dryden *et al.*
2. On October 8, 2010, patent owner, Celsis In Vitro filed, a request for *ex parte* reexamination of the '929 patent and the resulting reexamination proceeding was assigned

control number 90/011,276 (“the ‘11276 proceeding”). Notification was given of a concurrent proceeding concerning the ‘929 patent, styled *Celsis In Vitro v. CellzDirect*, Civil Action No. 1:10-cv-004053, at the U.S. District Court for the Northern District of Illinois.

3. On October 13, 2010, a request for *inter partes* reexamination of the ‘929 patent was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 95/001,467 (“the ‘1467 proceeding”). The real parties in interest were identified as CellzDirect and Life Technologies Corporation.

4. On December 16, 2010, the Office issued an order in the ‘11276 proceeding granting the October 8, 2010 patent owner request for *ex parte* reexamination and issued an Office action on the merits of the ‘11276 proceeding. The Office action stated that the patent owner had waived the statement under § 1.530 in an interview dated November 24, 2010.

5. On December 17, 2010, the Office issued an order in the ‘1467 proceeding denying the third party request for *inter partes* reexamination.

6. On December 21, 2010, third party requester filed a petition in the ‘1467 proceeding entitled “PETITION FROM DENIAL OF REQUEST FOR *INTER PARTES* REEXAMINATION.” This petition was filed “[p]ursuant to 37 C.F.R. §§ 1.181 and 1.927.”

7. On January 5, 2011, third party requester filed the instant petition in the ‘1467 proceeding entitled “PETITION UNDER 37 C.F.R. §1.182 FOR EXPEDITED CONSIDERATION OF PETITION FROM DENIAL OF REQUEST FOR *INTER PARTES* REEXAMINATION AND REQUEST THAT THE STATUS QUO BE MAINTAINED IN *EX PARTE* REEXAMINATION PENDING DETERMINATION OF THE §181 PETITION.”

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.4(c) states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

37 C.F.R. § 1.181 provides, in pertinent part:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

37 C.F.R. § 1.182 states:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP 2686.01(I) states, in pertinent part:

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with “special dispatch.”

MPEP 2686.04 states, in pertinent part:

Where a request for reexamination indicates (A) that it is filed as a result of an order by a court or an agreement by parties to litigation which agreement is sanctioned by a court, or (B) that litigation is stayed for the purpose of reexamination, the request will be taken up by the examiner for decision 6 weeks after the request is filed, and all aspects of the proceeding will be expedited to the extent possible. Cases will be taken up for action at the earliest time possible Action on such a proceeding will generally take precedence to any other action taken by the examiner in the Office.

In addition, if (A) there is litigation concurrent with an *inter partes* reexamination proceeding and (B) the reexamination proceeding has been pending for more than one year, the Director or Deputy Director of the Office of Patent Legal Administration (OPLA), Director of the Central Reexamination Unit (CRU), or a Senior Legal Advisor of the OPLA, may approve Office actions in such reexamination proceeding setting a one- month or thirty days, whichever is longer, shortened statutory period for response rather than the two months usually set in reexamination proceedings. . . . It is to be noted that the statutory requirement for “special dispatch” in reexamination often becomes important, and sometimes critical, in coordinating the concurrent litigation and reexamination proceedings.

DECISION

The present third party requester petition was filed on January 5, 2011, seeking two distinct requests for relief. The first request seeks expedited consideration of the December 21, 2010 third party requester petition under § 1.181. The second request seeks that the *status quo* in *ex*

parte reexamination number be maintained pending the decision upon that petition.

1. The Request to Expedite Consideration of the December 21, 2010 § 1.181 Petition

Third party requester asserts that requester is “being prejudiced . . . by the continuation of the *ex parte* reexamination proceeding while the §181 Petition awaits a decision.”¹ Third party requester reasons that, if the pending petition under § 1.181 were to be granted, and if the ‘1467 and ‘11276 proceedings were to be merged, the third party requester’s participation in the merged proceeding would be hampered by any Office action or interview granted with the patent owner prior to the merger of the proceedings.

A significant number of reexamination proceedings are currently pending that involve litigation, including reexamination proceedings in which the litigation has been stayed. Further, 35 U.S.C. § 314(c) provides that “[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.” Thus, regardless of whether a given request for reexamination is directed to a patent that is the subject of concurrent litigation, all requests for reexamination must be considered promptly so as to meet the deadlines imposed by the controlling reexamination statute.

Expedited treatment of a reexamination proceeding by the parties is, in certain rare situations, consistent with current practice in *inter partes* reexamination. As discussed in MPEP 2686.04, the existence of litigation concurrent to a pending *inter partes* reexamination can result in a shortened period for response, if the reexamination has been pending for over a year; or, expedition of all actions in a proceeding where litigation has been stayed for that proceeding, or the proceeding was court-ordered or court-sanctioned. However, pending reexamination proceedings in other instances are conducted in order, to give each reexamination proceeding the statutory special dispatch it deserves. Expediting the handling of a case acts to divert resources that would otherwise be applied to treating another case awaiting treatment by the Office). For this reason, a petitioner seeking to expedite the handling of other petitions bears a heavy burden akin to extraordinary circumstances.

The above considerations therefore provide the context in which third party requester’s petition to expedite must be viewed. In the present instance, petitioner has not shown extraordinary circumstances to call for expediting the rendering of a decision of the § 1.181 petition ahead of the rendering a decision of other petitions, in which reexamination parties are awaiting a decision on relief requested, that will affect further action taken in other reexamination proceedings. It is also pointed out that merger is an administrative act performed solely at the discretion of the Office to facilitate the orderly handling of the proceedings with special dispatch.² Merger is, pursuant to MPEP 2686.01(I), solely at the Office’s discretion; thus, even if the decision on the § 1.181 petition were to be expedited, and the petition granted, it is not clear that such would result in the asserted merger to provide the participation rights discussed in the petition. Since merger

¹ January 5, 2010 petition at 2.

² MPEP 2686.01 (I).

is discretionary, petitioner cannot assert prejudice resulting from either a decision to merge or a decision not to merge.

Additionally, petitioner seeks expedited treatment of a petition under § 1.181 in order that (1) the patent owner be prevented from conducting an interview with the Office in the *ex parte* '11276 proceeding, and that (2) the patent owner be prevented from prosecuting the *ex parte* '11276 proceeding absent input in the proceeding by the requester. However, as pointed out below, third party requester has no statutory or regulatory right to prevent a patent owner from taking actions, or to comment upon any actions taken, in an *ex parte* proceeding. Furthermore, prosecution on the merits has already begun in the '11276 *ex parte* proceeding, including a non-final Office action issued on December 16, 2010, an interview with Office personnel on January 13, 2011, and a reply to the Office action filed on January 26, 2011.

In view of the above, the request in the instant petition under 37 C.F.R. § 1.182 for expedited consideration of the December 21, 2010 third party requester petition under § 1.181 is **dismissed**.

2. The Request to Maintain the Status Quo in *Ex Parte* Reexamination 90/011,276

Under 37 C.F.R. § 1.4(c), "each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." Despite the fact that both requests relate to the same § 1.181 petition, the two requests in the instant petition deal with distinct subjects for which different orders would be required. The first request seeks to expedite a petition decision in the instant '1467 *inter partes* reexamination proceeding, which would require an order in the '1467 proceeding expediting the proceeding, and that has been addressed above. The second request seeks to maintain the *status quo* in a separate proceeding, the '11276 *ex parte* reexamination proceeding, and would require an order in the '11276 proceeding staying that proceeding, and will now be addressed.

As petitioner has requested multiple distinct inquiries in a single paper, the petition violates § 1.4(c). In the interest of providing special dispatch for the present proceeding, the request for expedition of the decision on the § 1.181 petition will be taken up in this decision. The request to maintain the *status quo* in the '11276 *ex parte* reexamination proceeding, however, is dismissed pursuant to § 1.4(c). Any future submission should be limited to a single subject or inquiry.

It is further noted that the 90/011,276 is – by statute - conducted *ex parte*, that is, solely between the Office and the patent owner. The third party requester of the present '1467 *inter partes* reexamination proceeding) does not have a right to file a petition for relief in another reexamination proceeding (reexamination 90/011,276), where the reexamination third party requester does not have any participation right, and does not have standing to request relief with respect to the other reexamination proceeding (reexamination 90/011,276). No such right and/or standing is provided for anywhere in the statute.

For the reasons given above, the request to maintain the *status quo* in the '11276 *ex parte*

reexamination proceeding is **dismissed** in this proceeding.

CONCLUSION

1. The request to maintain the *status quo* in the '11276 *ex parte* reexamination proceeding is **dismissed**.
2. The request for expedited consideration of the December 21, 2010 third party requester petition under § 1.181 is **dismissed**. This petition will be taken up for action at the earliest time possible in accordance with special dispatch.
3. Telephone inquiries related to this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

Kenpet8/IP/
May 3, 2011



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,467	10/13/2010	7604929	5662-00007	5191
69139	7590	01/24/2012		
LOEB & LOEB, LLP 321 NORTH CLARK SUITE 2300 CHICAGO, IL 60654-4746				
EXAMINER				
ART UNIT			PAPER NUMBER	

DATE MAILED: 01/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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100 EAST WISCONSIN AVENUE
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MILWAUKEE, WI 53202

Date:

MAILED

JAN 24 2012

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001467
PATENT NO. : 7604929
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.



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Chicago, IL 60654-4746

For Patent Owner

MAILED

JAN 24 2012

CENTRAL REEXAMINATION UNIT

Andrus, Sceales, Starke & Sawall
100 East Wisconsin Ave, St 100
Milwaukee, WI 53202

For Requester

In re: Dryden, et al
InterPartes Reexamination Proceeding
Control No. 95/001,467
Filed: October 13, 2010
For: US Patent No. 7,604,929 B2


DECISION ON
REQUEST

This is a decision on the paper filed January 13, 2012 requesting the petition filed under 37 CFR 1.181 and 1.927 on December 21, 2010 be withdrawn.

The request is granted.

The petition and supplement thereto filed January 5, 2011 are dismissed as moot in light of the letter filed January 13, 2012.

Telephone inquiries with regard to this decision should be directed to the undersigned at 571-272-1535.


Deborah Jones,
SPE, Art Unit 3991,
Central Reexamination Unit

1/23/2012



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(For Patent Owner)

MAILED

JAN 17 2012

CENTRAL REEXAMINATION UNIT

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ATLANTA, GA 30308-2216

(For Third Party Requester)

In re Haines et al.
Reexamination Proceeding
Control No.: 95/001,469
Filing Date: October 15, 2010
For: U.S. Patent No.: 7,344,541

:
: **DECISION**
: **DISMISSING**
: **PETITIONS**
:

The above reexamination proceeding is before the Director of the Central Reexamination Unit, after receipt of a patent owner's November 21, 2011 petition under 37 CFR 1.181 to invoke supervisory authority to not enter the October 31, 2011 requester's comments. This decision also addresses a January 3, 2012 opposition, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority, by the third party requester in response to the November 21, 2011 petition.

The patent owner's petition of November 21, 2011 is dismissed as premature.

The requester's opposition of January 3, 2012 is dismissed as premature and untimely.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,344,541 [hereinafter “the ‘541 patent”] was granted to *Haines et al.* on March 18, 2008.
2. On October 15, 2010, a request for *inter partes* reexamination of the ‘541 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,469 (the ‘469 proceeding).
3. On November 10, 2010, the Office issued an order granting *inter partes* reexamination in the ‘469 proceeding. An Office action on the merits was mailed on November 23, 2010.
4. Prosecution advanced and on August 29, 2011, an Action Closing Prosecution (ACP) was mailed.
5. On September 29, 2011, the patent owner filed a response to the ACP.
6. On October 31, 2011, the third party requester filed comments.
7. On November 21, 2011, the patent owner filed a petition under 37 CFR 1.181 to invoke supervisory review to not enter the third party requester’s comments of October 31, 2011.
9. On January 3, 2012, third party requester filed an opposition under 37 CFR 1.182 and 1.183 to the November 21, 2011 petition.
10. The examiner has not acted on the September 29, 2011 response and the October 31, 2011 comments to date.

DECISION

The November 21, 2011 petition under 37 CFR 1.181 to invoke supervisory authority asserts that the requester’s comment papers should not be entered in the proceeding record. However, there has been no decision by the examiner if the third party requester’s comments of October 31, 2011 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the October 31, 2011 comments because the examiner has not made his decision. Thus, the patent owner’s November 21, 2011 petition and the requester’s January 3, 2012 opposition are premature and are accordingly dismissed.

In addition, the January 3, 2012 opposition is untimely. See MPEP 2667, subsection II.B.3., which sets forth the policy that oppositions must be filed within two weeks of the date upon which the original petition was served to the opposing party. In this case, the January 3, 2012 opposition was filed more than two weeks from November 21, 2011, the date of service for the original petition.

CONCLUSION

1. The November 21, 2011 patent owner's petition under 37 CFR 1.181 is dismissed as premature.
2. The January 3, 2012 requester's opposition petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature and untimely.
3. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.



Irem Yucel, Director
Central Reexamination Unit